



**SANOFI,**  
*Opposer,*

**-versus-**

**SUN PHARMA PHILIPPINES,**  
*Respondent-Applicant.*

X-----X

}	<b>IPC No. 14-2013-00314</b>
}	Opposition to:
}	Appln. Serial No. 4-2012-012287
}	Date Filed: 05 October 2012
}	
}	
}	<b>TM: IROVEL</b>

**NOTICE OF DECISION**

**CESAR C. CRUZ AND PARTNERS**  
*Counsel for Opposer*  
3001 Ayala Life-FGU Center  
6811 Ayala Avenue, Makati City

**SUN PHARMA PHILIPPINES, INC.**  
*Respondent- Applicant*  
604 6<sup>th</sup> Floor, Liberty Center Building  
104 H.V. Dela Costa Street,  
Salcedo Village, Makati City

**GREETINGS:**

Please be informed that Decision No. 2017 - 185 dated 01 June 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, 01 June 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

SANOFI,	} IPC NO. 14-2013-00314
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2012-012287
	} Date Filed: 5 October 2012
	}
SUN PHARMA PHILIPPINES,	} Trademark: "IROVEL"
Respondent-Applicant.	}
x-----x	} Decision No. 2017- 185

**DECISION**

SANOFI, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-012287. The application, filed by SUN PHARMA PHILIPPINES, INC. (Respondent-Applicant)<sup>2</sup>, covers the mark "IROVEL", for use on "pharmaceutical applications" under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the following grounds:

"12. The Respondent-Applicant's application for registration of the mark IROVEL 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 the 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; xxx

(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:

<sup>1</sup> A corporation 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 604 6<sup>th</sup> Floor, Liberty Center Bldg., 104 H.V. Dela Costa St., Salcedo Village, 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.

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.

“13. The act of Respondent-Applicant in adopting the mark IROVEL 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 well-known APROVEL 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 APROVEL mark.

“14. The Opposer’s internationally well-known APROVEL mark is registered in International Class 5, for Pharmaceutical Products, identical to the class to which the Respondent-Applicant also intends to use the IROVEL mark. The Respondent-Applicant also intends to use the IROVEL mark on goods relating to pharmaceutical products specifically for the treatment of hypertension and prevention of kidney damage caused by type 2 diabetes, while the Opposer’s internationally well-known mark is being used for the prevention and treatment of high blood pressure or hypertension, making them identical, similar and/or closely related. Further, because the Opposer’s mark is internationally well-known, the same is likely to be associated with the Respondent-Applicant’s IROVEL mark leading to consumer confusion.

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

“16. The Opposer’s mark has been used worldwide for more than ten years. The product was first used and registered in Europe, in 1995, and has been openly and continuously used since then. In the Philippines, the Opposer’s product APROVEL has been in use since 1998 and was first registered in 1995. The Opposer’s claim of priority dates back as far as 1995. Moreover, the 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 APROVEL is internationally well-known and warrants protection.

“17. The Respondent-Applicant’s mark IROVEL closely resembles and is very similar to the Opposer’s internationally well-known APROVEL mark that was previously registered in the Philippines and elsewhere in the world. The resemblance of the Opposer’s and Respondent-Applicant’s respective marks is more evident upon a juxtaposition of the said marks. xxx”

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

1. Special Power of Attorney executed by Joelle Sanit-Hugot;
2. Affidavit of Joelle Sanit-Hugot;
3. Affidavit of Silvestre Dominic M. Afuang; and
4. Affidavit of Lucia I. Sabang.<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 12 November 2013. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 2 April 2014 Order No. 2014-424 declaring the Respondent-Applicant in default for failure to file an Answer.

Records show that at the time Respondent-Applicant applied for registration of the mark "IROVEL" the Opposer already registered the mark "APROVEL" under of Registration No. 4-1996-108527 on 23 June 2000. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "pharmaceutical products for the prevention and treatment of hypertension".

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

Opposer's mark

Respondent-Applicant's mark

The marks are similar with respect to the last syllables, ("RO-VEL"). Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, APROVEL and IROVEL sound the same and are *idem sonans*, differing only in their first letters, "AP" and "I". In determining the issue of confusing similarity, the court has also taken into account the aural effects of the words and letters contained in the mark.<sup>5</sup> Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia*<sup>6</sup>, the Supreme Court held:

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 "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

<sup>4</sup> Annex "A" to "D"

<sup>5</sup> *Prosource International Inc. v. Horphag Research Management S.A.*, G.R. No. 180073, 25 November 2009

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

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.

There are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other especially when used on the same Class 5, or pharmaceutical products. Because IROVEL is used or will be used on pharmaceutical products that may be similar or closely related to the goods covered by the Opposer's trademark registration, chances are, the consumers are likely to confuse the mark for the other or assume that one is just a variation of the earlier mark.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2012-012287 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, 01 JUN 2017



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