

SANOFI,  
Opposer,

-versus-

ATTY. AMBROSIO V. PADILLA III,  
Respondent- Applicant.

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}  
} **IPC No. 14-2015-00014**  
} Opposition to:  
} Appln. Serial No. 4-2014-00013009  
} Date Filed: 20 October 2014  
} **TM: "ATORPINE"**  
}  
}  
}

**NOTICE OF DECISION**

**CESAR C. CRUZ AND PARTNERS**  
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3001 Ayala Life-FGU Center  
6811 Ayala Avenue, Makati City

**ATTY. AMBROSIO V. PADILLA III**  
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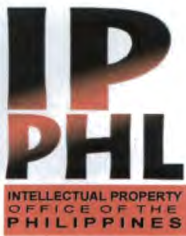
**GREETINGS:**

Please be informed that Decision No. 2016 - 236 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:

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



**SANOFI,**  
Opposer,

- versus -

**ATTY. AMBROSIO V. PADILLA III,**  
Respondent-Applicant.

X ----- X

IPC No. 14-2015-000014  
Opposition to:

Appln. No. 4-2014-013009  
Date Filed: 20 October 2014  
Trademark: "ATORPINE"  
Decision No. 2016 - 236

### DECISION

SANOFI ("Opposer")<sup>1</sup>, filed a verified opposition to Trademark Application Serial No. 4-2014-013009. The application, filed by ATTY. AMBROSIO V. PADILLA III ("Respondent-Applicant")<sup>2</sup>, covers the mark "ATORPINE" for use on goods under Class 05<sup>3</sup> namely: *pharmaceutical preparations - pharmaceutical drug used for the prevention of cardiovascular complication in hypertensive patients.*

The Opposer alleges the following grounds for opposition:

"10. The Respondent-Applicant's application for the registration of the mark ATORPINE 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 the mark.

"11. The act of the Respondent-Applicant in adopting the mark ATORPINE for his pharmaceutical products in International Class 5 is clearly an attempt to trade unfairly on the goodwill, reputation and consumer awareness of the Opposer's internationally well-known 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 internationally well-known ATORWIN mark.

"12. The Opposer's internationally well-known ATORWIN mark is registered in International Class 5, for Pharmaceutical Products for the Treatment of Cardiovascular diseases, identical to the class to which the Respondent-Applicant seeks registration for his ATORPINE mark. Further, because the Opposer's mark is internationally well-known, the same is likely to be associated with the Respondent-Applicant's ATORPINE mark leading to consumer confusion.

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"19. Goods bearing the Opposer's mark ATORWIN and the Respondent-Applicant's mark ATORPINE are commercially available to the public through the same channels of trade such that an indiscriminating buyer might confuse and interchange the products bearing the Respondent-

<sup>1</sup> A corporation organized and existing under the laws of France with principal address at 54 Rue La Boetie 75008 Paris, France.

<sup>2</sup> With business address at Unit 1001, 88 Corporate Center, Sedenon corner Valero Street, Salcedo Village, Makati City.

<sup>3</sup> The Nice Classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This 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.



Applicant's mark ATORPINE for goods bearing the Opposer's internationally well-known mark ATORWIN. It is worthy to mention that the relevant consumers affected herein will be the buyers of pharmaceutical products. Naturally, consumer 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 ATORPINE. Thus, confusion will likely arise and would necessarily cause the interchanging of one product with the other."

The Opposer's evidence consists of the following:

1. Legalized and authenticated Special Power of Attorney by the Opposer in favor of Cesar S. Cruz and Partners Law Offices;
2. Summary of Trademark Application and Registrations for ATORWIN; and,
3. Samples of Documentation.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer dated 03 March 2015 which was received by the Respondent-Applicant's agent on 12 March 2015. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.<sup>4</sup>

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

The instant opposition is anchored on Section 123.1 paragraph (d) of the IP Code which 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 mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 20 October 2014<sup>5</sup>, the Opposer has already an existing trademark registration for the mark ATORWIN bearing Registration No. 4-2011-002793 dated 06 October 2011 in the Philippines, for pharmaceutical product for the treatment of cardiovascular diseases.<sup>6</sup> Significantly, this Bureau noticed that Respondent-Applicant's ATORPINE trademark covers similar or closely related to that of Opposer's ATORWIN mark.

Nevertheless, it is unlikely that the co-existence of the marks will cause confusion, much less deception, among the public. The only similarities between the marks, as shown below,

**ATORWIN**

Opposer's Trademark

**Atorpine**

Respondent-Applicant's Trademark

<sup>4</sup> Order No. 2015-1110 dated 29 July 2015.

<sup>5</sup> Filewrapper records.

<sup>6</sup> Annex "B" of Opposer. IPPhl Philippine Trademark Database, available at <http://www.wipo.in/branddb/ph/en/> (last accessed 16 June 2016).

are the syllables or prefixes "A/TOR" and the letter "I" positioned in the last syllable or suffix of the above-shown marks.

In this regard, it appears that the syllables "A/TOR" are not an accurate indicator of the existence of confusing similarity between the marks because the same is common in drugs or medicine, over which the Opposer cannot claim exclusive rights. "A/TOR" is obviously derived from the generic name "*Atorvastatin calcium*". In fact, the Opposer's sample product packaging shows that ATORWIN's generic name is "ATORVASTATIN CALCIUM".<sup>7</sup> It is a fair inference therefore, that "A/TOR" in ATORWIN is derived from its generic name.

ATORWIN thus, is not highly distinctive as a trademark. At most, it is considered a suggestive mark, which is a weak mark. What will set apart or distinguish such mark from another mark which also includes the same syllables or prefix, are those that follow "A/TOR". In this instance, it is very unlikely that a consumer will be misled or confused into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's. The Respondent-Applicant's mark ends with "PINE" which are so much different, visually and aurally, from "WIN" in the Opposer's mark.

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 out into the market a superior 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.<sup>8</sup> This Bureau finds the Respondent-Applicant's mark consistent with this function.

Moreover, taking into account that the similarity between the competing marks is the prefix "A/TOR", sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive rights to use the same.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the file wrapper of Trademark Application Serial No. 4-2014-013009 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

**SO ORDERED.**

Taguig City **30 JUN 2016**

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

<sup>7</sup> Exhibit "B" of Opposer.

<sup>8</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).