



SANOFI,
Opposer,

-versus-

WOCKHARDT LIMITED,
Respondent- Applicant.

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IPC No. 14-2014-00080
Opposition to:
Appln. Serial No. 4-2013-009705
Date Filed: 13 August 2013
TM: "LOGULIN"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 137 dated April 24, 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, April 24, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

SANOFI,

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-versus-

WOCKHARDT LIMITED,
Respondent-Applicant.

} **IPC NO. 14-2014-00080**

} Opposition to:

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} Appln. Ser. No. 4-2013-009705

} Date Filed: 13 August 2013

} Trademark: **LOGULIN**

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x-----x} Decision No. 2017- 137

DECISION

SANOFI , (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2013-009705. The application, filed by WOCKHARDT LIMITED. (Respondent-Applicant)², covers the mark “LOGULIN”, for use on “medicinal and pharmaceutical preparations” under Class 5 and “devices and surgical instruments, medical and dental and veterinarians as well as members, artificial eyes and teeth, orthopaedic articles, suture material and medical apparatus used for the delivery of inhaled insulin and the delivery of insulin to the body” under class 10 of the International Classification of Goods³.

The Opposer anchors its opposition, on the following grounds:

“7. The Respondent-Applicant’s application for the registration of the mark LOGLUWIN 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 prohibit the registration of a mark that:

Sec. 123.1. Registrability. 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.

¹ A corporation organized and existing under the laws of France with address at 54, Rue de la Boetie, paris, France

² A corporation organized and existing under the laws of India with address at Bandra, Kurla Complex, Bandra east Mumbai, 400051, Maharashtra, India

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.

(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 and services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to the 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.”

“8. While the Opposer’s mark is used for medicinal and pharmaceutical preparations and/or products under Internationals Class 5, the goods of the Respondent-Applicant’s for which registration is sought, is designed similarly for ‘anti-hypertension preparation, which is exactly under the same International Class 5 as that of Opposer’s product on which its LOGLUWIN mark is intended to be used. Xxx

“9. Moreover, the Respondent-Applicant’s mark closely resembles and is very similar to the Opposer’s LOGLUWIN mark that was previously registered in the Philippines and elsewhere in the world. Xxx

“11. Goods bearing the Opposer’s mark LOGLUWIN and the Respondent-Applicant’s mark LOGULIN will commercially available to the public through the same channels of trade such that a non-discriminating buyer might confuse and interchange the products bearing the Respondent-Applicant’s mark LOGULIN for goods bearing the mark the Opposer’s mark LOGLUWIN. 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 LOGLUWIN and the Respondent-Applicant’s LOGULIN. Thus, confusion will likely arise and could necessarily cause the interchanging of the products with each other. Xxx

“14. It is clear that the registration and use of the Respondent-Applicant’s mark LOGULIN may cause confusion in the minds of the Filipino consuming public by usurping the mark LOGLUWIN, a mark legally owned by Opposer, a passing off its own products, as those manufactured by the Opposer. xxx”

To support its opposition, the Opposer submitted the Special Power of Attorney dated 13 March 2014 and Affidavit of Sylvie Guillas 13 March 2014.⁴

The Respondent-Applicant filed its Answer on 31 July 2014, alleging among other things, the following:

⁴ Annexes “A” and “B”

“4.2. Respondent-Applicant was founded in 1967 by Dr. habil Khorakiwala, an alumnus of Purdix ue University and Harvard University. Since its inception in the 1060’s , Respondent-Applicant has grown to be a multinational enterprise active in the fields of pharmaceuticals, biotechnology and hospitals and one of India’s leading healthcare businesses.

“4.3. To date, Respondent-Applicant has full-fledged operations in the USA, UK, Ireland and France. It also has a marketing presence in emerging markets of Russia, brazil, Mexico, Vietnam, Philippines, Nigeria, Kenya, Ghana, Tanzania, Uganda, Nepal, Myanmar, Sri Lanka, Mauritius, Lebanon and Kuwait.

“4.4. Respondent-Applicant is the first Asian pharmaceutical company – and the first outside the United States and Europe – to develop, manufacture and market recombinant human insulin product. Xxx

“4.6. The mark LOGULIN’ is coined from the combination of the arbitrary text string ‘LOG-‘ and the suffix ‘ULIN’ to denote an insulin product. Xxx

Respondent-Applicant further alleges “that there is no confusing similarity between Respondent-Applicant’s ‘Logulin’ and Opposer’s ‘Logluwin’ and the absence of any registrability report from the IPO confirms that LOGULIN mark is distinctive and thereby registrable.”

The Preliminary Conference was held on 5 November 2015 where both parties were directed to file their respective position papers.

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

Records show that at the time Respondent-Applicant applied for registration of the mark “LOGULIN” the Opposer already registered the mark LOGLUWIN under Registration No. 4-2013-005594 issued on 14 November 2013 for the mark “LOGLUWIN for goods under class 5, namely : “anti-hypertensive preparations”. Respondent-Applicant’s trademark application is applied on goods under class 5, namely: “medicinal and pharmaceutical preparations” and “devices and surgical instruments” under class 10.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Opposer’s mark

Respondent-Applicant’s mark

LOGLUWIN

LOGULIN

The marks are almost the same, having the same prefix "LOG" and last letters "IN", differing only in the middle, "LUW" and "UL". Even if the marks of the parties are almost identical, the kind, nature or type of goods upon which the marks are to be applied must be considered in determining the likelihood of confusion. The Opposer uses its mark on class 5 goods, particularly "anti-hypertensive preparations" while the Respondent-Applicant uses its mark on "devices and surgical instruments etc." under class 10 and anti-diabetic medications under class 5, hence, the suffix "ULIN" from the word "INSULIN". The target market or consumers are also different, thus it is unlikely that on account of the identity of the marks LOGLUWIN and LOGULIN, the public would be vulnerable to confusion much less deception.

It is basic in trademark law that the same mark can be used on different types of goods. The Supreme Court in *Philippine Refining Co. Inc. v. Ng Sam*⁵ held:

A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." ¹ Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Such restricted right over a trademark is likewise reflected in our Trademark law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.

In *Canon Kabushiki Kaisha v. Court of Appeals*⁶ likewise held:

xxx petroleum products on which the petitioner therein used the trademark ESSO, and the product of respondent, cigarettes are "so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods". Moreover, the fact that the goods involved therein flow through different channels of trade highlighted their dissimilarity xxx

Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of petitioner that confusion of business or origin might occur if private respondent is allowed to use the mark CANON."

Because the marks are used on products of different nature, confusion and deception is unlikely. There is no likelihood of confusion of business. It is improbable for one who is buying or patronizing Opposer's anti-hypertensive drugs to be reminded of the Respondent-Applicant's mark "LOGULIN" which is applied on a devices and surgical instruments.

⁵.GR. No. L-26676 July 30, 1982

⁷ G R. 120900 July 20, 2000

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-009705 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 24 APR 2017



ATTY. ADORACION U. ZARE, LL.M
Adjudication Officer
Bureau of Legal Affairs