MERCK SHARP & DOHME CORP.,
Opposer,

-versus-

MERCK KGAA,
Respondent- Applicant.

IPC No. 14-2015-00302
Opposition to:
Appln. Serial No. 4-2015-502259
Date Filed: 29 April 2015
TM: "AFORZET"

NOTICE OF DECISION

SANTOS PILAPIL AND ASSOCIATES
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PATRICK MIRANDAH CO., PHILIPPINES, INC.
Respondent-Applicant's Representative
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GREETINGS:

Please be informed that Decision No. 2017 - 267 dated June 29, 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, June 30, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

MERCK SHARP & DOHME CORP.,

Opposer,

- versus -

MERCK KGAA,

Respondent-Applicant.

IPC NO. 14 – 2015 – 00302

Opposition to:
Trademark Application Serial No. 4201500502259

TM: "AFORZET"

DECISION NO. 2017 - 267

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D E C I S I O N

MERCK SHARP & DOHME CORP. (Opposer)[1] filed an Opposition to Trademark Application Serial No. 4-2015-00502259. The trademark application filed by MERCK KGAA (Respondent-Applicant)[2], covers the mark AFORZET for *"pharmaceutical preparations"* under Class 5 of the International Classification of Goods and Services[3].

The Opposer based its Opposition on the following:

> b) Opposer's application for registration of the trademark ATOZET was filed with this Office on September 12, 2014, and its Certificate of Registration which was issued on January 15, 2015 is in full force and effect until January 15, 2025.
>
> c) The trademark AFORZET being applied for registration by respondent is confusingly and deceptively similar to opposer's registered trademark ATOZET, since both marks have 3 syllables, they have the same first letter and the same last 3 letters. Considering their phonetic and visual similarities, there is likelihood of confusion because the difference is very slight, and is far outweighed on balance by the overall similarity in sight and sound.

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[1] A corporation organized under the laws of United States of America with address at One Merck Drive, Whitehouse Station, New Jersey 08889, U.S.A..

[2] A corporation organized under the laws of India with business address at One India Bulls Centre Tower 2-B, 7th Floor, 841 Senapati Bapat Marg, Elphinstone Road (West), Mumbai-400 013, 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.

d) Moreover, respondent's mark AFORZET is used on goods in the exact same class as that of the goods covered by opposer's mark ATOZET, hence they are competing goods, and flow through the same channel of trade.

e) The uncanny similarity in the marks and the use of respondent's mark on identical and/or related goods makes it very obvious that respondent is riding on the popularity of the mark ATOZET and that respondent is passing off its goods to the buying public as those of opposer.

f) Furthermore, the use and registration of the mark AFORZET by respondent will likely cause the dilution of the advertising value and excellent image of opposer's mark ATOZET and will surely weaken their power of attraction.

g) Under the circumstances, the use and registration of the mark AFORZET by respondent will violate opposer's exclusive right over its registered trademark ATOZET, it will cause great and irreparable injury to opposer, and it will likely prejudice the public who might mistakenly believe that respondent's products are those of opposer, or sponsored by, originated from or related to opposer.

The following evidence evidence were submitted to support the Opposition:

Exhibit "A" – Sworn Statement of Ms. Lynn Brumfield;

Exhibit "B" – Certificate of Authority;

Exhibit "C" – Certificate of Registration No. 4-2014-011414; and

Exhibit "D" – Power of Attorney;

This Bureau issued a Notice to Answer and served a copy to the Respondent-Applicant on 9 September 2015. However, the Respondent-Applicant failed to file an Answer. Accordingly, this Bureau issued an Order dated 14 January 2016, declaring the Respondent-Applicant in default, and thus, making this case deemed submitted for decision.

The issue to be resolved in the instant case is whether to allow Respondent-Applicant to register the trademark "AFORZET."

This Opposition is grounded on Section 123.1, par (d), of the Intellectual Property Code of the Philippines (IP Code) which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that when Respondent-Applicant filed its trademark application for "AFORZET" trademark on 29 April 2015, the Opposer has

already a prior and existing trademark registration for the mark "ATOZET" used for identical pharmaceutical preparations. In view of this, there is a need to determine whether the earlier registered trademark of the Opposer is similar to the Respondent-Applicant mark, such that, it will cause deception or confusion on the buying public.

The contending marks are depicted below for comparison:

AFORZET	ATOZET
Respondent – Applicant's Mark	Opposer's Mark

A simple perusal of the two wordmarks readily show that five (5) of the six (6) of the letters in the Opposer's wordmark, particulary, "A" "O" "Z" "E" and "T" can be found in the Respondent-Applicant's mark. Although the middle portion of the Respondent-Applicant's mark changed the letter "T" in the Opposer's mark to letter "F" and added additional consonant "R", the difference is insignificant and not enough to distinguish the Respondent's mark from that of the Opposer. This close similarity creates the same commercial impression on the consumers. Moreover, both of the competing trademarks are composed of three syllables that have almost similar sounding effect – A-TO-ZET *vis a vis* A-FOR-ZET.

Our jurisprudence is replete of rulings providing that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.[4] Accordingly, our Supreme Court has ruled that the following words: Duraflex and Dynaflex;[5] Lusolin and Sapolin;[6] Salonpas and Lionpas;[7] and Celdura and Cordura[8] are confusingly similar. It even recognized the confusing similarities in sounds of the following trademarks: "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 "Meje"; "Kotex" and Fermetex"; and "Zuso" and "HooHoo."[9] No doubt, the trademarks "ATOZET" and "AFORZET" fall squarely within the purview of this *idem sonans* rule.

Our Supreme Court has consistently held that our Intellectual Property law does not require that the competing trademarks must be so identical as to

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[4] Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966
[5] American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries, G.R. L-26557 18 Fenruary 1970
[6] Sapolin Co. vs. Balmaceda, 67 Phil 795
[7] Marvex Commercial Co., Inc. vs. Petra Hawpa and Co, G.R. No. L-19297, 22 December 1966
[8] Co Tiong vs. Director of Patents, 95 Phil 1
[9] Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[10] Our laws do not require actual confusion, it being sufficient that confusion is likely to occur.[11]

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 42015502259 is hereby **SUSTAINED.** Let the filewrapper of Trademark Application Serial No. 42015502259 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 29 JUN 2017

Atty. Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs

[10] American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970
[11] Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992