



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

SANOFI,
Opposer,

-versus-

ZENAUST PHARMA, INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00261
Opposition to:
Appln. Ser. No. 4-2015-507191
Date Filed: 21 December 2015

TM: MANIZEN

NOTICE OF DECISION

CESAR C. CRUZ & PARTNERS
Counsel for Opposer
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6811 Ayala Avenue, Makati City


ZENAUST PHARMA, INC.
Respondent-Applicant
1105 Chino Roces Avenue
Brgy. Sta. Cruz, Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 353 dated 09 October 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, 10 October 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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Filing Date: 21 December 2015
Trademark: **MANIZEN**

Decision No. 2017 - 353

DECISION

SANOFI, ¹ ("Opposer") filed an Opposition to Trademark Application No. 4-2015-507191. The application, filed by ZENAUST PHARMA, INC.² ("Respondent-Applicant") covers the mark **MANIZEN** for use on "*pharmaceutical preparations*" under Class 05 of the International Classification of goods³.

The Opposer alleges that the Respondent-Applicant's application for the registration of the mark **MANIZEN** should not be accepted since it would be contrary to Section 123.1 (d) and (f) of the Intellectual Property Code. According to Opposer, the act of the Respondent-Applicant in adopting the mark **MANIZEN** 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 **ZENIMA** mark that was previously registered with this Office which, would result in the diminution of the value of the Opposer's **ZENIMA** mark. Opposer further argues its **ZENIMA** mark is registered in International Class 5, identical to the class which Respondent-Applicant seeks registration of its **MANIZEN** mark. Opposer asseverates also that since its mark is internationally well-known and registered throughout the world, the same is likely to be associated with Respondent-Applicant's **MANIZEN** mark leading to consumer confusion. Opposer also claims that its mark **ZENIMA** was first registered with this Office in 2013 and being the senior mark, it enjoys protection. Opposer further argues that Respondent-Applicant's **MANIZEN** mark very closely resembles to its **ZENIMA** mark.

The Opposer's evidence consists of the following:

1. Legalized and authenticated Special Power of Attorney;
2. Legalized and authenticated Affidavit of Sylvie GUILLAS;
3. List of registrations and applications for the mark **ZENIMA** in various countries;

¹ A corporation duly organized and existing under the laws of France with address at 54 Rue La Boetie 75008 Paris, France.

² A domestic corporation with office address at 1105 Chino Roces Avenue, Brgy. Sta. Cruz, Makati City

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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. Copies of certificates of registration of the mark ZENIMA issued in Brunei Darussalam, Cambodia, Lao P.D.R., Myanmar, Thailand and Singapore;

This Bureau issued on 09 August 2016 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 23 August 2016. The Respondent-Applicant, however, did not file the Answer. On 06 June 2017, Order No. 2017-1242 was issued declaring Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark "ZENIMA"?

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.⁴

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), as amended provides:

SECTION 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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

The records will show that at the time the Respondent-Applicant filed its application for the mark MANIZEN on 21 December 2015, Opposer has no existing registration nor pending application for registration of a similar mark. As such, there was no bar or obstacle to the registration of Respondent-Applicant's mark. The registration of its mark ZENIMA in other countries did not also operate to bar the registration of Respondent-Applicant's mark as protection of trademark is confined to the territory where it is

⁴See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

registered. Opposer's mark also has not attained the status of a well-known mark as to effectively bar registration of Respondent-Applicant's mark on the basis of its registration abroad.

Although, a trademark search in IPOPHL's Trademark Database would show that Opposer's mark ZENIMA was previously registered, its registration was canceled. That is why, Opposer had re-apply for the registration of its mark ZENIMA on 13 January 2016, a date later than the application date of the herein subject trademark. Besides, even assuming that Opposer did not abandon its mark after it was canceled, still the instant opposition cannot be sustained.

A comparison of the mark of the parties shows that they are not confusingly similar as to likely cause confusion, mistake or deception on the part of the purchasers. The marks of the parties are reproduced below:

ZENIMA

Opposer's Marks

maniZEN

Respondent-Applicant's Mark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the 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.⁵ Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

The manifest similarity between the contending marks is the presence of the letters "Z-E-N". The letters "Z-E-N" is the first three letters of Opposer's mark and the last three letters in Respondent-Applicant's mark. However, the presence of these identical letters in the parties' marks does not automatically makes them confusingly similar. Although, both are word marks, they are presented differently. Opposer's ZENIMA is written in plain upper case letters. On the other hand, Respondent-Applicant's mark consists of the letters 'M-A-N-I' written in red-colored plain lower case letters and the letters "Z-E-N" written in blue-colored upper case letters. As such, the marks are visually dissimilar. Further, when pronounced, the marks are also aurally dissimilar. "Appeals to the ear are dissimilar. And this, because in a word- combination, the part that comes first is the most pronounced."⁶ Thus, the likelihood that the consumers or purchasing public will be confused, mistaken or

⁵ *Etepha A.G. v. Director of Patents, G.R. No. L-20635, 31 March 1966.*

⁶ *Supra.*

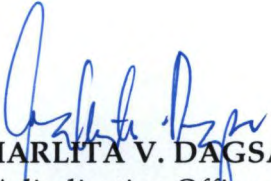
deceived into believing the goods bearing the Opposer's and Respondent-Applicant's mark is the same or that they come from the same source or origin.

Accordingly, the registration of the mark Respondent-Applicant's MANIZEN mark is not contrary to the provision of Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby *DISMISSED*. Let the filewrapper of Trademark Application Serial No. 4-2015-507191, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 OCT 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs