

**SANOFI,**  
*Opposer,*

**-versus-**

**AJANTA PHARMA PHILIPPINES, INC.,**  
*Respondent-Applicant.*

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**IPC No. 14-2013-00331**  
Opposition to:  
Appln. Serial No. 4-2013-0002910  
Date Filed: 15 March 2013

**TM: ATORPRIN**

**NOTICE OF DECISION**

**CESAR C. CRUZ & PARTNERS**

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**AJANTA PHARMA PHILIPPINES, INC.**

*Respondent- Applicant*  
Unit 710 Philippine Axa Life Center  
1286 Sen. Gil Puyat Avenue corner Tindalo Street,  
Brgy. San Antonio, Makati City

**GREETINGS:**

Please be informed that Decision No. 2017 - 179 dated 01 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPPL 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, 01 June 2017.

**MARILYN F. RETUAL**  
IPRS IV

Bureau of Legal Affairs

**Republic of the Philippines**  
**INTELLECTUAL PROPERTY OFFICE**

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SANOFI,	} IPC NO. 14-2013-00331
Opposer,	} Opposition to:
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-versus-	} Appln. Ser. No. 4-2013-0002910
	} Date Filed: 15 March 2013
	}
AJANTA PHARMA PHILIPPINES, INC.,	} Trademark: "ATORPRIN"
Respondent-Applicant.	}
x-----x	} Decision No. 2017- 179

**DECISION**

SANOFI, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2013-0002910. The application, filed by AJANTA PHARMA PHILIPPINES, INC. (Respondent-Applicant)<sup>2</sup>, covers the mark "ATORPRIN", for use on "drug/ pharmaceutical product with two active ingredients, taken orally, with pharmacologic category as anti-hyperlipidemia and anti-platelet" under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer relies, among other things, on the following grounds in support of its opposition:

"2. The Respondent-Applicant's application for registration of the mark ATORWIN should not be accepted by this Honorable Office since to do so would be contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code of the Philippines, which prohibits the registration of a mark that:

- (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;

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<sup>1</sup> A foreign corporation duly organized and existing under the laws of France with address at 54 Rue La Boetie 75008 Paris, France

<sup>2</sup> A corporation with address at Unit 710, Philippine AXA Life Center, No. 1286 Sen. Gil Puyat Ave. Cor. Tindalo St., Barangay San Antonio, Makati City

<sup>3</sup> 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.”

“12. The act of the Respondent-Applicant in adopting the mark ATORPRIN for its pharmaceutical products in International Class 5 is clearly an attempt to trade unfairly on the goodwill, reputation and consumer awareness of the Opposer’s internationally famous ATORWIN mark that was previously registered before this Honorable Office. Such act of the Respondent-Applicant results in the diminution of the value of the Opposer’s internationally famous ATORWIN mark.

“13. The Opposer’s internationally famous ATORWIN mark is registered in International Class 5, for pharmaceutical products, similar to the class to which the Respondent-Applicant seeks registration for its ATORPRIN mark. The Respondent-Applicant intends to use the ATORPRIN mark on good relating to the treatment of cardiovascular diseases, while the Opposer’s internationally famous mark is also being used as treatment for cardiovascular diseases, making them identical, similar and/or closely related. Further, because the Opposer’s mark is internationally famous, the same is likely to be associated with the Respondent-Applicant’s ATORPRIN mark leading to customer confusion. xxx

“15. The Opposer’s product was first used in Indonesia in 2009, and has been openly and continuously used since then. In the Philippines, the Opposer’s product ATORWIN has been in use since 2011 and was first registered in 2011.

“16. The Respondent-Applicant’s mark ATORPRIN closely resembles and is very similar to the Opposer’s internationally famous ATORWIN mark that was previously registered in the Philippines and elsewhere in the Asia. The resemblance of the Opposer’s and the Respondent-Applicant’s respective marks is most evident upon a juxtaposition of the said marks, xxx

“18. Goods bearing the Opposer’s mark ATORWIN and Respondent-Applicant’s mark ATORPRIN are 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 ATORPRIN for goods bearing the Opposer’s internationally famous mark ATORWIN. It is worthy to mention that the relevant consumers affected herein will be buyers of pharmaceutical

products that treat cardiovascular diseases. Naturally, consumers would merely rely on recollecting the dominant and distinct wording of the marks. There is a great similarity and not much difference between the Opposer's mark ATORWIN and the Respondent-Applicant's mark ATORPRIN. Thus, confusion will likely arise and could necessarily cause the interchanging of one product with the other.

"19. The Respondent-Applicant's ATORPRIN mark so closely resembles the Opposer's internationally famous ATORWIN mark that the Filipino public will undoubtedly confuse one with the other or worse, believe that goods bearing the Respondent-Applicant's mark ATORPRIN originate from the Opposer, or, at least, originate from economically linked undertakings. Xxx

"23. The Opposer's internationally famous mark ATORWIN is used on pharmaceutical products for the treatment of cardiovascular diseases. The goods bearing the Respondent-Applicant's mark ATORPRIN are also pharmaceuticals designated under Class 5 used in the treatment of cardiovascular diseases. The presence of two identical and/or similar pharmaceutical products bearing highly similar trademarks which are used to treat the same illnesses/diseases will undoubtedly cause consumer confusion which may even endanger the health and lives of those Filipino consumers who are unable to differentiate between the origin of the parties respective products. xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Authenticated and legalized Special Power of Attorney;
2. Affidavit of Edith Gourtay dated 22 August 2013 ;
3. Affidavit of Dominic M. Afuang dated 27 September 2013 ;
4. Affidavit of Rogelio N. Laxamana, Jr. dated 27 September 2013; and
5. Affidavit of Gloria L. Menano dated 27 September 2013.<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 30 October 2013. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 5 March 2014, Order No. 2014-266 declaring the Respondent-Applicant in default for failure to file an Answer.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "ATORPRIN", the Opposer already registered the mark "ATORWIN" under of Registration No. 2793 on 6 October 2011. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "pharmaceutical products for the treatment of cardiovascular diseases", while the Respondent-Applicant's trademark

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<sup>4</sup> Annexes "A" to "E"

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application indicates use as “drug/ pharmaceutical product with two active ingredients, taken orally, with pharmacologic category as anti-hyperlipidemia and anti-platelet”.

But do the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

**ATORWIN**

**ATORPRIN**

Opposer’s mark

Respondent-Applicant’s mark

The marks are similar with respect to the six of the seven literal elements, “A-T-O-R-I-N”. The substitution by the Respondent-Applicant of the first letters “PR” for “W” on the mark’s last syllable, hence, ATOR-PRIN, is of no moment. The resultant marks when pronounced are *idem sonans* or phonetically similar. “PRIN” and “WIN” are similar especially so, when combined with the prefix “ATOR” Visually and aurally the marks are confusingly similar. The Supreme Court held:

As to the syllabication and sound of the two trade-names "Sapolin" and "Lusolin" being used for paints, it seems plain that whoever hears or sees them cannot but think of paints of the same kind and make. In a case to determine whether the use of the trade-name "Stephens' Blue Black Ink" violated the trade-name "Steelpens Blue Black Ink", it was said and held that there was in fact a violation; and in other cases it was held that trade-names *idem sonans* constitute a violation in matters of patents and trade-marks and trade-names. (Nims on Unfair Competition and Trade-Mark, sec. 54, pp. 141-147; N. K. Fairbanks Co. vs. Ogden Packing and Provision Co., 220 Fed., 1002.)<sup>5</sup>

Likewise, the Supreme Court in the case of Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents<sup>6</sup> is instructive on the matter, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS"; the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (Co Tiong Sa vs. Director of Patents, 95 Phil. 1 citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., vol. 2, pp. 678-679). xxx

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "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

<sup>5</sup> *Sapolin Co., Inc. v. Balmaceda*, G.R. No. L-45502, 2 May 1939

<sup>6</sup> G.R. No. L-19297, 22 December 1966

"Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the *idem sonans* rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148).


Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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.<sup>7</sup>

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2013-0002910 is hereby **SUSTAINED**. 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, 07 JUN 2017.

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

<sup>7</sup>*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.