SANOFI, *Opposer,* **-versus-** **MEDIRICH PHARMA DISTRIBUTION CORPORATION,** *Respondent-Applicant.*	}	**IPC No. 14-2016-00226** Opposition to: Appln. Serial No. 4-2015-011579 Date Filed: 07 October 2015 **TM: TRANEX**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 219 dated 13 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, 14 June 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

SANOFI,
Opposer,

versus-

MEDIRICH PHARMA DISTRIBUTION CORPORATION,
Respondent-Applicant.
x----------x

IPC NO. 14-2016-00226

Appln. Ser. No. 4-2015-011579
Filing Date: 07 October 2015
Trademark: **TRANEX**

Decision No. 2017 - 219

DECISION

SANOFI, [1] ("Opposer") filed an Opposition to Trademark Application No. 4-2015-011579. The application, filed by MEDIRICH PHARMA DISTRIBUTION CORPORATION[2] ("Respondent-Applicant") covers the mark TRANEX for use on *"pharmaceutical product used for the treatment of severe hemorrhage associated with excessive fibrimolysis, abnormal bleeding during operation, traumatic injuries, profuse menstrual bleeding, recurrent nose bleed, genital bleeding post tooth extraction and other dental procedures"* under Class 05 of the International Classification of goods[3].

The Opposer alleges that the Respondent-Applicant's application for the registration of the mark TRANEX 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 TRANEX 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 TRANXENE mark that was previously registered with this Office and such act would result in the diminution of the value of the Opposer's internationally well-known TRANXENE mark. Opposer further argues that the goods bearing the Opposer's mark TRANXENE and the Respondent-Applicant's mark TRANEX are commercially available to the public through the same channels of trade such that an undiscriminating buyer may confuse and interchange the products bearing the Respondent-Applicant's mark TRANEX for goods bearing the Opposer's internationally well-known mark TRANXENE. Opposer also points out that considering 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 drug even without the doctor's prescription, may mistakenly believe that the goods of the Respondent-Applicant is equivalent to, or , at least, originate from

[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 Room 208, J. Borromeo Bldg., F. Ramos cor. Arlington Pond Sts. Cebu 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.

economically linked undertakings.

The Opposer's evidence consists of the following:

1. Legalized and authenticated Special Power of Attorney;
2. Legalized and authenticated Affidavit of Chakib Chambi;
3. List of registrations in various countries of the mark TRANXENE;
4. Copies of Certificates of Registration of the mark TRANXENE issued in France, Hong Kong, Russian Federation, Singapore, South Africa, Thailand and United States of America;
5. Certificates of Product Registration issued by the Food and Drug Administration for the drug Tranxene;
6. Photocopies of the packaging, label, product leaflets of the TRANXENE drug;
7. Copy of Invoices showing sale of TRANXENE; and
8. List of customers.

This Bureau issued on 18 July 2016 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's address on 30 July 2016. The Respondent-Applicant, however, did not file the Answer. 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 "**TRANEX**"?

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] Thus, Sec. 123.1 (d) of the IP Code 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 a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark TRANEX on 07 October 2015 2012, the Opposer already has an existing registration for the trademark TRANXENE issued on way back in 02 March 1979. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

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

But are the competing marks, as shown below, similar or closely resemble each other such that confusion, mistake or deception is likely to occur?

TRANXENE	TRANEX
Opposer's Mark	Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks show that they are both word marks written in plain upper case letters. Both marks contain two syllables: the first syllable "TRA" in both the contending marks are identical while they differ in the second syllable which is "XENE" for the Opposer's and "NEX" for the Respondent-Applicant's. Although the marks are not entirely the same, there are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other[5]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article[6].

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to 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.[7]

Further, the subject marks may differ in spelling but when Respondent-Applicant's TRANEX mark is pronounced, it is audibly similar to Opposer's TRANXENE such that it becomes indistinguishable from Opposer's mark. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in

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[5] *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.
[6] *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.
[7] *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

In *Marvex Commercial Co. Inc. vs. Petra Hawpia & Co., and The Director of Patents*[8], the Supreme Court ruled:

> "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 special significance (Co Tiong Sa vs. Director of Patents, 95 Phil. I, citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679). 'The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear' (Operators, Inc. vs. Director of Patents, supra).
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> 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 'Jass-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 'Trade-Mark Law and Practice', pp. 419-421, cities, as coming within the 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.
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> In the case at bar, '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 (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148)."

In addition, it bears stressing that Respondent-Applicant's mark is being applied for use on related goods that belong to Class 5. Considering therefore the similarity in the appearance of the marks as well as the fact that marks are used on related products, there is likelihood that the usually unwary or incautious person would be confused or mistaken that Opposer's TRANXENE is the same as TRANEX or that one is just a variation of the other.

It must be emphasized that the registration of trademarks involves public interest. Public interest, therefore, require that only marks that would not likely cause deception, mistake or confusion should be registered. The consumers must be protected from deception, mistake or confusion with respect to the goods or services they buy. Trademarks serve to guarantee that the product to which they are affixed

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8 G.R. No. L-19297. 22 December 1966

comes up to a certain standard quality. Modern trade and commerce demands that depredations on legitimate trademarks should not be countenanced. The law against such depredations is not only for the protection of the owner but also, more importantly, for the protection of consumers from confusion, mistake, or deception as to the goods they are buying.[9]

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2016-011579, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 JUN 2017.

MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

[9] *Le Chemise Lacoste, S.A. v. Oscar C. Fernandez et. al.*, G.R. Nos. 63796-97 and G.R. No. 65659, 21 May 1984.