

SANOFI,
Opposer,

-versus-

SYNERGEN ASIA PTE. LTD.,
Respondent- Applicant.

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} **IPC No. 14-2013-00417**
} Opposition to:
} Appln. Serial No. 4-2013-001309
} Date Filed: 06 February 2013
} **TM: "SYNATOR"**
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}

NOTICE OF DECISION

CESAR C. CRUZ AND PARTNERS
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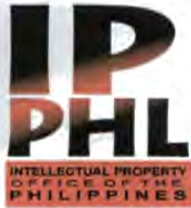
GREETINGS:

Please be informed that Decision No. 2016 - 260 dated July 26, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 26, 2016.

For the Director:

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



SANOFI,

Opposer,

IPC NO. 14 – 2013 - 00417

- versus -

Opposition to:
Trademark Application Serial No. 4-
2013-001309

SYNERGEN ASIA PTE. LTD.,
Respondent-Applicant.

TM: "SYNATOR"

x-----x

DECISION NO. 2016 - 260

DECISION

SANOFI (Opposer)¹ filed an Opposition to Trademark Application Serial No. 4-2013-001309. The trademark application filed by SYNERGEN ASIA PTE. LTD., (Respondent-Applicant)², covers the mark SYNATOR for services under Class 5 of the International Classification of Goods³ particularly, "*pharmaceutical – antihyperlipidaemic agents.*"

The pertinent portions in the Opposition are quoted as follows:

"3. The Opposer is the owner of the internationally well-known WINATOR mark by prior actual use in commerce and prior registration in the Philippines. The Opposer first registered its internationally well-known WINATOR mark in the Philippines in 2000.

"4. The Opposer is the owner of the internationally well-known WINATOR mark by prior actual use in commerce and prior registration worldwide. x x x

"5. The Opposer first registered its internationally well-known WINATOR mark January 14, 2013. The Opposer has been using the mark openly and continuously around the world since then. To date, the WINATOR mark is protected in various jurisdictions worldwide.

"6. The Opposer has extensively sold and promoted its products bearing its internationally well-known WINATOR trade mark across the world and has been doing so prior to the Respondent-Applicant's filing of its trademark application for the mark SYNATOR with this Honorable Office.

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

² A corporation with office address at 20 Maxwell Road, # 07-01 Maxwell House, Singapore.

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.*

“7. As a result of its promotion, sales and of the excellence of Opposer’s goods, the Opposer has built and now enjoys valuable goodwill in its business as represented by its internationally well-known WINATOR mark. The internationally well-known WINATOR mark has become distinctive for the Opposer’s pharmaceutical products sold all over the world.

“8. Notwithstanding the prior use and prior registration of the Opposer’s internationally well-known WINATOR mark, the Respondent-Applicant SYNERGEN ASIA PTE LTD [SG], filed Trademark Application No. 4-2013-00001309 for SYNATOR on February 6, 2013 with this Honorable Office.

“9. The Opposer has not consented to the Respondent-Applicant’s use and registration of the mark SYNATOR or any other mark identical or similar to its internationally well-known WINATOR mark for that matter.

To support its Opposition, the Opposer submitted the following exhibits:

1. Authenticated Special Power of Attorney in favor of Cesar C. Cruz and Partners;
2. Affidavit of Edith Gourtay;
3. List of Trademark Applications and/or Registrations for Winator
4. Copy of the Certificate of Registration of Singapore for Trademark Winator

This Bureau served a Notice to Answer to the Respondent-Applicant on 22 January 2014. However, the Respondent-Applicant did not file an Answer to the Opposition. In view of the failure to file an Answer, an Order dated 15 May 2014 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue in the present case is whether to allow the registration of herein Respondent-Applicant “SYNATOR” trademark.

The instant opposition is primarily 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 trademarks subject of the instant case are reproduced below for examination.

WINATOR

SYNATOR

Opposer’s Trademark

Respondent – Applicant’s Trademark

Upon perusal of the two competing trademarks and the evidence submitted by the Opposer, this Bureau finds the Opposition meritorious.

Five (5) of the seven (7) letters of the competing wordmarks, specifically, “N”, “A”, “T”, “O” and “R”, are the same. Also, the two competing marks are both composed of three (3) syllables. The close similarities in the syllables and phonetic effects in the two trademarks create similar impression on the buying the public. The variances in the first two letters of the two marks are negligible. In fact, the phonetic effect of “Y” in the Respondent-Applicant’s mark is the same with “I” in the Opposer’s. Thus, the minimal differences are not enough to distinguish the two word marks from each other.

Our Supreme Court has consistently held that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.⁴ The Court has ruled that the following words: Duraflex and Dynaflex;⁵ Lusolin and Sapolin;⁶ Salonpas and Lionpas;⁷ and Celdura and Cordura⁸ are confusingly similar. In addition, the Supreme Court, citing *Unfair Competition and Trade Marks, 1947, vol. 1* by Harry Nims, recognized the confusing similarities in sounds of the following trademarks: “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 Fermetex”; and “Zuso” and “HooHoo.”⁹ Evidently, the subject trademarks “SYNATOR” and “WINATOR” fall squarely within the purview of this *idem sonans* rule.

Furthermore, based on the records, at the time the Respondent-Applicant filed its trademark application on 6 February 2013, the Opposer has a prior trademark application for its mark covering “*pharmaceutical preparations*” under Class 5. The trademark application matured into registration on 16 May 2013. The goods indicated in the application /registration, i.e. “pharmaceutical preparation” is broad and encompassing to include those indicated in the Respodent-Applicant’s trademark application. Thus, there is the likelihood that the product of the Respondent-Applicant may be confused with the Opposer’s. The public may even be deceived that Respondent-Applicant’s products originated from the Opposer, or that there is a connection between the parties and/or their respective goods.

The field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another’s mark if there was no intent to take advantage of the goodwill generated by the other mark.¹⁰

⁴ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁵ American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries, G.R. L-26557 18 Fenruary 1970

⁶ Sapolin Co. vs. Balmaceda, 67 Phil 795

⁷ Marvex Commercial Co., Inc. vs. Petra Hawpa and Co, G.R. No. L-19297, 22 December 1966

⁸ Co Tiong vs. Director of Patents, 95 Phil 1

⁹ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

¹⁰ American Wire & Cable Company vs. Dir. Of Patent , G.R. No. L-26557, February 18, 1970.

Time and again, it has been held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.¹¹ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.¹² Because the respondent-applicant will use his mark on goods that are similar and/or closely related to the opposer's, the consumer is likely to assume that the respondent-applicant's goods originate from or sponsored by the opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:¹³

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

This Bureau, therefore, finds that the Respondent-Applicant's mark is proscribed under Section 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 42013001309 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42013001309 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 26 JUL 2016


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

¹¹ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

¹² Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

¹³ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987