SANOFI-SYNTHELABO, INC.,
Opposer,

-versus-

MEGA LIFESCIENCES CO., LTD.
Respondent-Applicant.
x----------x

IPC No. 14-2009-00096
Case Filed on: 23 March 2009
Opposition to:
Appln. Ser. No. 4-2008-003695
Date Filed: 01 April 2008
Trademark: "AVARIN"

Decision No. 2011-03

DECISION

Sanofi-Synthelabo, Inc. ("Opposer"), a corporation organized and existing under the laws of Delaware, United States of America with principal office address at 55 Corporate Drive, Bridgewater, New Jersey 08807, U.S.A., filed on 23 March 2009 on opposition to Trademark Application Serial No. 4-2008-003695. The trademark application, filed on 01 April 2008 by Mega Lifesciences Co., Ltd. ("Respondent-Applicant"), a company organized under the laws of Thailand with address at 384 SOI 6 Pattana 3 Road, Bangpoo Industrial Estate, Samutprakarn 10280, Thailand, Covers the mark "AVARIN" used for goods in Class 05[1], particularly, "pharmaceutical preparation for antispasmodic and antiflatulent form human use". The subject trademark application was published in the "IPO Gazette" on 21 November 2008.

The Opposer alleges the following:

"1.1. The Opposer is entitled to the benefits granted to foreign national under Section 3 of Republic Act No. 8293, the Intellectual Property Code of the Philippines ('Intellectual Property Code'), which provides:

Section 3. International Conventions and Reciprocity. – Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of un affair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property rights is otherwise entitled by this act.

x x x

'4. On April 1, 2008, the Respondent-Applicant filed with this Honorable Office Trademark Application No. 4-2008-003695 for AVARIN in class 05, specifically for 'pharmaceutical preparation for antispasmodic and antinflatulent for human use'.

"5. The Opposer is the owner of the mark AFAXIN which was originally registered by the Philippine Patent Office on April 5, 1949 under registration No. 1230-S and which registration has been timely renewed covering goods in Class 05, specifically for 'vitamin A preparation for the prevention and treatment of deficiencies of growth-promoting and antiopthalmic vitamin A'.

"6. Under existing law, rules and jurisprudence, the mark AVARIN should not be registered by this Honorable Office because the registration of mark subject of this opposition is contrary to Section 123.1 (d) of the Intellectual Property Code, which prohibits the registration of a mark that:

x x x

(d) Is identical with a registered mark belonging to a different proprietor or mark with an earlier filing or priority date, in respect of:

(i) The same goods 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;

x x x

"7. The Opposer has openly and continuously used the mark AFAXIN in the Philippines, prior to the filing date of the Respondent-Applicant's trademark application for AVARIN on April 1, 2008. Moreover, the Opposer continues to use the AFAXIN mark in the Philippines.

"8. The Opposer likewise has extensively promoted the mark AFAXIN in the Philippines and has this obtained significant exposure for its goods upon which the mark AFAXIN is used.

"9. The Opposer has not consented to the Respondent-Applicant's use and registration of the mark AVARIN, or any other identical or similar to its AFAXIN mark for that matter.

9.1 That the Respondent-Applicant adopted the mark AVARIN for its products also in Class 05 is Cleary an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer's AFAXIN mark that was originally registered by Philippine Patent Office on April 5, 1949 which registration has been timely renewed by the Opposer.

"10. The Respondent-Applicant's mark AVARIN is confusingly similar to the Opposer's mark and is applied for the same class of goods as that of the Opposer's registration, which would be likely to deceive or cause confusion as to the origin of the goods.

10.1 In determining if two trademarks are confusingly similar, it is sufficient if one is a colourable imitation of the other. Colourable imitation means such a close or ingenious imitation as to be calculated to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause to purchase the one supposing it to be the other. Colourable imitation does not mean identity. It does not require that all detail be copied literally. It means such similarity in form, content, words, sounds, meaning, special arrangement, or general appearance of trademark with that of another trademark in their overall presentation of in their essential, substantive, and distinctive parts as would likely mislead or confuse the purchaser in the ordinary course of purchasing the genuine article.

10.2 The Respondent-Applicant's mark resembles the Opposer's AFAXIN mark in terms of spelling, pronunciation and appearance as to be likely to deceive or cause confusion. Hence, the registration of said mark violates Section 123.1 (d) of the Intellectual Property Code.

10.3 The two marks are confusingly similar based on the following factors:

10.3.1 Both AVARIN and AFXIN are word marks.

10.3.2 Both marks are composed of six (6) letters.

10.3.3 Of the six (6) letters, only the second and the fourth letters differ.

10.3.4 A cursory glance at both marks makes it appear as though the marks are exactly the same and may cause confusion

10.3.5 Both AVARIN and AFAXIN are pharmaceutical products in the same class of goods.

"11. By the Respondent-Applicant's use of the mark AVARIN on the goods covered by Application Serial No. 4-2008-003695, the Respondent-Applicant seeks to take the advantage of the reputation and goodwill that the Opposer has established through the years, resulting in the diminution of the value of the trademark AFAXIN.

"12. Of all combination of letters to create a trademark, particularly for a pharmaceutical product as in this case, the Respondent-Applicant chose a combination or mark very similar to Opposer's trademark. Evidently, the Respondent-Applicant's chose its mark to resemble that of the Opposer's and which may cause confusion in the minds of the consumers by usurping the mark AFAXIN, a mark legally owned by the Opposer, and passing off the Respondent-Applicant's own products as those made by the Opposer.

"13. The denial of Trademark Application No. 4-2008-3695 for the mark AVARIN by this Honorable Office is authorized under other provisions of the Intellectual Property Code.

"14. Simultaneous with the filing of this Notice of Opposition, the Opposer will submit evidence in support of the opposition. The Opposer further reserves its rights to present additional evidence to rebut evidence that will be presented by the Respondent-Applicant in support of its Answer to this Notice of Opposition.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 30 April 2009. Respondent-Applicant, however, did not file an answer. Consequently, this Bureau issued Order No. 2009-1710 declaring that the Respondent-Applicant is deemed to have waived the right to file an answer and the case submitted for decision based on the opposition and evidence submitted by the Opposer.

Should the opposition to Trademark Application Serial No. 4-2008-003695 be sustained?

The essence of trademark registration is to give protection to the owner of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure him, who has been instrumental 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; to protect the manufacturer against substitution and sale of inferior and different articles as his products.[1]

Thus, Sec. 123.1 (d) of Rep. Act. No. 8293, also known as the Intellectual Property code of the Philippines ("IP Code") provides that a mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or 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;

The records show that at the time the Respondent-Applicant filed its trademark application on 01 April 2001, the Opposer still has an existing trademark registration (No. 000158) for the mark AFAXIN. The questions are: Are the competing marks used on similar or

closely related goods? Are they identical or resemble each other that deception or confusion is likely to occur?

This Bureau noticed that although belonging to Class 05, the pharmaceutical products on which the parties use their respective marks are of different nature and purposes. The Respondent-Applicant's products are "pharmaceutical preparation for antispasmodic and antiflatulent for human use".[2] on the other hand, the Opposer's products are "vitamin A preparation for the prevention and treatment of deficiencies of growth-promoting and antiopthalmic vitamin A".

Also, a comparison between the competing marks, as shown below, clearly reveals that confusion in this instance is remote and unlikely:

Respondent-Applicant's mark

Opposer's mark

The stroke of the letters "V", "F", "R", and "X", as used in the competing marks, are distinct such that one could easily recognize one mark from the other. The consonants of the competing marks are pronounced differently and distinctly such that no likelihood of confusion may arise in pronouncing, referring to, and likely mistaking one mark for the other mark. The letter "F" when pronounced could not be mistaken for the letter "V", and so is the letter "X" for the letter "R". This, in appearance and in sound, it is unlikely for one to confuse one mark for the other.

In conclusion, this Bureau finds the competing marks not confusingly similar.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 4-2008-003695 is hereby DENIED. Let the file wrapper of the subject Trademark Application be returned, together with a copy this Decision, to the Bureau of Trademarks for information and appropriate action and information.

SO ORDERED.

Makati City, 10 January 2011.