



SANOFI AVENTIS,
Opposer,

-versus-

POLPHARMA,
Respondent- Applicant.

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} **IPC No. 14-2012-00009**
}
} Opposition to:
} Appln. Serial No. 4-2011-009468
} Date Filed: 10 August 2011
} **TM: "CORDAFEN"**
}
}
}

NOTICE OF DECISION

CESAR CRUZ & PARTNERS LAW OFFICE
Counsel for the Opposer
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6811 Ayala Avenue, Makati City

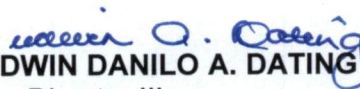
MELISSA C. BROFAS
Representative of Respondent-Applicant
GREENPOWER PHILS., INC.
530 Sirloin Street
FTI Complex, Taguig City

GREETINGS:

Please be informed that Decision No. 2014 - 223 dated September 16, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 16, 2014.

For the Director:


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



SANOFI-AVENTIS,

Opposer,

-versus-

POLPHARMA,

Respondent-Applicant.

x ----- x

IPC No. 14-2012-00009

Opposition to Trademark

Application No. 4-2011-009468

Date Filed: 10 August 2011

Trademark: "**CORDAFEN**"

Decision No. 2014- 223

DECISION

Sonafi-Aventis¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-00468. The contested application, filed by Polpharma² ("Respondent-Applicant"), covers the mark "CORDAFEN" for use on "*pharmaceutical and veterinary preparation*" under Class 05 of the International Classification of Goods³.

Opposer maintains ownership of its allegedly internationally well-known mark "CORDARONE". It claims to have first registered the said mark with the World Intellectual Property Office (WIPO) on 19 May 1967; first used the same in Switzerland in 1967; and in Belgium and France in 1968. It alleges to first use the mark in the Philippines on 01 May 1985 and registered the same on 20 July 1984. It contends that as a result of its extensive promotion, sales and of the excellence of its goods, its company was able to build and enjoy valuable goodwill in its business as represented by its allegedly internationally well-known mark "CORDARONE".

Opposer anchors its opposition on Sections 123.1 (d) and (f) of Republic Act No. 82932, otherwise known as the Intellectual Property Code ("IP Code"). It insists that Respondent-Applicant's adoption of the "CORDAFEN" mark on pharmaceutical products under Class 05 is a clear attempt to trade unfairly on the goodwill, reputation and awareness of its own mark. It avers that while its mark is used for medicinal and pharmaceutical preparations and/or products intended for the "*control of ventricular and supraventricular arrhythmias. Cardiopulmonary resuscitation in the vent of cardiac arrest related to ventricular fibrillation*" and "*for angina pectoris in all its forms, rhythm disorders, tachycardia extrasystoles, for the treatment of attacks and prevention of*

¹ A corporation organized and existing under the laws of France with principal address at 54, rue de la Boetie, Paris, France.

² A foreign corporation with principal place of office at Zaklady Farmaceutyczne Polpharma S.A., 19, Pelpinska Street, 83-200 Starogard Gdanski, Poland.

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.

recurrences" as far as comprised in Class 5, among other classes, Respondent-Applicant's mark is designed similarly "for management of vasospastic angina, chronic stable angina and hypertension", which is exactly the same indication as that of its product on which its "CORDARONE" mark is used.

Opposer furthers that Respondent-Applicant's mark closely resembles and is very similar to its own mark citing the following reasons:⁴

- 12.1 Both marks are purely word marks.
- 12.2. Both marks begin with the same five letters, the letters 'C', 'O', 'R', 'D' and 'A'.
- 12.3. The eighth letter of both marks is the letter 'N'.
- 12.4. The first two syllables of both mark are exactly the same, that is, 'COR-DA'.
- 12.5. Both marks consist of three syllables.
- 12.6. Both marks are used in Class 5.
- 12.7. Both marks are used on exact same goods.
- 12.8 Both marks are used for identical indications.
- 12.9. The Respondent-Applicant's CORDAFEN mark may be believed to be derived from the Opposer's internationally well-known CORDARONE mark."

In support of its allegations in the Opposition, the Opposer submitted the following as evidence:

1. summary of Opposer's worldwide trademark registration of its mark "CORDARONE";
2. affidavit of Ms. Emmanuelle Ragon and its annexes;
3. affidavit of Ms. Malia Lei T. Darantinao and its annex;
4. notarize affidavit of Ms. Gloria Meñano and its annexes; and,
5. authority of Ms. Emmanuel Ragon.

For its part, Respondent-Applicant states that its company is engaged in manufacturing and selling of numerous pharmaceutical products and is certified to be compliant with good manufacturing practice. It asserts that its products, including the

⁴ See Verified Opposition, p. 7.

mark "CORDAFEN", are registered in several countries. In WIPO, the said mark was registered on 09 September 1998. According to Respondent-Applicant, it entered into a Regulatory Representative Agreement with Isochem Pharma on 19 May 2011 in order to register its products. As per the said agreement, its authorized representative filed its application for registration of the mark "CORDAFEN".

Respondent-Applicant denies that that the competing marks are confusingly similar. It claims that its applied mark is an internationally well-known mark that is a medicine for certain types of chest pain and high blood pressure and not basically an antiarrhythmic medication. It denies that its mark "CORDAFEN" is derived from Opposer's mark "CORDARONE". In its defense, it argues that it is a duly registered pharmaceutical entity in Poland that has built its name and reputation worldwide and that it will not resort to n unprofessional schemes and tactics to trade its products.

Attached to Respondent-Applicant's Verified Answer are the following:

1. authentic Certificate of Good Manufacturing Practice Compliance;
2. computerized WIPO-Romarin International Registration Details;
3. copy of the Regulatory Representative Agreement;
4. copy of the License to Operate as Drug Distributorth/Importer issued by the Food and Drug Authority (FDA) to Isochem Pharma on 25 August 2012; and,
5. copy of Respondent-Applicant's application for the trademark "CORDAFEN".

Ultimately, the issue to be resolved is whether Respondent-Applicant's mark "CORDAFEN" should be allowed.

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

"Section 123.1. A mark cannot be registered if it:

(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**
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x"**

As culled from available records, the Opposer was granted registration of the mark "CORDARONE" as early as 20 July 1984. On the other hand, Respondent-Applicant only filed its application on 10 August 2011.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are reproduced below for comparison:

CORDARONE

Opposer's mark

Cordafen

Respondent-Applicant's mark

The competing marks are alike insofar as their beginning syllables "corda". The term "corda" in Latin, however, connotes the word "heart". Noteworthy, the Opposer itself contends that its mark "CORDARONE" is intended for the *"control of ventricular and supraventricular arrhythmias. Cardiopulmonary resuscitation in the vent of cardiac arrest related to ventricular fibrillation"* and *"for angina pectoris in all its forms, rhythm disorders, tachycardia extrasystoles, for the treatment of attacks and prevention of recurrences"*. The Respondent-Applicant, on the other hand, stated in its Answer that "CORDAFEN" is a medicine for certain types of chest pain and high blood pressure. A trademark which appropriates the prefix "CORDA" and is used on heart-related medications is a suggestive mark; therefore, a weak mark. A mark or brand name itself gives away or tells the consumers the goods or service and/or the kind, nature, use or purpose thereof.

Succinctly, what easily comes to the mind one when one sees or hears a mark or brand name of oral antiseptics of which the prefix "CORDA" is a part of is the very concept or idea of the goods. What will set apart or distinguish such mark from another which also includes the same prefix on similar and/or related goods are the letters that comes after. In this case, it will be highly unlikely that the consumers will be misled, confused or deceives that Respondent-Applicant's goods came from or are connected to or associated with that of the Opposer's. The Respondent Applicant's mark uses "FEN" after the prefix "CORDA" while that of Opposer's utilizes the letters or syllables "RONE". Visually and aurally, "FEN" and "RONE" are different.

Finally, 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

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 Respondent-Applicant's trademark sufficiently met this requirement.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-009468 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 September 2014.


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

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