

**SANOFI,**  
*Opposer,*

**-versus-**

**INNOGEN PHARMACEUTICALS, INC.,**  
*Respondent-Applicant.*

X-----X

}	<b>IPC No. 14-2014-00079</b>
}	Opposition to:
}	Appln. Serial No. 4-2013-012793
}	Date Filed: 24 October 2013
}	
}	
}	<b>TM: VALGARD</b>

**NOTICE OF DECISION**

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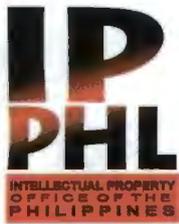
**GREETINGS:**

Please be informed that Decision No. 2017 - 95 dated 29 March 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 29 March 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



**SANOFI,**

Opposer,

-versus-

**INNOGEN PHARMACEUTICALS, INC.,**

Respondent-Applicant.

IPC No. 14-2014-00079

Opposition to Trademark

Application No. 4-2013-012793

Date Filed: 24 October 2013

Trademark: "VALGARD"

X ----- X Decision No. 2017- 95

### DECISION

Sanofi<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-012793. The contested application, filed by Innogen Pharmaceuticals, Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "VALGARD" for use on "*anti-hypertension medication*" under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the provision of Section 123.1 (d) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code). It alleges, among others, that "VALGARD" is confusingly similar to its registered mark "VALGRIX" especially that both are used for medicinal and pharmaceutical products. In support of its Opposition, the Opposer submitted the affidavit of its Legal Director Trademark, Sylvie Guillas, with annexes.<sup>4</sup>

The Respondent-Applicant filed its Answer on 19 June 2014 denying that its applied mark is confusingly similar to that of the Opposer's. It claims that products covered by the mark "VALGARD" contain *valsartan* as active ingredient. It also avers that confusion is remote as under the generics law, pharmaceutical products are to be sold in standard format and that the doctors should issue prescription using the generic name with the trademark only as an option. The Respondent-Applicant's evidence consists of the affidavit of Sonny Bob Cardinal, with annexes.<sup>5</sup>

During the scheduled Preliminary Conference on 23 October 2014, only counsel for the Opposer appeared. The Opposer was directed to submit its position papers within ten days therefrom. For the failure of the Respondent-Applicant to

<sup>1</sup> A corporation duly organized and existing under and by virtue of the laws of France with principal address at 54, rue de la Boetie, Paris, France.

<sup>2</sup> With known address at 29 Scout Bayoran Street, Quezon City, Metro Manila.

<sup>3</sup> 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.

<sup>4</sup> Marked as Exhibit "B", inclusive.

<sup>5</sup> Marked as Exhibit "1", inclusive.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

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attend and/or representative to attend, it is considered to have waived its right to submit position paper.

The primordial issue in this case is whether the trademark "VALGARD" should be allowed.

Records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing application for the mark "VALGRIX" under Certificate of Registration No. 4-2013-000657 issued on 30 May 2013. The application covers "*pharmaceutical preparations*".

But are the competing marks, as shown below, confusingly similar?

**VALGRIX VALGARD**

*Opposer's mark*

*Respondent-Applicant's mark*

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.<sup>6</sup> Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The manifest similarity between the competing marks is their first syllable "VAL". The said syllable, however, is part of the generic name *valsartan*. As such, no person and/or entity can claim exclusive use thereof. The so-called descriptive terms, which may be used to describe the product adequately, cannot be monopolized by a

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<sup>6</sup> Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

single user and are available to all. It is only natural that the trade will prefer those marks which bear some reference to the article itself.<sup>7</sup>

Moreover, the Trademark Registry of this Office reveals several other trademarks involving goods under Class 05, registered in favor of different proprietors that appropriate the "VAL" as the first syllable of their marks including "VALAZYD" and "VALTIZART". Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's. What will then determine whether the marks are confusing are the words and/or device that accompany the same and also the design or style of the marks. In this case, the last syllable "GRIX" in the Opposer's mark is easily distinguishable from "GARD" in the Respondent-Applicant. The two are obviously different in spelling and pronunciation such that confusion is unlikely.

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.<sup>8</sup> In this case, the Respondent-Applicant's mark met this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-012793 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 29 MAR 2017

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

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<sup>7</sup> Ong Ai Gui vs. Director of Philippines Patent Office, G.R. No. L-6235, March 28, 1955.

<sup>8</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.