

SANOFI,
Opposer,

-versus-

MERCK KGAA,
Respondent- Applicant.

X-----X

IPC No. 14-2015-00574

Opposition to:

Appl. Serial No. 4-2015-010599

Date Filed: 11 September 2015

TM: "AFORTIN"

NOTICE OF DECISION

CESAR C. CRUZ & PARTNERS

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JDF LAW

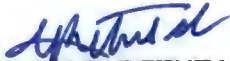
Counsel for Respondent-Applicant
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5th Avenue corner 25th Street
Bonifacio Global City, Taguig

GREETINGS:

Please be informed that Decision No. 2017 - 321 dated August 31, 2017 (copy enclosed) was promulgated in the above entitled case.

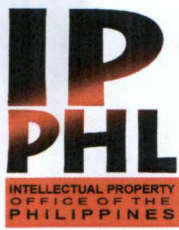
Pursuant to Section 2, Rule 9 of the IPOPHEL Memorandum Circular No. 16-007 series of 2016, any party may appeal the Decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, August 31, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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IPC No. 14-2015-00574
Opposition to:
Application No. 4-2015-010599
Date Filed: 11 September 2015
Trademark: "AFORTIN"
 Decision No. 2017- 321

DECISION

SANOFI¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-010599. The application, filed by Merck KGAA ² ("Respondent-Applicant"), covers the mark "AFORTIN" for use on "*pharmaceutical preparations for the prevention and treatment of cardiovascular diseases*" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
 "GROUNDS IN SUPPORT OF THIS OPPOSITION

"10. The Respondent-Applicant's application for the registration of the mark AFORTIN 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, which prohibits the registration of a mark that:

x x x

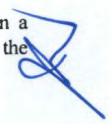
"11. The act of the Respondent-Applicant in adopting the mark AFORTIN for his pharmaceutical products in International Class 5 is clearly an attempt to trade unfairly on the goodwill, reputation and consumer awareness of the Opposer's internationally well-known ATORWIN mark that was previously registered before this Honorable Office. Such act of the Respondent-Applicant results in the diminution of the value of the Opposer's internationally well-known ATORWIN mark.

"12. The Opposer's internationally well-known ATORWIN mark is registered in International Class 5 for, 'Pharmaceutical products for the treatment of cardiovascular diseases', identical to the class to which the Respondent-Applicant seeks registration for its AFORTIN mark and which is being sought for registration under International Class 5 for, 'Pharmaceutical preparations for the prevention and treatment of cardiovascular diseases'. Further, because the Opposer's mark is internationally well-known, the same is

¹With address at 54 Rue La Boetie 75008 Paris, France.

²With address at Frankfurter Strasse 250, 64293 Darmstadt, Germany Fed. Rep.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.



likely to be associated with the Respondent-Applicant's AFORTIN mark leading to consumer confusion.

"13. Goods are closely related when they belong to the same class, or have the same descriptive properties, or when they possess the same physical attributes or characteristics, with reference to their form, composition, texture or quality.

"14. Opposer first filed its registration for the ATORWIN mark in the Philippines on October 6, 2011. Today, there is one ATORWIN trademark registered with the Philippine Intellectual Property Office.

"15. The Opposer's ATORWIN trademark, being the more senior mark, clearly enjoys protection. Jurisprudence is well-settled that protection is accorded to trademarks that have prior, or a more senior registration. As held by the Supreme Court in the case of Berris Agricultural Co., Inc., vs. Norby Abyadang,

x x x

"Clearly, ownership and protection of a trademark is granted from its registration and actual use. The Opposer is undoubtedly the more senior registrant, being first issued a Certificate of Registration in the Philippines in 2013. The Supreme Court has also held that registration of the mark also grants the registrant exclusive right to use the trademark, thereby precluding the Respondent-Applicant, the more junior applicant, from appropriating and using the same.

"16. Certificates of registration that the Opposer has obtained all over the world, included in the Affidavit attached hereto as Annex 'B', is evidence that the Opposer's mark ATORWIN is internationally well-known and warrants protection.

"17. The Opposer's mark ATORWIN and the Respondent-Applicant's mark AFORTIN are identical and/or similar, in the following respects to wit:

- "17.1 Both are purely said works, ATORWIN and AFORTIN;
- "17.2 Both marks are composed of seven letters, i.e., A-T-O-R-W-I-N and A-F-O-R-T-I-N;
- "17.3 Both marks are composed of only three (3) syllables, A-TOR-WIN and A-FOR-TIN, which when applied to identical/similar goods heighten the visual, aural, phonetic and conceptual similarity between the marks;
- "17.4 The only difference between both marks are the letters 'F' and 'T' used by the Respondent-Applicant in its mark while the rest of the letters are identical - and as such, the marks are almost identical;
- "17.5 The Respondent-Applicant's mark and the Opposer's mark are undoubtedly phonetically similar;
- "17.6 Both marks are applied for, used or intended to be used in the similar class of goods namely in International Class 5, specifically for the prevention and treatment of cardiovascular diseases.

"18. The Respondent-Applicant's mark AFORTIN very closely resembles and is very similar to the Opposer's internationally well-known ATORWIN mark that was previously registered in the Philippines and elsewhere in the world. The resemblance of

the Opposer's and the Respondent-Applicant's respective marks is more evident upon a juxtaposition of the said marks.

x x x

"19. Goods bearing the Opposer's mark ATORWIN and the Respondent-Applicant's mark AFORTIN 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 AFORTIN for goods bearing the Opposer's internationally well-known mark ATORWIN. It is worthy to mention that the relevant consumers affected herein will be the buyers of pharmaceutical products. 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 AFORTIN. Thus, confusion will likely arise and would necessarily cause the interchanging of one product with the other.

"20. Considering the fact that the goods involved are related and flow through the same channels of trade, the possibility of confusion is more likely to occur in the light of the fact that ordinary consumers, who are prone to self-diagnose illnesses and purchase prescription drugs even without a doctor's prescription, may mistakenly believe that the goods of the Respondent-Applicant is equivalent to, or affiliated with, the Opposer's goods.

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

"22. In *American Wire & Cable Co. v. Director of Patents*, 31 SCRA 544, 547-548 (1970), the Supreme Court through Justice J.B.L. Reyes ruled:

x x x

"23. In addition, under the rule of *idem sonans*, it is clear that there is a confusing aural similarity between the marks. The Supreme Court has held that the mark 'Gold Top' is 'aurally' similar to 'Gold Toe'. Furthermore, in *McDonald's vs. L.C. Big Mak*, 437 SCRA 10, 34 (2004) citing *Marvex Commercial Co., Inc. vs. Petra Hawpia & Co., et al.*, Phil 295, 18 SCRA 1178 (1966) the Supreme Court held:

x x x

"24. The Honorable Office also had occasion to deny the registration of a trademark under the rule of *idem sonans*. In *Inter Partes Case No. 14-2009-00086* concerning the registration of the trademark 'RENNIE', this Honorable Bureau ruled:

x x x

"The Honorable Office relied on the *idem sonans* rule in denying the registration of the trademark RENNIE. If the Honorable Bureau denied registration of a mark to be used on a pharmaceutical product that treated a different illness from that for which the products of the Opposer are used on, all the more reason for this Honorable Office to likewise deny registration of a junior mark that will be used on a pharmaceutical product that will treat identical illnesses as that for which products bearing the senior mark will be used

on, as in the case of the Opposer's ATORWIN mark and the Respondent-Applicant's AFORTIN mark.

"25. This Honorable Office has also applied the idem sonans rule in the more recent case of Merck KGAA vs. Serville Pharmaceuticals, Inc., where it ruled that:

x x x

"26. The Opposer's internationally well-known mark ATORWIN is used as treatment for cardiovascular diseases. The goods bearing the Respondent-Applicant's mark AFORDIN is applied for 'pharmaceutical preparations for the prevention and treatment of cardiovascular diseases,' designated under International Class 5 which is identical to that of the Opposer's ATORWIN mark. The presence of two identical and/or similar pharmaceutical products bearing highly similar trademarks which are used to treat the same illnesses will indubitably lead to consumer confusion.

"27. In consonance with public policy, it is the duty of this Honorable Office to protect the Filipino purchasing public by ensuring that there is no confusing similarity involving medicinal products. Unlike ordinary goods, confusion of product between medicinal goods may also arise from as a result of a physician's illegible handwriting, thus the need for further protection. This has been recognized in jurisprudence, notably in Morgenstern Chemical Co. v. G.D. Searle & Co., 253 F. 2d 390 (1958).

"28. In Morgenstern, the United States Court of Appeals ruled that the, 'obvious similarity in derivation, suggestiveness, spelling, and sound in careless pronunciation, between 'Micturin' and 'Mictine' as applied to pills to be taken by mouth for therapeutic purposes requires the conclusion, in the circumstances of this case, that the defendant has infringed the rights of the plaintiff in its common-law trade name Micturin and should be restrained from further doing so.

"29 Further, in Morgenstern, the Court also noted that it is common knowledge that mistakes or confusion occurring in filing handwritten prescriptions which are not legible. In arriving at this conclusion, the Court of Appeals in Morgenstern appropriately ruled that:

x x x

"30. The ruling in Morgenstern should squarely be applied in the case at bar. The fact that the medicinal products of the parties are for identical indications highlights the stubborn fact that there exist a possibility of one medicinal product being dispensed for the other medicinal product, which could easily be remedied by requiring clearly dissimilar trademarks in the field of medicinal products. The reputation and goodwill of the Opposer should not be trifled with the talismanic invocation that there is only a remote possibility of confusion. The fact clearly remains that the goods of the parties belong to the same class, are identical, and are available through the same channels of trade. As the Supreme Court in Ang v. Teodoro has aptly stated:

x x x

"31. The case of Glenwood Laboratories, Inc. v. American Home Prod. Corp., 455 F. 2d 1384 (C.C.P.A. 1972), aptly illustrates the danger of confusion as regards medicinal products bearing similar marks, ruling that,

x x x

"32. Further, this Honorable Office has also aptly stated in Inter Partes Case No. 14-2009-000172 concerning the opposition of the trademark 'Solvit' that:

x x x

"33. Of all the possible combinations of the letters of the alphabet and words, the Respondent-Applicant chose to use the mark AFORTIN to identify the goods in International Class 5, which are in direct competition with the Opposer's goods, also in International Class 5. It cannot be gainsaid that confusion will arise inasmuch as the goods are identical, and they cater to the same kind of purchasers. As pharmaceutical products for the treatment of identical illnesses, both will be found and displayed in hospitals, clinics, and pharmacies, probably side by side, making both products flow through the same channels of trade, thus making the Opposer and the Respondent-Applicant competitors in the same product industry. No conclusion can be drawn surrounding the case other than the fact that the Respondent-Applicant is knowingly and deliberately attempting to trade on the valuable goodwill and to ride on the notoriety of the Opposer's internationally well-known ATORWIN mark that has been used throughout the world for several decades including the Philippines.

"34. Clearly, the registration and use of the Respondent-Applicant mark's AFORTIN is a usurpation of the internationally well-known mark ATORWIN, a mark legally owned by the Opposer, as well as the goodwill associated therewith and/or passing off its own products, as those manufactured by the Opposer.

"35. By the Respondent-Applicant's attempt to register and use the mark AFORTIN for its goods in International Class 5, it is plain that the Respondent-Applicant seeks to take advantage of the worldwide and nationwide reputation of the internationally well-known mark ATORWIN that the Opposer has gained by ingenious and persistent marketing and the expenditure of considerable sums of money to promote the same, by confusing and misleading the trade and the Filipino public in passing off its products as those of the Opposer and/or suggesting that they are being sold or are approved by the Opposer.

"36. The Respondent-Applicant seeks to register the mark AFORTIN which is confusingly similar to the Opposer's internationally well-known ATORWIN mark, as to be likely, when applied to the goods of Respondent-Applicant, to cause confusion, mistake or deception to the Filipino public as to the source of goods, and will inevitably falsely suggest a trade connection between the Opposer and the Respondent-Applicant, is simply violative of the Intellectual Property Code of the Philippines.

"37. This Honorable Office has recently ruled in Inter-Partes Case No. 14-2011-00059, regarding the presence of confusion or deception between the marks FERLIN and FERIDIN that:

x x x

"38. The Supreme Court discussed these two types of trademark confusion in *Mighty Corporation, et. al. vs. E. & J. Gallo Winery, et. al.*, G.R. No. 154342, July 14, 2004, 434 SCRA 473, 504, thus:

x x x

"Allowing Respondent-Applicant to use the mark 'AFORTIN' on its goods in International Class 5, would not only allow it to take a free ride and reap the advantages of the goodwill and reputation of the Opposer's mark, but it would also confuse the

consuming public who would be led to believe that the products sold by the Respondent-Applicant are produced and manufactured by the Opposer, or at the very least, a variant of the Opposer's products. Clearly, the risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the general purchasing public could reasonably be misled into believing that the goods of the parties originated from one and the same source.

"39. In the case of Societe Des Produits Nestle, S.A. vs. Dy, Jr., the Supreme Court held that:

x x x

"40. Moreover, in the case of McDonald's Corporation vs. L.C. Big Mak Burger, Inc., et. al., the Supreme Court had occasion to rule that, 'while proof of actual confusion is the best evidence of infringement, its absence is inconsequential'.

"41. Thus, the denial of the registration of Trademark Application No. 4-2015-010599 for the mark AFORTIN by this Honorable Office is authorized and warranted under the provisions of the Intellectual Property Code of the Philippines.

The Opposer's evidence consists of the Special Power of Attorney executed by the Opposer in favor of Cesar C. Cruz and Partners Law Offices and the Affidavit executed by Sylvia Guillas, the Legal Director Trade Mark of SANOFI.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 23 February 2016. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123.Registrability. - 123.1. A mark cannot be registered if it:

x x x

(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;"

(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 or service which are not

⁴Marked as Annexes "A" and "B", inclusive.

similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those 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;

Records show at the time the Respondent-Applicant filed its trademark application on 11 September 2015, the Opposer has an existing trademark registration for the mark ATORWIN under Trademark Reg. No. 4-2011-002793 issued on 06 October 2011. The registration covers "pharmaceutical products for the treatment of cardiovascular diseases" under Class 05. This Bureau noticed that the goods indicated in Respondent-Applicant's trademark application filed on 11 September 2015, i.e. pharmaceutical preparations for the prevention and treatment of cardiovascular diseases under Class 05, are similar to the Opposer's.

Hence, the question, does AFORTIN resemble ATORWIN such that confusion or deception is likely to occur? The marks are shown below:

ATORWIN

Opposer's trademark

AFORTIN

Respondent-Applicant's mark

This Bureau noticed that the products covered by the marks are similar. Designated as AFORTIN, Respondent-Applicant's products are pharmaceutical preparations for the prevention and treatment of cardiovascular diseases. Opposer's products covered under ATORWIN are pharmaceutical products for the treatment of cardiovascular diseases. Confusion is likely in this instance because of the close resemblance between the marks and that the goods are the same and are for human consumption. Both marks have the same syllabication and same five (5) letters "A", "O", "R", "I" and "N". Respondent-Applicant merely changed the second letter "T" with the letter "F" and the fifth letter "W" with the letter "T" in Opposer's ATORWIN mark to come up with the mark AFORTIN. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁵, "SAPOLIN" and LUSOLIN"⁶, "CELDURA" and "CORDURA"⁷, "GOLD

⁵ *MacDonalds Corp. et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁶ *Sapolin Co. v. Balmaceda and Germann & Co.* 67 Phil, 705.

⁷ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, 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...."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.⁸

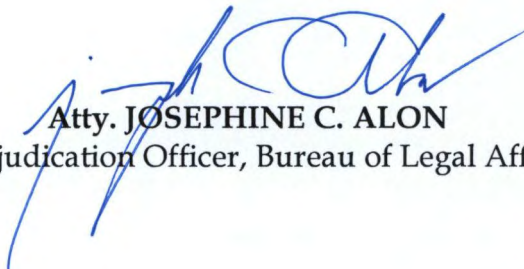
It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public 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.⁹ This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1(d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2015-010599 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 AUG 2017.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁸ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.

⁹ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).