



SANOFI,
Opposer,

-versus-

PHARM EVO (PVT.) LIMITED [PK],
Respondent-Applicant.

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}
} **IPC No. 14-2013-00202**
} Opposition to:
} Appln. Serial No. 4-2012-013425
} Date Filed: 05 November 2012
} **TM: "TREATAN"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 77 dated May 08, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 08, 2015.

For the Director:


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



SANOFI,
Opposer,

-versus

IPC No. 14-2013-00202
Opposition to Trademark
Application No. 4-2012-013425
Date Filed: 05 November 2012
Trademark: "TREATAN"

PHARM EVO (PVT.) LIMITED [PK],
Respondent-Applicant.

X ----- X

Decision No. 2015- 77

DECISION

Sanofi¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-013425. The contested application, filed by Pharm Evo (Pvt.) Limited [PK]² ("Respondent-Applicant"), covers the mark "TREATAN" for use on "*pharmaceutical preparation, namely, treatment for hypertension*" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on the provision of Section 123.1 (d) and (f) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "TREATAN" is confusingly similar to its registered mark "TREATAN" for the following reasons:⁴

- "17.1 Both are purely word marks, TREATAL and TREATAN;
- 17.2 Both marks are composed of two (2) syllables, TREN-TAL and TREA-TAN respectively which when applied to identical/similar goods heighten the visual, aural, phonetic and conceptual similarity between the marks;
- 17.3 Both marks are composed of the same prefix 'TRE'-ntal and 'TRE'-atan;
- 17.4 Both marks are composed of seven (7) letters;
- 17.5 Both use five (5) identical letters namely 'T', 'R', 'E', 'A', and 'N'. consumer confusion arises inevitably with the use of five (5) (sic) letters for each mark to identify the goods in the marketplace. The only differences are in the middle the **Letter N** for TREATAL and the **Letter A** for TREATAN, and the **Letter L** for TREATAL and the **Letter N** for TREATAN. It is undeniable that even a prudent purchaser will have a hard time choosing and distinguishing one product from the other. It is without question that allowing the Respondent-Applicant to use the mark TREATAN for the same kind of pharmaceutical products on which the internationally well known mark TREATAL mark is used on would inevitably lead to diluting the distinctiveness of the well known mark especially between competitors in the same industry; and
- 17.6 Both marks are applied for, used or intended to be used in the same class of goods namely in International Class 5 or for Pharmaceutical Products."

¹ A corporation duly organized and existing under the laws of Germany with principal address at Bruningstrasse 50, Frankfurt, am Main, Germany.

² With office address at 402 Business Avenue, Block 6, P.E.C.H.S., Shahrah-E-Faisal, Karachi.

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.

⁴ See Verified Opposition.

The Opposer states that it has been using its mark "TRENAL" since 1914 and has first registered the same in May 1914 in Germany. It claims that it registered its mark in the country in 1972 and that it likewise registered, sold and promoted the same worldwide. It maintains that as a result of its extensive promotion, sales and excellence, it has built and enjoys valuable goodwill in its business as represented by its allegedly internationally well-known mark. It avers that in the Philippines, the estimated sales thereof is more than Twenty Million Four Hundred Sixty Three and Forty Eight Pesos (P10,463,048.00) in 2012 alone.

In support of its Opposition, the Opposer submitted the following as evidence:⁵

1. affidavit of Dr. Klaus Menken and Dr. Carsten Vogel
2. affidavit of Silvestre Dominic M. Afuang; and
3. affidavit Lucia J. Sabang.

On 30 October 2013, a Notice to Answer was served to the Respondent-Applicant. The latter, however, failed to comply. Thus, the Hearing Officer issued Order No. 2014-367 on 20 March 2014 declaring the Respondent-Applicant in default and submitting the case for resolution.

The issue to be resolved is whether the Respondent-Applicant's mark "TREATAN" should be allowed registration.

The Trademark Registry of this Office, which this Bureau can take judicial notice, reveals that the Opposer was granted registration for its mark "TRENAL" as early as 20 November 2005 under Certificate of Registration No. 4-1999-008147. On the other hand, the contested trademark application of the Respondent-Application was filed only on 05 November 2012.

But are the competing marks, as shown below, confusingly similar?

TRENAL **TREATAN**

Opposer's mark

Respondent-Applicant's mark

From the illustration, it can be observed that the marks are readily distinguishable from each other. Although both begin with the letters "T", "R" and "E", appreciated with the letters that follow them, they produce different sounds when pronounced. The first syllable of the Opposer's mark is pronounced as /tren/ while that of the Respondent-Applicant's as /tri/. Also, the respective final letters in the Opposer's

⁵ Marked as Exhibits "B" to "D", inclusive.

and Respondent-Applicant's mark, "L" and "N", are reverberate distinguishable sounds thereby contributing to the distinctiveness of each mark. Even visually, the similar letters pale in significance because of the different impressions that the contending manifest when taken in their entirety.

Moreover, although both marks cover goods under Class 05, the Respondent-Applicant's trademark application indicates goods or products that, i.e. *pharmaceutical preparation, namely, treatment for hypertension*, are not similar to those covered by the Opposer's trademark registration. Even assuming en arguendo that the parties' respective goods are related, still the differences between the marks make confusion, much more deception, unlikely.

Also, the Opposer failed to prove that its trademark "TRENAL" is well-known for it to be conferred protection outside what is stated in its certificate of registration. Nor that its mark's fame could support the claim that the Respondent-Applicant's trademark application and use of the mark "TREATAN" manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the former.

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 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.⁶ The Respondent-Applicant's trademark sufficiently met his requirement.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-013425 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 May 2015.



ATTY. NATHANIEL S. AREVALO

Director IV, Bureau of Legal Affairs

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