



ALCON, INC.,  
Petitioner,

-versus-

SANTEN PHARMACEUTICAL CO. LTD.,  
Respondent-Registrant.

X-----X

}  
} IPC No. 14-2009-00222  
} Petition for Cancellation:  
} Reg. No. 4-2007-005726  
} Date Registered: October 01, 2007  
} TM: "TAFLOTAN"  
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**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2014 - 242 dated October 07, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 07, 2014.

For the Director:

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



ALCON, INC.,

Opposer,

- versus -

SANTEN PHARMACEUTICALS CO.  
LTD.,

Respondent-Registrant.

X-----X

**IPC NO. 14 - 2009- 00222**

Case Filed on: 10 September 2009

Opposition to:

Registration No. 42007005726

Date filed: 01 October 2007

**TM: "TAFLOTAN"**

**DECISION NO. 2014 - 242**

### DECISION

ALCON, INC.(Petitioner)<sup>1</sup> filed a petition for cancellation to Trademark Registration No. 4-2007-005726. The trademark registration owned by SANTEN PHARMACEUTICAL CO. LTD. covers the mark "Taflotan" for services under Class 5 of the International Classification of Goods<sup>2</sup> particularly, *"pharmaceutical formulations namely, topical antibiotics, anti-inflammatory, anti-infective, anti-glaucoma and decongestant formulations; solutions for use during ophthalmic surgery; sterile; sterile ointments; ocular wetting solutions, artificial tears and formulations for the treatment of minor ocular inflammations and allergic conditions; sterile ophthalmic saline solutions; contact lens cleaning, disinfecting, wetting, cushioning, storing, soaking and/or rinsing formulations in solution or tablet form; pharmaceutical formulations for the therapeutic treatment of neurological disorders and muscle dystonias; dermatological formulations, namely, medicated dry skin lotions and creams, acne medications and medicated skin lighteners; pharmaceuticals for the treatment of actinic keratosis, seborrhea and psoriasis; medicated shampoos and sunscreen preparation; pharmaceutical preparations for the treatment of infectious diseases, pain, inflammation, sepsis, alopecia and obesity and for the treatment of metabolic musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, respiratory, neurological gastrointestinal, hormonal, dermatological and psychiatric related diseases and disorders and skin and tissue repair preparations; veterinary preparations and tablet for cocks, veterinary preparations for the prevention and treatment of bacterial infection affecting poultry livestock, veterinary preparations and vitamins for poultry and livestock; veterinary preparations for fighting cocks against lice and mites; electrolytes and multivitamins for veterinary use only; eye patches for medical purposes; dietary management food supplements; food for babies; plsters materials for*

<sup>1</sup> A corporation organized and existing under the laws of Switzerland with office address located at Bosch 69, CH-6331 Hunenberg, Switzerland..

<sup>2</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

*dressings, material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.*”

The Petitioner based its Petition for Cancellation on the following grounds:

1. The respondent-registrant’s “Taflotan” mark contravenes Section 123.1 sub-paragraph (d) and (e) of Republic Act No. 8293 also known as the Intellectual Property Code of the Philippines (“IP Code”);
2. The mark “Taflotan” so resembles the petitioner’s previously – registered “TRAVATAN” mark as to be likely when applied to or used in connection with the Respondent-Registrant’s goods, deceive or cause confusion with those of Petitioner’s goods;
3. The use by Respondent-Registrant of the mark “Taflotan” on goods that are similar, identical or closely related to the goods that are produced by, originate from, or are under the sponsorship of Petitioner, will mislead the purchasing public into believing that Respondent-Registrant’s goods are produced by, originate from, or are under the sponsorship of herein Petitioner;
4. Petitioner’s mark is a well known one which is entitled to broad protection under *6bis* of the Paris Convention for the Protection of Industrial Property (the “Paris Convention”) and the Article 16 of the TRIPS Agreement, to which the Philippines and Switzerland are signatories, as well as the applicable provision of the IP Code;
5. The registration of Respondent-Registrant’s “Taflotan” contravenes the provision of R.A. No. 8293, the Paris Convention and the TRIPs Agreement hence subject to cancellation under Section 151.1 sub-paragraphs (a) and (b) of the IP Code; and
6. Section 147 of the IP Code clearly provides in relevant part that “The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade, identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion;

In support to the above, Petitioner presented the following exhibit:

1. Exhibit “A” – List of Registrations/Application worldwide of Petitioner’s “TRAVATAN” mark;
2. Exhibit “B” – Duly executed, notarized and legalized Affidavit of Denise Vivar, certifying copies of “TRAVATAN” mark;
3. Exhibit “B-1” – Certified True Copy of the Notice of Renewal of Registration of Trademark Registration No. 764882 for the “TRAVATAN” mark issued by the Australian Register of Trademarks;
4. Exhibit “B-2” – Certified True Copy of Certificate of Registration of Trademark No. 79275-C for the TRAVATAN mark issued by the Bolivia Oficina Nacional De Propriedad Industrial;
5. Exhibit “B-3” – Certified True Copy of Certificate of Registration of Trade Mark No. 820790265 for the TRAVATAN mark issued by the Brazil Instituto Nacional de Propriedad Industrial;

6. Exhibit "B-4" – Certified True Copy of Certificate of registration of Trade Mark No. 554842 for the TRAVATAN mark issued by the Canadian Intellectual Property Office;
7. Exhibit "B-5" – Certified True Copy of Certificate of Registration of Trademark No. VR200800708 for the TRAVATAN mark issued by the Danish Register of Trade Marks;
8. Exhibit "B-6" – Certified True Copy of Certification of Registration of Trademark No. VR200800708 for the TRAVATAN mark issued by the Danish Register of Trademarks;
9. Exhibit "B-7" – Certified True Copy of Certificate of Registration of Trademark No. 221174 for the "TRAVATAN" mark issued by the Finland Patent- JA Rekisterihallitus Patent – OCH Registerstyrelsen;
10. Exhibit "B-8" – Certified True Copy of Certificate of Registration of Trademark No. 144784 for the TRAVATAN mark issued by the Greece Department of Trademark Registration;
11. Exhibit "B-9" – Certified True Copy of Notice of Renewal of Registration of Trade Mark No. 20003924 for the TRAVATAN mark issued by the Trade Marks Registry, Intellectual Property Department, The Government of the Hongkong Special Administrative Region;
12. Exhibit "B-10" – Certified True Copy of Certificate of Registration of Trademark No. 20003924 for the TRAVATAN mark issued by the Trade Marks Registry, Intellectual Property Department, The Government of the Hongkong Special Administrative Region;
13. Exhibit "B-11" – Certified True Copy of Notice of Renewal of Registration of Trademark No. 814839 for the TRAVATAN mark;
14. Exhibit "B-12" – Certified True Copy of Certificate of Registration of Trade Mark No. 814839 for the TRAVATAN mark issued by the India Trade Mark Registry;
15. Exhibit "B-13" – Certified True Copy of Certificate of Registration of Trademark No. 814839 for the TRAVATAN mark issued by the India Trade Marks Registry;
16. Exhibit "B-14" – Certified True Copy of Certificate of Registration of Trademark No. 442337 for the "TRAVATAN" mark issued by the Indonesia Directorate General of Copyright, Patents and Marks;
17. Exhibit "B-15" – Certified True Copy of Certificate of Registration of Trademark No. 442337 for the "TRAVATAN" mark issued by the Ireland OIFIG NAbPAITINNI Patent Office;
18. Exhibit "B-16" – Certified True Copy of Confirmation of Renewal of Registration of Trademark No. 238009 for the TRAVATAN mark issued by the Ireland OIFIG NA bPAITINNI Patent Office;
19. Exhibit "B-17" – Certified True Copy of Notification of Registration of Trade Mark No. 47019CV for the TRAVATAN mark issued by the Malta Ministry of Finance Economy and Investment;
20. Exhibit "B-18" – Certified True Copy of Trademark Registration Certificate Wrapper of Trademark No. 600228 for the TRAVATAN mark issued by the Mexico Instituto Mexicano de la Propriedad Industrial;
21. Exhibit "B-19" – Certified True Copy of Trademark Registration Certificate Wrapper of Trade Mark No. 600228 for the TRAVATAN mark issued by the Mexico Instituto Mexicano de la Propriedad Industrial;

22. Exhibit "B-20" – Certified True Copy of Trademark Registration Certificate Wrapper of Trademark No. 294541 for the "TRAVATAN" mark issued by the Intellectual Property Office of New Zealand;
23. Exhibit "B-21" – Certified True Copy of Renewal of Trademark No. 150187 for the TRAVATAN mark issued by the Trade Mark Registry of Pakistan;
24. Exhibit "B-22" – Certified True Copy of Certificate of Registration No. 150187 for the TRAVATAN mark issued by the Trade Mark Registry of Pakistan;
25. Exhibit "B-23" – Certified True Copy of Certificate of Registration of Trademark No. 4-1999-004845 for the "TRAVATAN" mark issued by the Intellectual Property Office of the Philippines;
26. Exhibit "B-24" – Certified True Copy of Trademark Registration Certificate of Trademark No.4767 for the TRAVATAN mark issued by the Saudi Arabia Ministry of Commerce and Industry, Trademark Registration Department;
27. Exhibit "B-25" – Certified True Copy of Renewal Certificate of Trademark No. T98/065081 for the "TRAVATAN" mark issued by the Intellectual Property Office of Singapore;
28. Exhibit "B-26" – Certified True Copy of Certificate of Registration of Trade Mark No. 392966 for the TRAVATAN mark issued by the Sweden Intellectual Property Office;
29. Exhibit "B-27" – Certified True Copy of Registration Certification of Trademark No. 858725 for the TRAVATAN mark issued by the Republic of China (Taiwan);
30. Exhibit "B-28" – Certified True Copy of Certificate of Registration of Trade Mark No. Kor93256 for the TRAVATAN mark issued by Thailand Intellectual Property Department;
31. Exhibit "B-29" – Certified True Copy of Certificate of Registration of Trade Mark No. 199137 for the TRAVATAN mark issued by Turkish Patent Institute (Turkey);
32. Exhibit "B-30" – Certified True Copy of Certificate of Registration of Trade Mark No. 199137 for the TRAVATAN mark issued by Turkish Patent Institute (Turkey);
33. Exhibit "B-31" – Certified True Copy of Renewal of Trademark No. 2469859 for the "TRAVATAN" mark issued by the UK Intellectual Property Office;
34. Exhibit "B-32" – Certified True Copy of Certificate of Trademark Registration of Trade Mark No. 246859 for the TRAVATAN mark issued by UK Intellectual Property Office;
35. Exhibit "B-33" – Certified True Copy of Certificate of Registration of Trade Mark No. 2496583 for the TRAVATAN mark issued by United States Patent and Trademark Office;
36. Exhibit "B-34" – Certified True Copy of Certificate of Registration of Trade Mark No. 391894 for the TRAVATAN mark issued by Uruguay Direccion Nacional De La Propriedad Industrial;
37. Exhibit "B-35" – International Extension Registration Certificate No. 705779 dated 14 January 1999 issued by the Organisation Mondiale De La Propriete Intellectuelle(OMPI);

38. Exhibit "C" – Duly executed, notarized and legalized Affidavit of Stefan Basler Finance Manager and Martin Schneider, Attorney-in-Fact, both of Petitioner Alcon, Inc.;
39. Exhibit "D" – Product carton / packaging bearing the "TRAVATAN" mark;
40. Exhibit "D-1" – Product insert contained inside the product carton/packaging bearing the "TRAVATAN" mark; and
41. Exhibit "E" – Advertisement brochures made by the Petitioner featuring "TRAVATAN" mark.

Pursuant to the Regulations on Inter Partes Proceedings, this Bureau issued a Notice to Answer and served a copy thereof to Santen Pharmaceutical Co. Ltd. (Respondent-Registrant)<sup>3</sup> on 14 October 2009.

On 8 February 2010, Respondent-Registrant filed its Answer denying all the material allegations of the petition. Respondent-Registrant relied on the following grounds:

1. Respondent-registrant's mark Taflotan is not confusingly similar with petitioner's mark TRAVATAN;
2. Purchasers are more wary when dealing with medicines hence, the likelihood of confusion is remote;
3. Petitioner's mark and respondent-registrant's mark are registered and coexistent with each other in various countries;
4. Contrary to petitioner's contention, respondent-registrant has the right to use and appropriate for itself the mark Taflotan; and
5. Petitioner's mark TRAVATAN is not internationally well known.

The Respondent-Registrant's evidence consist of the following:

1. Exhibit "1" – U.S. Trademark Registration No. 3,194,510 for the mark Taflotan;
2. Exhibit "2" – Hong Kong Trademark Registration No. 300886672 for the mark Taflotan;
3. Exhibit "3" – Chinese Trademark Registration No. 01297156 for the mark Taflotan;
4. Exhibit "4" – Legalized Affidavit – Testimony of witness Akira Kurokawa; and
5. Exhibit "5" – Pages from respondent-applicant's Annual Report 2009.

The Petitioner and Respondent-Registrant filed a Reply and a Rejoinder, respectively, both of which reiterated their earlier arguments in their Petition and Answer.

On 7 June 2010, the Preliminary Conference was terminated. Subsequently, this Bureau issued an Order dated 10 June 2010 directing both parties to file their Position Papers. Both parties submitted their respective Position Papers.

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<sup>3</sup> A corporation organized and existing under the laws of Japan with business address at 3-9-19 Shimoshinjo, Higashiyodogawa-Ku, Osawka-shi, Osaka-Fu, Japan.

The issue to be resolved in the instant case is whether Respondent-Registrant's trademark "Taflotan" should be cancelled.

A perusal of the instant petition shows that it is anchored on Section 151.1, paragraphs (a) and (b), in relation to Section 123.1, paragraphs (d) and (e) of the IP Code. The particular provisions are hereby quoted as follows:

Section 151. *Cancellation.* - 151.1. A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

(a) Within five (5) years from the date of the registration of the mark under this Act.

(b) At any time, if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of this Act, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used. x x x

Section 123.1 A mark cannot be registered if it:

x x x

(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
- (ii) If it nearly resembles such mark as to be likely to deceive or cause confusion;

(e) Is identical with or confusingly similar to or constitute a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services. Provided, that in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

x x x

The records shows that at the time of the Respondent-Registrant filed its trademark application on 5 June 2007, the Petitioner has already an existing trademark registration for TRAVATAN bearing Reg. No. 41999004845 issued on 10 February 2005. This registration covers "pharmaceutical ophthalmic preparations" under Class 5. Notably, ophthalmic preparations are among the applied usage for the trademark "Taflotan." Undoubtedly, the two competing marks are being used on similar or closely related goods.

However, the similarity in the goods of the parties will only be relevant and the aforementioned provisions of the IP Code apply if there will be a finding of confusing similarity between the two competing trademarks. In this instant, this bureau finds that the coexistence of the marks will unlikely cause confusion, much less, deception among the public.

The marks are shown below for comparison:

**TRAVATAN**

**Taflotan**

Petitioner's Mark

Respondent-Registrant's Mark

The only similarities between the contending trademarks are the letters "T", "A" and the suffix "TAN." Although the marks both contain three syllables, the first two syllables of both marks are visually and aurally different from one another. Contrary to the claim of petitioner, even applying the *idem sonans test*, the syllables TA-FLO vis-à-vis TRA-VA have a very much distinguishable aural or phonetic effect and will not result to confusing similarity in sound.

This Bureau also notes that the goods subject of the above trademarks are prescription medicines that are dispensed only through prescription from physicians.<sup>4</sup> In addition to the safeguards provided by our laws<sup>5</sup> in order to prevent the wrong dispensation of prescription drugs, the letters "F" and "L" in the Respondent-Registrant's mark when written in cursive or in print are prominent and distinguishable from the counterpart letters on that of the Petitioner's mark. Thus, there is merit to the argument of the Respondent-Registrant that the likelihood of confusion is remote.

In conclusion, this Bureau finds that there is sufficient difference between the two trademarks such that the buying public would not be mistaken to associate the product of the Respondent-Registrant with that of the Petitioner.

Succinctly, the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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

<sup>4</sup> Exhibit "D" and "D-1" of the Petition for Cancellation and Annex "B" and "B-1" of the Rejoinder

<sup>5</sup> R.A. 9502 or the Universally Accessible Cheaper and Quality Medicine Act of 2008, Generic Act of 1988, and R.A. 9711 Food and Drugs Administration Act of 2009

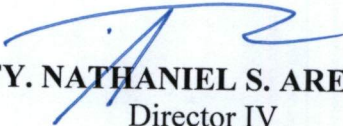


imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.<sup>6</sup> This Bureau finds the Respondent-Registrant's mark is consistent with this function and its registration is not contrary to the provision of our Intellectual Property Laws.

**WHEREFORE**, premises considered, the instant Petition for Cancellation of the Trademark Registration Serial No. 42007005726 is hereby **DISMISSED**. Let the filewrapper of Trademark Registration with Serial No. 42007005726 be returned together with a copy of this **DECISION** to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 7 October 2014

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

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<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19, 1999