SANOFI,	}	**IPC No. 14-2014-00391**
Opposer,	}	Opposition to:
	}	Application No. 4-2014-001870
	}	Date filed: 13 February 21014
-versus-	}	TM: **"ATORVAS"**
	}	
	}	
	}	
EUROASIA PHARMACEUTICALS, INC.,	}	
Respondent-Applicant.	}	

x--x

NOTICE OF DECISION

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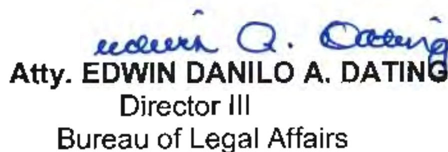
GREETINGS:

Please be informed that Decision No. 2015 - 258 dated November 09, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 09, 2015.

For the Director:



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

IP PHL
INTELLECTUAL PROPERTY OFFICE OF THE PHILIPPINES

SANOFI *Opposer*,	}	**IPC No. 14-2014-00391**
-versus-	}	**Opposition to: Application No. 4-2014-001870 Date Filed: 13 February 2014 Trademark: "ATORVAS"**
EUROASIA PHARMACEUTICALS, INC., *Respondent-Applicant.*	}	
x--x		*Decision No. 2015-* 258

DECISION

SANOFI[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-001870. The application, filed by Euroasia Pharmaceuticals, Inc.[2]("Respondent-Applicant"), covers the mark "ATORVAS" for use on *"pharmaceutical preparations "* under Class 05 of the International Classification of Goods and Services.[3]

The Opposer alleges:

"IV.
"GROUNDS IN SUPPORT OF THIS OPPOSITION

"10. The Respondent-Applicant's application for the registration of the mark ATORVAS should not be accepted by this Honorable Office since to do so would be contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code, which prohibits the registration of a mark that:

x x x

"11. The act of the Respondent-Applicant in adopting the mark ATORVAS for its pharmaceutical products in International Class 5 is clearly an attempt to trade unfairly on the goodwill, reputation and consumer awareness of the Opposer's ATORWIN mark that was previously registered before this Honorable Office. Such act of the Respondent-Applicant results in the diminution of the value of the Opposer's ATORWIN mark.

"12. The Opposer's ATORWIN mark is registered in International Class 5, for pharmaceutical products, namely, pharmaceutical products for the treatment of cardiovascular diseases, identical to the class to which Respondent-Applicant seeks registration for its ATORVAS mark. Further, the Opposer's ATORWIN mark is likely to be associated with Respondent—Applicant's ATORVAS mark leading to consumer confusion.

[1]A foreign corporation organized and existing under the laws of France with principal address at 54, rue la Boetie, 75008 Paris, France.
[2]With address at Unit 1201 12/F AIC Burgundy Empire Tower, ADB Avenue, Ortigas Business Center, Pasig City, Metro Manila.
[3]The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

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"13. 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 characteristics, with reference to their form, composition, texture, or quality.

"14. The Respondent-Applicant's mark ATORVAS closely resembles and is very similar to the Opposer's ATORWIN mark that was previously registered in the Philippines and elsewhere in the world. The resemblance of the Opposer's and the Respondent-Applicant's respective marks is most evident upon a juxtaposition of the said marks.

x x x

"15. The Opposer's mark ATORWIN and the Respondent-Applicant's mark ATORVAS are identical and/or similar, in the following respects to wit:

"15.1. Both marks are purely word mark, i.e., ATORWIN and ATORVAS;
"15.2. Both marks consist of seven (7) letters, i.e., 'A'-'T'-'O'-'R'-'W'-'I'-'N' and 'A'-'T'-'O'-'R'-'V'-'A'-'S';
"15.3. Both marks consist of three (3) syllables, i.e., 'A'-'TOR'-'WIN' and 'A'-'TOR'-'VAS';
"15.4. The first two (2) syllables of both marks are identical. The only difference between the marks is the last syllable, i.e., 'WIN' and 'VAS'- and as such, the marks are almost identical;
"15.5. The Respondent-Applicant's mark and the Opposer's mark are undoubtedly phonetically similar.
"15.6. Both marks are used for similar goods, namely for pharmaceutical preparations under International Class 5.

"16. Goods bearing the Opposer's mark ATORWIN and the Respondent-Applicant's mark ATORVAS are commercially available to the public through the same channels of trade such that an undiscriminating buyer might confuse and interchange the products bearing the Respondent-Applicant's mark ATORVAS for goods bearing the Opposer's mark ATORWIN. It is worthy to mention that the relevant consumers affected herein will be the buyers of pharmaceutical products. Naturally, consumers would merely rely on recollecting the dominant and distinct wording of the marks. There is a great similarity and not much difference between the Opposer's mark ATORWIN and the Respondent-Applicant's mark ATORVAS. Thus, confusion will likely arise and would necessarily cause the interchanging of one product with the other.

"17. Considering the fact that the goods involve are related and flow through the same channels of trade, the possibility of confusion is more likely to occur in light of the fact that ordinary consumers, who are prone to self-diagnose illness and purchase prescription drugs even without a doctor's prescription, may mistakenly believe that the goods of the Respondent-Applicant is equivalent to, or affiliated with, the Opposer's goods.

"18. The Respondent-Applicant's ATORVAS mark so closely resembles the Opposer's ATORWIN mark that the Filipino public will undoubtedly confuse one with the other or worse, believe that goods bearing the Respondent-Applicant's mark ATORVAS originate from the Opposer, or, at least, originate from economically linked undertakings.

"19. In American Wire & Cable Co. v. Director of Patents, 31 SCRA 544, 547-548 (1970), the Supreme Court through Justice J.B.L. Reyes ruled:

x x x

"20. In addition, under the rule of idem sonans, it is clear that there is a confusing aural similarity between the marks. The Supreme Court has held that the mark 'Gold Top is 'aurally' similar to 'Gold Toe'. Furthermore, in McDonald's vs. L.C. Big Mak, 437 SCRA 10, 34 (2004) citing Marvex Commercial Co., Inc. vs. Petra Hawpia & Co., et al., Phil 295, 18 SCRA 1178 (1966) the Supreme Court held:

x x x

"The only difference between the Respondent-Applicant's mark ATORVAS and the Opposer's ATORWIN mark is the last syllable used while the first two syllables are identical. It cannot be denied that the two marks are aurally similar and would indubitably cause confusion amongst the Filipino consumers.

"21. The Opposer's mark ATORWIN is used for the treatment of hypercholesterolemia and prevention of cardiovascular disorders under International Class 5. Similarly, the goods bearing the Respondent-Applicant's mark ATORVAS designated under International Class 5. The presence of two identical and/or similar pharmaceutical products bearing highly similar trademarks which are used to treat the same illnesses will indubitably lead to consumer confusion.

"22. In consonance with public policy, it is the duty of this Honorable Court to protect the Filipino purchasing public by ensuring that there is no confusing similarity involving medicinal products. Unlike ordinary goods, confusion between medicinal goods may also arise as a result of a physician's illegible handwriting, thus the need for further protection. This has been recognized in jurisprudence, notably in Morgenstern Chemical Co. v. G.D. Searle & Co., 253 F. 2d 390 (1958).

"23. In Morgenstern, the United States of Appeals ruled that the 'obvious similarity in derivation, suggestiveness, spelling, and sound in careless pronunciation, between 'Micturin' and 'Mictine' as applied to pills to be taken by mouth for therapeutic purposes requires the conclusion , in the circumstances of this case, that the defendant has infringed the rights of the plaintiff in its common-law trade name Micturin and should be restrained from further doing so.

"24. Further, in Morgenstern, the Court also noted that it is common knowledge that mistakes or confusion occurring in filling handwritten prescriptions which are not legible. In arriving at his conclusion, the Court of Appeals in Morgenstern appropriately ruled that:

x x x

"25. The ruling in Morgenstern should squarely be applied in the case at bar. The fact that the medicinal products of the parties are for identical indications highlights the stubborn fact that there exist a possibility of one medicinal product being dispensed for the other medicinal product, which could easily be remedied by requiring clearly dissimilar trademarks in the field of medicinal products. The reputation and goodwill of the Opposer should not be trifled with the talismanic invocation that there is only a remote possibility of confusion. The fact clearly remains that the goods of the parties belong to the same class, are identical, and are available through the same channels of trade. As the Supreme Court in Ang v. Teodoro has aptly stated:

x x x

"26. The case of Glenwood Laboratories, Inc. v. American Home Prod. Corp., 455 F. 2d 1384 (C.C.P.A. 1972), aptly illustrates the danger of confusion as regards medicinal products bearing similar marks, ruling that,

x x x

"It is clear from the ruling in Glenwood Laboratories that medicinal products require greater protection because confusion or mistake in filling up a prescription would produce harmful effects. Regardless of the high degree of educational attainment and discernment attained by the physicians prescribing these drugs, it cannot be denied tha the purchasing public should be protected from the possible harm that may arise form a confusion of the marks.

"27. Of all the possible combinations of the letters of the alphabet and words, the Respondent-Applicant chose to use the mark ATORVAS to identify its goods in International Class 5, which are in direct competition with the Opposer's goods, also in International Class 5. It cannot be gainsaid that confusion will arise inasmuch as the goods are identical, and they cater to the same kind of purchasers. As pharmaceutical products for the treatment of identical illnesses, both will be found and displayed in hospitals, clinics, and pharmacies, probably side by side, making both products flow through the same channels of trade, thus making the Opposer and the Respondent-Applicant competitors in the same product industry. No conclusion can be drawn surrounding the case other than the fact that the Respondent-Applicant is knowingly and deliberately attempting to trade on the valuable goodwill and to ride on the notoriety of the Opposer's ATORWIN mark that has been used throughout the world for several decades including in the Philippines.

"28. Clearly, the registration and use of the Respondent-Applicant mark's ATORVAS is a usurpation of the mark ATORWIN, a mark legally owned by the Opposer, as well as the goodwill associated therewith and/or passing off its own products, as those manufactured by the Opposer.

> "28.1. By the Respondent-Applicant's attempt to register and use the mark ATORVAS for its goods in International Class 5, it is plain that the Respondent-Applicant seeks to take advantage of the worldwide and nationwide reputation of the mark ATORWIN that the Opposer has gained by ingenious and persistent marketing and the expenditure of considerable sums of money to promote the same, by confusing and misleading the trade and the Filipino public in passing off its own products as those of the Opposer and/or suggesting that they are being sold or are approved by the Opposer.

"29. The registration of the Respondent-Applicant's mark ATORVAS will lead the purchasing public to believe that the goods of the Respondent-Applicant emanate from the Opposer. If the products of the Respondent-Applicant are inferior in quality, there will be grave and irreparable injury to the Opposer's valuable goodwill and to its ATORWIN mark. Furthermore, the use and registration of the mark ATORVAS by the Respondent-Applicant will dilute and diminish the distinctive character of the Opposer's ATORWIN mark.

"30. The Respondent-Applicant seeks to register the mark ATORVAS which is confusingly similar to the Opposer's ATORWIN mark, as to be likely, when applied to the goods of Respondent-Applicant, to cause confusion, mistake or deception to the

Filipino public as to the source of goods, and will inevitably falsely suggest a trade connection between the Opposer and the Respondent-Applicant, is simply violative of the Intellectual Property Code of the Philippines.

"31. The Supreme Court discussed these two types of trademark confusion in Mighty Corporation, et. al. vs. E. & J. Gallo Winery, et. al., G.R. No. 154342, July 14, 2004, 434 SCRA 473, 504, thus:

x x x

"32. In the case of Societe Des Produits Nestle, S.A. vs. Dy, Jr., the Supreme Court held that:

x x x

"33. Moreover, in the case of McDonald's Corporation vs. L.C. Big Mak Burger, Inc., et.al., the Supreme Court had occasion to rule that, 'while proof of actual confusion is the best evidence of infringement, its absence is inconsequential'.

"34. Thus, the denial of the registration of Trademark Application No. 4/2014/001870 for the mark ATORVAS by this Honorable Office is authorized and warranted under the provisions of the Intellectual Property Code of the Philippines.

x x x

The Opposer's evidence consists of the Special Power of Attorney executed by the Opposer in favor of Cesar C. Cruz and Partners Law Offices; and the Affidavit executed by Sylvie Guillas .[4]

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant, Euroasia Pharmaceuticals, Inc., on 13 November 2014. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123.Registrability. - 123.1. A mark cannot be registered if it:

x xx

(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

[4]Marked as Annexes "A" to "B", inclusive.

> (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;"
>
> (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or service which are not similar to those with respect to which registration is applied for: Provided, That 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;

Records show at the time the Respondent-Applicant filed its trademark application on 13 February 2014, the Opposer has an existing trademark registration for the mark ATORWIN under Trademark Reg. No. 2793 issued on 06 October 2011. The registration covers "pharmaceutical products for the treatment of cardiovascular diseases" under Class 05. On the other hand, Respondent-Applicant's mark covers "pharmaceutical preparations" under Class 05.

Hence, the question, does ATORVAS resemble ATORWIN such that confusion or deception is likely to occur? The marks are shown below:

ATORWIN	Atorvas
Opposer's trademark	*Respondent-Applicant's mark*

This Bureau finds that confusion or deception is unlikely to occur at this instance. Although both pharmaceutical products have the same first two (2) syllables "ATOR", Opposer can not exclusively appropriate the first two syllables as "ATOR" is derived from ATORVASTATIN, a statin administered orally in the form of its hydrated calcium salt to lower lipid levels in the blood.[5] In the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, there are registered marks covering pharmaceutical preparations or drugs that have the prefix – "ATOR", such as Atorvasterol with Reg. No. 42011009471, Atorva with Reg. No. 42006005576, and TGP-ATOR with Reg. No. 42014007241, which are owned by entities other than the Opposer. Hence, this Bureau cannot sustain the opposition solely on the ground that both marks contain or start with "ATOR". To do so would have the unintended effect of giving the

[5] Merriam-Webster dictionary definition of ATORVASTATIN.

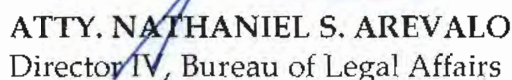
Opposer exclusive right over the prefix "ATOR". To determine whether two marks that contain the prefix "ATOR" are confusingly similar, there is a need to examine the other letters or components of the trademarks. In this regard, when the syllable "VAS" is appended to "ATOR", the resulting mark when pronounced can be distinguished from ATORWIN.

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] This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2014-001870 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 09 November 2015.



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

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