



**SANOFI-AVENTIS DEUTSCHLAND  
GMBH,**

*Opposer,*

- versus -

**SUHITAS PHARMACEUTICALS, INC.,**  
*Respondent-Applicant.*

X-----X

**Inter Partes Case No. 14-2008-00204**

Case filed on: 15 September 2008

Opposition to:

Appln. Ser. No. : 4-2008-000633

Date Filed : 18 January 2008

Trademark : "ARA"

**Decision No. 2009 - 95**

## DECISION

For decision is the Notice of Opposition filed by Sanofi-Aventis Deutschland GmbH, (hereinafter referred to as Opposer), a corporation organized and existing under the laws of Germany with address at Bruningstrasse 50, 65926, Frankfurt am Main, Federal Republic of Germany against Application Serial No. 4-2008-000633 for the mark ARA for goods under class 5 namely: "pharmaceutical products used in the management of hypertension and may have a role in patients who are unable to tolerate ace inhibitors. It has also been tried in heart failure and in myocardial infarction, also for diabetic nephropathy in Type 2 diabetes mellitus" in the name of Suhitas Pharmaceuticals, Inc. (hereinafter referred to as respondent-applicant), a corporation with address at 3<sup>rd</sup> Floor Centrepont Bldg., Pasong Tamo cor Export Bank Drive, Makati City.

Opposer relied on the following grounds to support its opposition:

- "6. Under the existing law, rules and jurisprudence, the mark **ARA** should not be registered by this Honorable Office because the registration of the 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:

1

**Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE**

351 Sen. Gil Puyat Ave., Makati City 1200 Philippines • www.ipophil.gov.ph

Telephone: +632-7525450 to 65 • Facsimile: +632-8904862 • email: mail@ipophil.gov.ph

- (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;"

x

x

x

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

7.1 That the Respondent-Applicant adopted the mark **ARA** for its products also in Class 05 is clearly an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer's **ARAVA** mark that was previously applied for registration before this Honorable Office on January 17, 2008

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

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

8.2 Both marks are grouped under Class 05 as pharmaceutical products which would likely cause confusion. Such confusion can be dangerous to the consumer of the products since the goods involved relate to medical products which when used improperly, may cause more harm than good.

"9. Respondent-Applicant's mark resembles the Opposer's **ARAVA** mark in terms of spelling, pronunciation and appearance as to likely deceive or cause confusion. Hence, the registration of the mark **ARA** violates Section 123.1 (d) or the Intellectual Property Code.

9.1 Both **ARAVA** and **ARA** are word marks.

9.2 The first three (3) letters of both marks are composed of three (3) letters, which are exactly the same – A, R and A.

9.3 A cursory glance at both marks make it appear as though the marks are exactly the same and/or that the mark **ARA** is derived from the Opposer's mark **ARAVA** or is a short cut thereof and hence, may cause confusion.

"10. By the Respondent-Applicant's use of the mark **ARA** on goods in Class 5, the Respondent-Applicant takes advantage of the goodwill and reputation

of the Opposer, resulting in the diminution of the value of the trademark **ARAVA**.

- "11. Evidently, the Respondent-Applicant's mark may cause confusion in the minds of the consumers by usurping the mark **ARAVA**, a mark legally owned by the Opposer, and passing off its own products as those manufactured by the Opposer.
- "12. The denial of Trademark Application No. 4-2008-000633 for the mark **ARA** in Class 5 by this Honorable Office is authorized under other provisions of the Intellectual Property Code.

Opposer submits the following evidence in support of the opposition:

ANNEXES	DESCRIPTION
"A"	Verified Notice of Opposition
"B"	Special Power of Attorney
"C"	Joint-Affidavit of Joelle Sanit-Hugot and Arthur Muratyan

The Notice to Answer dated 30 September 2008 was received on 13 October 2008 but no Answer was submitted. The issue is whether respondent-applicant's mark **ARA** is confusingly similar to opposer's mark **ARAVA**.

The marks of the contending parties are reproduced below for comparison:

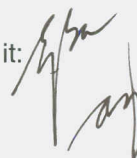
Opposer's mark	Respondent-Applicant's mark
<b>ARAVA</b>	<b>ARA</b>

The law provides that a mark cannot be registered if it nearly resembles another mark which would lead to a likelihood of confusion or deception.

The Intellectual Property Code states:

"SECTION 123.

Registrability. – 123.1. A mark cannot be registered if it:





(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"

Evidence shows that opposer filed its application for the mark ARA covering goods under class 5 on 17 January 2008 (Annex "A" of Annex "C"). In point of time, opposer has an earlier filing date for its mark ARAVA than respondent-applicant's filing date of 18 January 2008. In determining whether the marks are confusingly similar, the Supreme Court developed the dominance test and holistic test.

In McDonald's Corporation v. L.C. Big Mak Burger, Inc., G.R. No. 143993, dated 18 August 2004, the Supreme Court held:

"In determining likelihood of confusion, jurisprudence has developed two tests, the dominance test and the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. xxx

This Court, however, has relied on the dominance test rather than the holistic test. The dominance test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominance test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments.

In American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, the Supreme Court held:

"In fact, even their similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reason that trade *idem sonans* constitutes violation of trade mark patents.

Applying the dominance test, the first two syllables, ARA, of the word marks are identical. Only two additional literal elements, VA was added by the respondent-applicant was added. When seen side by side, the marks visual impression are similar and when pronounced, the sound produced are confusingly similar.

In Marvex Commercial Co., Inc. vs. Petra Hawpia & Co. (18 SCRA 1178), 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-splash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutes" 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 purview of the *idem sonans* rule. "Yusea" and "U-C-A", "Steinway Pianos" and "Stienberg Pianos" and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Condura" 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.

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 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).

"Infringement' of trade-mark does not depend on the use of identical words, nor on the question whether they are so similar that a person looking at one would be deceived into the belief that it was the other, it being sufficient if one mark is so like another in form, spelling, or sound that one with not a very definite or clear recollection as to the real mark is likely to be confused or misled." (*Northam Warren Corporation v. Universal Cosmetic C., C. C. A III.*, 18 F. 2d 714, 775). (*Philippine Nut Industry, Inc. vs. Standard Brands Incorporated*, 65 SCRA 575)

Moreover, the likelihood of confusion is compounded by the fact that the marks are applied for goods under the same class 5.

**WHEREFORE**, premises considered the **OPPOSITION** filed by Opposer, Sanofil-Avevntis Deutschland GmbH, is, as it is hereby **SUSTAINED**. Accordingly, Application Serial No. 4-2008-000633 filed by Respondent- Applicant, Suhitas Pharmaceuticals, Inc., on 18 January 2008 for the registration of the mark "ARA" used under Class 5, for "pharmaceutical products", is as it is, hereby **REJECTED**.

Let the filewrapper of "ARA", subject matter of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

**SO ORDERED.**

Makati City, 3 August 2009.

  
**ESTRELLITA BELTRAN-ABELARDO**  
Director, Bureau of Legal Affairs