



SANOFI-AVENTIS,
Opposer,

-versus-

BELL KENZ PHARMA INC.,
Respondent-Applicant.

} **IPC No. 14-2010-00201**

} Opposition to:

} Application No. 4-2009-008034

} Date filed: 12 August 2009

} **TM: "CLOVIX"**

X-----X

NOTICE OF DECISION

CESAR C. CRUZ AND PARTNERS

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GREETINGS:

Please be informed that Decision No. 2015 - 94 dated May 15, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 15, 2015.

For the Director:


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



SANOFI-AVENTIS, } IPC NO. 14-2010-00201
Opposer, } Opposition to:
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-versus- } Appln. Ser. No. 4-2009-008034
 } Date Filed: 12 August 2009
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BELL KENZ PHARMA INC., } Trademark: "CLOVIX"
Respondent-Applicant. }
x-----x } Decision No. 2015- 94

DECISION

SANOFI-AVENTIS , (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2009-008034. The application, filed by BELL KENZ PHARMA INC. (Respondent-Applicant)², covers the mark "CLOVIX", for use on "anti-thrombotic agent (tablets)" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that CLOVIX is confusingly similar to "PLAVIX", its registered mark. The Opposer alleges, among others:

"12. Under existing law, rule and jurisprudence, the mark CLOVIX should not be registered by this Honorable Office because the registration of the mark subject of this opposition is contrary to Section 123.1 (d) 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; xxx

"13. The Respondent-Applicant's mark CLOVIX is confusingly similar to the Opposer's mark, in that:

- '13.1. Both marks are purely word marks.
- '13.2. Both marks consist of two syllables.

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

² A domestic corporation with address at RH Building, 136 Malakas St., Diliman, Quezon City

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.

- "13.3 Both marks end with the letters 'V', 'I' and 'X'.
'13.4. The second letter of both marks is the letter 'L'.
'13.5. Both marks are used for goods under Class 5.
'13.6. Both marks are used for IDENTICAL drugs which is CLOPIDOGREL.

"14. The Respondent-Applicant's selection of the mark CLOVIX will take advantage of the enviable worldwide reputation that the mark PLAVIX has gained worldwide and that the Opposer has earned through continuous and extraordinary research and marketing efforts through the expenditure of enormous, time, effort and resources. The registration of the Respondent-Applicant's mark and use in Philippine commerce of the same will confuse, mislead and/or deceive the public that the Respondent-Applicant's products are being sold, approved by and/or are originating from the Opposer.

"15. Further, the use and registration of the Respondent-Applicant's mark CLOVIX will dilute the distinctive character of the Opposer's registered mark PLAVIX.

The Opposer also alleges, among others, the following facts:

"4. The Opposer is the owner of the mark PLAVIX which has been registered by this Honorable Office on May 21, 1996 under Registration No. 63004 covering goods in Class 05, specifically for pharmaceutical products for the prevention and treatment of cardiovascular disorders.

"4.1. The Opposer obtained trademark registrations and/or has applied for the registration for its PLAVIX mark in numerous countries.

"5. The generic name of PLAVIX is CLOPIDROGEL. CLOPIDROGEL is an anti-platelet drug, that is, a drug that inhibits the ability of the platelets to clump together as part of a blood clot and therefore reduce the risk of heart attack and strokes. It is marketed for the secondary prevention of thrombotic complications in patients with a history of myocardial infarction, ischemic stroke or peripheral arterial disease.

"6. The Opposer has been extensively promoting its pharmaceutical products bearing its PLAVIX mark in the Philippines and in other countries and has been doing so long before the Respondent-Applicant filed its trademark application for CLOVIX for CLOPIDOGREL with this Honorable Office.

"7. The Opposer's pharmaceutical product bearing its PLAVIX mark is widely available throughout the Philippines.

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

1. Authenticated and notarized Special Power of Attorney dated 8 July 2010;
2. Certified copy of Registration No. 63004 dated 21 May 1996 for the mark "PLAVIX";
3. Copies of trademark registrations in various countries namely: Australia, Canada, Bolivia, Singapore, United Kingdom, United States of America;
4. Copies of marketing materials bearing the mark "PLAVIX";
5. Photocopies of sample sales invoices indicating "PLAVIX" products;
6. List of pharmacies, drugstores, clinics and hospitals selling "PLAVIX" products;
7. Authenticated and notarized Affidavit of Sylvie Guillas dated 8 July 2010;
8. Affidavit of Malia Lei Tiangco Darantinao dated 2 September 2010;
9. Affidavit of Hector Reyes dated 17 August 2010; and
10. Affidavit of Gloria Menano 17 August 2010.⁴

The Respondent-Applicant filed its Answer on 10 November 2010, alleging that the mark CLOVIX is not confusingly similar to the mark PLAVIX owned by the Opposer and that the registration of the mark CLOVIX will not violate section 123 of the IP Code. It put forward, among other things, the following arguments:

"There is no possibility of causing confusion or mistake on the part of the buying public since there are no components in the mark which sufficiently differentiate one from the other. The mark in their entirety, more than sufficiently differentiate one from the other and negate the possibility of confusion or deception.

XXX

"It should also be observed that 'ethical products' are prescribed by experts in the field of medicine. By the way clarification, the end-users in the sales process of medicines are the medical practitioners and not the buying public. This is purely the essence and product of what is termed 'ETHICAL PROMOTION' and contrary to consumer products wherein the target audience and decision makers are the consumers themselves, the target doctors are the ones who write the prescriptions. In effect, if a company promotes their products properly and in good faith, then any kind of confusion will be eradicated. In short, it would be very important to note that medical practitioners are intellectual professionals who are very knowledgeable of the medicines they prescribe and are least likely to commit any error especially if they write their preferred brand. In essence, end-users of our products are the least likely individuals to be affected by 'CONFUSING SIMILARITIES' because of this fact.

"The application for registration of the trademark CLOVIX conforms with, and does not violate the Intellectual Property Code. The fact that the

⁴ Exhibits "A" to "J" with submarkings

Bureau of Trademarks, through the Examiner who examined the Application Number 4-2009-000804 and thereafter approved it for publication for opposition, presupposes that the application conforms with, and does not violate, the Intellectual Property Code of the Philippines, hence, should not be refused/rejected.xxx"

The Respondent-Applicant submitted as evidence, the following:

1. Copy of Securities and Exchange Commission (SEC) Certificate of Incorporation No. CS200606362;
2. Copy of Bureau of Food and Drug License to Operate dated 10 February 2010;
3. Copy of Certificate of Product Registration dated 22 July 2014;
4. Sample of packaging/label of "CLOVIX";
5. Secretary's Certificate signed by Joseph Vincent Go dated 4 November 2010.⁵

The Preliminary Conference was held on 27 September 2011. The Opposer and the Respondent-Applicant submitted their position papers on 21 June 2011 and 12 August 2011, respectively.

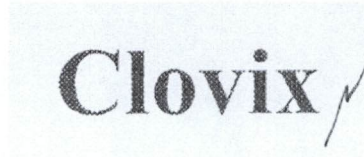
Records show that at the time Respondent-Applicant applied for registration of the mark "CLOVIX" the Opposer already registered the mark "PLAVIX" under of Registration No. 63004. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "pharmaceutical products for the prevention and treatment of cardio-vascular disorders", while the Respondent-Applicant's trademark application indicates use as "anti-thrombotic agents".

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

The competing marks are reproduced below:



Opposer's mark



Respondent-Applicant's mark

The marks are similar with respect to the last syllable, ("VIX") and second letter "L". Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, PLAVIX and CLOVIX sound the same and are *idem sonans*, differing only in their suffixes. In determining the issue of confusing similarity, the court has also

⁵ Exhibits "1" to "5" inclusive of Annexes

taken into account the aural effects of the words and letters contained in the mark.⁶ Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia*⁷, the Supreme Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the *idem sonans* rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

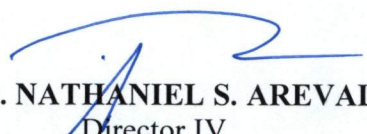
It is also observed that the Respondent-Applicant merely combined the last syllable of Opposer's mark, "VIX" with the prefix of the generic name of the drug, CLOPIDOGREL, hence, CLOVIX.

There are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other especially when used on the same goods under Class 5, in the category of drugs for the treatment of heart attack or stroke. Because CLOVIX is used or will be used on pharmaceutical products that are similar or closely related to the goods covered by the Opposer's trademark registration, chances are, the consumers are likely to confuse the mark for the other or assume that one is just a variation of the earlier mark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-008034 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, 15 May 2015.


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

⁶ *Prosource International Inc. v. Horphag Research Management S.A.*, G.R. No. 180073, 25 November 2009

⁷ G.R. No. L--19297, 22 December 1966