

SANOFI,
Opposer,

-versus-

AMBICA INTERNATIONAL TRADING
CORPORATION,
Respondent- Applicant.

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IPC No. 14-2014-00313
Opposition to:
Appln. Serial No. 4-2014-005513
Date Filed: 06 May 2014
TM: "ATORPHIL"

NOTICE OF DECISION

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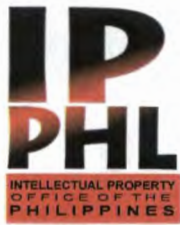
GREETINGS:

Please be informed that Decision No. 2016 - 242 dated July 12, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 12, 2016.

For the Director:

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



SANOFI

Opposer,

-versus-

AMBICA INTERNATIONAL TRADING CORPORATION,

Respondent-Applicant.

x-----x

IPC No. 14-2014-00313

Opposition to:
Application No. 4-2014-005513
Date Filed: 06 May 2014
Trademark: "ATORPHIL"

Decision No. 2016- 242

DECISION

SANOFI¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-005513. The application, filed by Ambica International Trading Corporation² ("Respondent-Applicant"), covers the mark "ATORPHIL" for use on "pharmaceutical preparations namely anti cholesteremic agent" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

"IV.
"GROUNDS IN SUPPORT OF THIS OPPOSITION

"7. The Respondent-Applicant's application for the registration of the mark ATORPHIL 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 a mark that:

x x x

"8. The Opposer's mark is used on Pharmaceutical Products in International Class 5 that are utilized for, the 'treatment of hypercholesterolemia and prevention of cardiovascular disorders', the Respondent-Applicant's mark will also be used on Pharmaceutical Products in International Class 5 that are also utilized for, the 'treatment of primary hypercholesterolemia, heterozygous familial hypercholesterolemia'. It is noteworthy that both marks will be used on Pharmaceutical Products in International Class 5 that are used to treat exactly the same medical condition.

x x x

"9. Moreover, the Respondent-Applicant's mark closely resembles and is very similar to the Opposer's ATORWIN mark that was previously registered in the

¹A foreign corporation organized and existing under the laws of France with principal address at 54, rue la Boetie, 75008 Paris, France.
²A domestic corporation with address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque City, Metro Manila, Philippines.
³The 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.

Philippines and in other countries around the world. The resemblance of the Opposer's and the Respondent-Applicant's respective marks is evident even with a simple evaluation of the contending marks, to wit:

- "9.1. Both marks are purely word marks;
- "9.2. Both marks consist of three (3) syllables, i.e. 'A-TOR-WIN'
- "9.3. The first two (2) syllables of both marks are identical, i.e., 'ATOR'. The only difference between both marks is the last syllable, i.e., 'WIN' and 'PHIL' - and as such, the marks are Almost identical;
- "9.4. The Respondent-Applicant's mark and the Opposer's mark and the Opposer's mark are undoubtedly phonetically similar;
- "9.5. Both marks are used on Pharmaceutical Products in International Class 5 that are utilized in the treatment of primary Hypercholesterolemia and prevention of cardiovascular disorders;
- "9.6. Both marks are used for similar goods, namely for pharmaceutical preparations under Class 5.
- "9.7. The Respondent-Applicant's ATORPHIL mark may be believed to be derived from the Opposer's ATORWIN mark.

"10. Out of all the possible combinations of the letters of the alphabet, the Respondent-Applicant chose to use ATORPHIL 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 that will be manufactured by both parties refer to the same type of pharmaceutical product, with the same medicinal/therapeutic indication, used to treat the same diseased/ailments, in the same class of goods and which flow through the same channels of trade.

"11. Goods bearing the Opposer's mark ATORWIN and the Respondent-Applicant's mark ATORPHIL will be 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-Applicant's mark ATORPHIL for goods bearing the Opposer's mark ATORWIN. Naturally, consumers would merely rely on recollecting the dominant and distinct wording of the marks. There is great similarity and not much difference between the Opposer's mark ATORWIN and the Respondent-Applicant's mark ATORPHIL. Thus, confusion will likely arise and could necessarily cause the interchanging of one product with the other.

"12. The Respondent-Applicant's mark, 'ATORPHIL' resembles the Opposer's 'ATORWIN' mark. The Respondent-Applicant conveniently used the suffix 'PHIL' while adopted the prefix 'ATOR' on its mark. The stubborn fact remains that both marks are: (1) word marks; (2) belong to the same International Class 5; (3) have the same medicinal/therapeutic indication and are used to treat the same diseases/ailments; and (4) will be used on products that will be available to the consuming public in the same channels of trade, i.e., pharmacies or drugstores.

"13. 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

"14. It is clear that the registration and use of the Respondent-Applicant's mark ATORPHIL may cause confusion in the minds of the Filipino consuming public by usurping the mark ATORWIN, a mark legally owned by Opposer, and passing off its own products, as those manufactured by the Opposer.

"15. The Respondent-Applicant seeks to register the mark ATORPHIL 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 public as to the source of goods, and will inevitably false suggest a trade connection between the Opposer and the Respondent-Applicant.

"16. 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

"Allowing Respondent-Applicant to use the mark 'ATORPHIL' on the goods under International Class 5, would not only allow it to take a free ride and reap the advantages of the goodwill and reputation of the Opposer's mark, but it would also confuse the consuming public who would be led to believe that the products sold by the Respondent-Applicant are produced and manufactured by the Opposer, or at the very least, a variant of the Opposer's products. Clearly, the risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the general purchasing public could reasonably be misled into believing that the goods of the parties originated from one and same source.

"17. In *Morgenstern*, the Court noted that it is common knowledge that mistakes or confusion occurring in filing handwritten prescriptions which are not legible. In arriving at this conclusion, the Court of Appeals in *Morgenstern* appropriately ruled that:

x x x

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

x x x

"19. Furthermore, 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'.

"20. Thus, the denial of the registration of Trademark Application No. 4/2014/005513 for the mark ATORPHIL by this Honorable Office is authorized and warranted under the provisions of the Intellectual Property Code of the Philippines.

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, the Legal Director Trade Marks of Opposer, SANOFI.⁴

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

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 09 October 2014. Respondent-Applicant filed the Answer on 18 December 2014. Thereafter, the Bureau issued Order No. 2015-060 dated 09 January 2015 directing the Respondent-Applicant to submit the original Secretary's Certificate within ten (10) days from receipt of the said Order. Said Respondent-Applicant, however, submitted a certified true copy of the Secretary's Certificate only on 13 May 2015. Pursuant to Rule 2, Sec. 10 of the Amended Rules and Regulations on Inter Partes Proceedings (promulgated through Office Order No. 99, s. 2011 which took effect on 17 July 2011), the Respondent-Applicant was declared in default for failure to complete the requirements of the Verified Answer.

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

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
 - (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 06 May 2014, the Opposer has an existing trademark registration for the mark ATORWIN under Trademark Reg. No. 4-2011-002793 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 namely anti cholesteremic agent" under Class 05.

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

ATORWIN

ATORPHIL

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 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 "PHIL" 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. 4-2014-005513

⁵ Merriam-Webster dictionary definition of ATORVASTATIN.

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

together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 12 JUL 2016.


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