



SANOFI PASTEUR,
Opposer,

-versus-

LUMAR PHARMACEUTICAL LABORATORY,
Respondent - Applicant.

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} **IPC No. 14-2012-00007**
} Opposition to:
} Appln. Serial No. 4-2011-005513
} Date filed: 16 May 2011
} **TM: "TRIMOXAVIN"**

NOTICE OF DECISION

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LUMAR PHARMACEUTICAL LABORATORY

c/o DANIEL P. REGINO
For Respondent-Applicant
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GREETINGS:

Please be informed that Decision No. 2014 - 277 dated November 03, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 03, 2014.

For the Director:


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



SANOFI PASTEUR,
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**LUMAR PHARMACEUTICAL
LABORATORY,**
Respondent-Applicant.

} **IPC NO. 14-2012-00007**

} Opposition to:

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} Appln. Ser. No. 4-2011-005513

} Date Filed: 16 May 2011

} Trademark: **TRIMOXAVIN**

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x-----x} Decision No. 2014- *277*

DECISION

SANOFI PASTEUR, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-000707. The application, filed by LUMAR PHARMACEUTICAL LABORATORY. (Respondent-Applicant)², covers the mark "TRIMOXAVIN", for use on "Medicines, namely AntiBacterial; Quinolones; Cotrimazole preparations" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"9. The Respondent-Applicant's application for the registration of the mark TRIMOXAVIN should not be given due course by this Honorable Office because its registration is contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code, which prohibits the registration of the mark that:

- (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

- (e) Is identical with, or confusingly similar to, or constitute a translation of a mark which is considered by competent authority of the Philippines to be well-known in accordance with the preceding paragraph, which is registered in the Philippines, with respect to goods or

¹ A corporation organized and existing under the laws of France with address at 2, Avenue Pont Pasteur-69007 Lyon, France

² A domestic corporation with address at No. 5 First Bulacan Industrial City, Malolos City, Bulacan

³ 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.

services which are not similar to those with respect to which registration is applied for; Provided, That the use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark; Provided, further, That the interests of the owner of the registered mark are likely to be damaged by such use; xxx

“10. The act of the Respondent-Applicant in adopting the mark TRIMOXAVIN for its product in Class 5 is clearly an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer’s internationally well-known TRIMOVAX mark that was previously applied for registration before this Honorable Office. Such act of the Respondent-Applicant results in the diminution of the value of the Opposer’s internationally well-known TRIMOVAX mark.

“11. While the Opposer’s mark is used on ‘pharmaceutical products namely vaccines for human use’ in Class 5, among other classes, the goods for which the Respondent-Applicant seeks registration for its mark is, ‘Medicines, namely AntiBacterial; Quinolones; Cotrimazole preparations’ are similar and closely related to the goods on which the Opposer uses its internationally well-known TRIMOVAX mark.

“11.1. Goods are closely related when they belong to the same class, or have the same descriptive properties, or when they possess the same physical attributes or essential characteristics, with reference to their form, composition, texture or quality.

“12. The Respondent-Applicant’s mark closely resembles and is very similar to the Opposer’s internationally well-known TRIMOVAX mark that was previously registered in the Philippines and elsewhere in the world to wit:

“12.1. Both marks are purely word marks.

“12.2. Both marks both begin with syllables that are exactly the same, that is, ‘TRI-MO’.

“12.3. Both marks are spelled with exactly the same five letters, namely the letters ‘T’, ‘R’, ‘I’, ‘M’ and ‘O’.

“12.4. Both marks contain the letters ‘V’, ‘X’ and ‘A’ in the suffix of the respective marks on goods.

“12.5. Both marks are used on goods on Class 5.

“12.6. Both marks are used on similar and closely related goods.

"12.7. Both products bearing the Opposer's mark TRIMOVAX and Respondent-Applicant's TRIMOXAVIN are commercially available to the public through the same channels of trade.

"12.8. Aurally, the marks are similar than an indiscriminating buyer might confuse and interchange the products.

"12.9. A cursory glance at both marks appears as though Respondent-Applicant's TRIMOXAVIN mark is the same as the Opposer's TRIMOVAX marks, and hence, may cause confusion.

"12.10. The Respondent-Applicant's TRIMOXAVIN mark so closely resembles the Opposer's internationally well-known TRIMOVAX mark that the public may confuse one from the other and/or believe that goods bearing the said mark originated from the Opposer.

"13. Of all possible combinations of the letters of the alphabet, the Respondent-Applicant chose to use its TRIMOXAVIN mark to identify its goods in Class 5, which are in direct competition with the Opposer's goods, also in Class 5. It cannot be gainsaid that confusion will arise inasmuch as the goods are similar and closely related, in the same class and flow through the same channels of trade. Moreover, the Opposer and the Respondent-Applicant are in direct competition with one another in the same industry. No conclusion can be drawn surrounding the case other than the fact that the Respondent-Applicant is deliberately attempting to trade on the valuable goodwill and ride on the notoriety of the Opposer's internationally well-known TRIMOVAX mark that the public may confuse one from the other and/or believe that goods bearing the said mark originated from the Opposer.

The Opposer also alleged the following:

"4. The Opposer is the owner of the internationally well-known TRIMOVAX mark by prior actual use in commerce and prior registration in the Philippines.

"4.1. A summary of the Opposer's worldwide trademark registrations for the Opposer's internationally well-known TRIMOVAX mark that the Opposer has obtained is hereto attached as EXHIBIT 'C', and made an integral part hereof.

"4.2. The Opposer first registered its internationally well-known TRIMOVAX mark on January 22, 1981 in France and the Opposer has been using the mark openly and continuously around the world since then.

“4.3. In the Philippines, the Opposer first used its internationally well-known TRIMOVAX mark on May 1, 1985 and has been openly and continuously using the same since then.

“5. The Opposer has been extensively promoting and selling its products bearing its internationally well-known TRIMOVAX mark worldwide including in the Philippines, and has been doing so prior to the Respondent-Applicant’s filing of its trademark application for TRIMOXAVIN with this Honorable Office.

“6. As a result of its extensive promotion, sales and excellence of the Opposer’s goods and services, the Opposer has built and now enjoys valuable goodwill in its business as represented by its internationally well-known TRIMOVAX mark, resulting in sales in the Philippines amounting to € 150 759 in 2009, € 439 147 in 2010, € 210 110 in 2011. The internationally well-known TRIMOVAX mark has become distinctive for the Opposer’s goods and services sold in commerce all over the world.

“7. Notwithstanding the prior use and prior registration of the Opposer’s internationally well-known TRIMOXAVIN, or any other mark identical or similar to its internationally well-known TRIMOVAX mark for that matter.”

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

1. Legalized and authenticated Special Power of Attorney dated 27 February 2012;
2. Copy of listings of registration of the mark “TRIMOVAX”;
3. Legalized and authenticated Affidavit of Ms. Joelle Sanit-Hugot dated 27 January 2012;
4. Affidavit of Mr. Jervin B. Papelleras dated 28 February 2012; and
5. Affidavit of Ms. Conchita R. Santos dated 2 March 2012.⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 27 April 2012. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 22 April 2013 Order No. 2013-638 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark TRIMOXAVIN?

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

⁴ Exhibits “A” to “F”

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 R. A. No. 8293, also known as The Intellectual Property Code of the Philippines ("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 Respondent-Applicant applied for registration of the mark "TRIMOXAVIN" the Opposer already registered the mark "TRIMOVAX" under Registration No. 037111 issued on 8 April 1987.⁶ The goods covered by the Opposer's trademark registration are also under Class 5 for pharmaceutical products, same as indicated in the Respondent-Applicant's trademark application. The records further show that the Certificate of Product Registration⁷ issued by the Food and Drug Administration indicate the Opposer as the manufacturer of drug, TRIMOVAX MERIEUX, with the generic name "live attenuated measles, mumps, rubella (MMR) vaccine powder for injection (IM/SC)".

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

TRIMOVAX

Opposer's mark

TRIMOXAVIN

Respondent-Applicant's mark

The marks are similar with respect to the first syllables ("TRIMO"). The syllable "VAX" and "XAV" have the same literal elements "V", "A" and "X", but the Respondent-Applicant merely exchanged the position of the consonants, "V" and "X". When pronounced, TRIMOVAX and TRIMOXAV are the confusingly similar. The addition of the suffix "IN" is negligible given the similarity of TRIMOVAX and TRIMOXAV.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

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

⁶ Exhibit "D" (Affidavit of Joelle Sanit-Hugot)

⁷ Exhibit "E"-Annex "A"


Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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 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.⁸

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.⁹

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-005513 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 3 November 2014.


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

⁸*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁹*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

