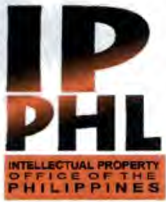


R-1081

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THERAPHARMA, INC.,
Opposer,

-versus-

SANOFI,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00547
Opposition to :
Appln. No. 4-2013-006357
Date Filed: 03 June 2013

TM : "LIFSAR"

NOTICE OF DECISION

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Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 355 dated October 05, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 05, 2016.

Marilyn F. Retual
MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

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THERAPHARMA, INC.,
Opposer,

-versus-

SANOFI,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00547

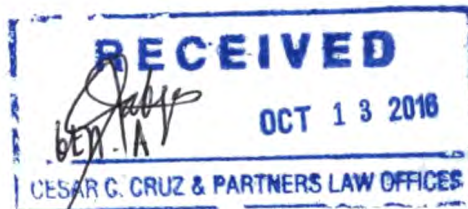
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MARILYN F. RETUAL
IPRS IV
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THERAPHARMA, INC.,

Opposer,

-versus-

SANOFI,

Respondent-Applicant.

X ----- X

IPC No. 14-2014-00547

Opposition to Trademark

Application No. 4-2013-0006357

Date Filed: 03 June 2013

Trademark: **"LIFSAR"**

Decision No. 2016- 355

DECISION

Therapharma, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-0006357. The contested application, filed by Sanofi² ("Respondent-Applicant"), covers the mark "LIFSAR" for use on "*pharmaceutical preparations*" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's applied mark "LIFSAR" is confusingly similar with its own mark "LIFEZAR". It claims that it has dutifully filed its Declaration of Actual Use ("DAU") and Affidavit of Actual Use and that it likewise registered its product with the Food and Drug Administration ("FDA"). It prides its brand "LIFEZAR" for being acknowledged and listed by the Intercontinental Marketing Services (IMS) as one of the leading brands in the Philippines in the category of "*C09C – Angiotems – II Antag, Plain Market*" in terms of market share and sales performance. In support of its Opposition, the Opposer submitted the following as evidence:⁴

1. copy of the pertinent page of the IPO E-Gazette publishing Respondent-Applicant's application;
2. certified true copy of Certificate of Registration No. 4-2004-004304;
3. certified true copies of the DAU and Affidavit of Actual Use;
4. certified true copy of the Certificate of Product registration No. DRP-2675-01;
5. product sample; and
6. copy of the certification and sales performance issued by IMS.

¹ A domestic corporation with office address at 3F Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Metro Manila, Philippines.

² A foreign corporation with office address at 54 Rue La Boetie 75008 Paris, France.

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 Marked as Exhibits "A" to "G".

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The Respondent-Applicant filed its Answer on 23 March 2015 alleging, among others, that the competing marks are not confusingly similar. It contends that the mark "LIFSAR" cover medicinal products, which are not ordinary household items bought at a minimal cost and as such, the purchasing public would be more cautious in their purchase. It also asserts that the mere fact that "LIFSAR" and "LIFEZAR" are sold in the same channels of trade does not necessarily cause confusion. It reasons that pharmacists are mandated to proceed with extreme caution in dispensing pharmaceutical products prescribed by physicians and that it is common practice in the Philippines for drugstores to employ pharmacists and/or pharmacy assistants to assist buyers in their purchasers. The Respondent-Applicant's evidence consists of the list of the trademark applications/registrations for "LIFSAR" and copies of its registration certificates.⁵

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, failed to settle their dispute through mediation. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 07 January 2016. Thereafter, the parties submitted their respective position papers. After which, the case is deemed submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark application for "LIFSAR" should be allowed.

Section 123.1 (d) of RA 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. A mark cannot be registered if it:

(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;

xxx."

Records reveal that the Opposer filed an application for its mark "LIFEZAR" as early as 14 May 2004. The Certificate of Registration No. 4-2004-004304 was eventually issued to it on 31 October 2005. On the other hand, the Respondent-Applicant filed its application for the contested mark "LIFSAR" only on 03 June 2013.

The question is whether the competing marks, as shown hereafter, are confusingly similar:

⁵ Marked as Annex "A" and "B".

Lifezar

LIFSAR

Opposer's mark

Respondent-Applicant's mark

Perusing the competing marks, it appears that the Respondent-Applicant merely substituted the letters "EZ" in the Opposer's mark for the letter "S". These dissimilarity notwithstanding, the marks "LIFEZAR" and "LIFSAR" still look and sound alike. Noteworthy, the letters "Z" and "S" are almost the same sounding. After all, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁶ Aptly, the Supreme Court held in the case of **Del Monte Corporation vs. Court of Appeals**⁷, thus:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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

⁶ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁷ G.R. No. L-78325, 25 January 1990.

deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁸

Furthermore, it is noteworthy that both marks cover goods under Class 05. The Opposer's registration covers "*anti-hypertensive medicinal preparation*", which is closely-related, if not similar, to the Respondent-Applicant's "*pharmaceutical preparations*". Hence, it is highly likely that consumers of one will confuse or mistake "LIFSAR" as being a mere variation of or in any way connected to "LIFEZAR", and vice-versa. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitations, the unanswered riddle is why of the millions of terms and the combinations of letters and designs available, the Respondent-Applicant has 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.⁹

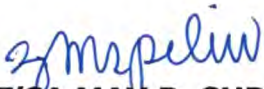
Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market 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.¹⁰ The Respondent-Applicant's trademark fell short in meeting this function.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-0006357 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 05 OCT 2016


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁸ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

⁹ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

¹⁰ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.