

LES LABORATORIES SERVIER,
Opposer,
- versus -

IPC 14-2007-00096

Opposition to:
TM Application No. 4-2005-007431
(Filing Date: 03 August 2005)

GAMOT PHILIPPINES, INC.,
Respondent-Applicant.

TM: "TRIZIDINE"

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Decision No. 07-142

DECISION

This pertains to an Opposition filed on 10 April 2007 by herein opposer, LES LABORATORIES SERVIER, a corporation duly organized under the laws of France, with office at 22, Rue Garnier, 92200 Neuilly-sur-Seine, France, against the application filed on 03 August 2005 bearing Serial No. 4-2005-007431 for the registration of the trademark "TRIZIDINE" used for goods in Class 05, of the Nice Classification of Goods for pharmaceutical product namely, antihypertensive, which application was published in the Intellectual Property Office Electronic Gazette on 09 February 2007.

The respondent-applicant in this instant opposition is Gamot Philippines, Inc. with address of record at No. 67 Scout Fuentebella St., Tomas Morato, Quezon City, Philippines.

Opposer enumerated the following grounds in support of its opposition to the registration of the subject trademark, to wit:

"1. Les Laboratories Servier is the originator of the molecule and active ingredient TRIMETAZIDINE, which is also the active ingredient of the anti-angina preparation largely sold by Servier and other authorized distributors around the world under the trademark VASTAREL. The molecule, active ingredient and generic name TRIMETAZIDINE is an international non-proprietary name ("INN") Included in Cumulative List No. 10 of the World Health Organization's ("WHO") International Non-Proprietary Names (INN) for Pharmaceutical Substances. TRIMETAZIDINE is also listed in THE MERCK INDEX as a coronary vasodilator and in The International Drug Directory Index Nominum. Being an international non-proprietary name, TRIMETAZIDINE may not be exclusively appropriate as a trademark."

"2. The WHO, during its Forty Sixth World Health Assembly, acknowledge that the use of trademarks and brand names derived from stems or other descriptors used in international non-proprietary names, particularly in respect of single-ingredient prescription drugs, may compromise the safety of patients by creating confusion in prescribing and dispensing medicines and by interfering with the orderly development of nomenclature for international non-proprietary names. Accordingly, the WHO requested Member States, which includes the Philippines, to discourage the use of names derived from international non-proprietary names and particularly names including established stems, as trademarks."

"3. Applicant's TRIZIDINE trademark is very similar to, if not almost identical, and so resembles the generic name of the pharmaceutical ingredient for cardiovascular drugs, TRIMETAZIDINE. In this regard, the registration and use by Applicant of the trademark TRIZIDINE violates Sections 123.1 (h) and 123.1 (j) of Republic Act. No. 8293, the Intellectual Property Code ("IP Code") which proscribe the registration of a mark if it "consists exclusively of signs that are generic for the goods or services that they seek to identify" of "consists exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose xxx or other characteristics of the goods or services."

“4. The approval of Applicant’s trademark TRIZIDINE is based on the misrepresentation that it is the originator, true owner and first user of the trademark, which was merely copied/derived from INN TRIMETAZIDINE. As stated, Les Laboratories Server is the true originator of the molecule and active ingredient TRIMETAZIDINE, and as such has legitimate right to make the best efforts in order to avoid any confusion regarding the INN which is public property and must stay now at competitor’s disposal but not be appropriated as a trademark.”

Opposer alleged the facts, in sum, to wit:

1. “TRIMETAZIDINE” is the descriptive name of the molecule and active ingredient 1-[2, 3, 4-Trimethoxyphenyl methyl] piperazine C₁₄H₂₂N₂O₃. It is the generic name for cardiovascular drugs and included in the “WHO’s” “INN” Cumulative List No. 10 for Pharmaceutical Substances. “TRIMETAZIDINE” is listed in the MERCK INDEX as a coronary vasodilator and in the International Drug Directory Index Nominum.

2. An issue to the present case has been previously resolved by this Honorable Office in Decision No. 2003-24, dated 15 May 2003, in Inter Partes Case No. 4082, with respect to anti-hypertensive drug being an imitation of the generic and international non-proprietary name “INDAPAMIDE”, and therefore confusingly similar thereof, as both are used in pharmaceutical preparations for the treatment of hypertension, and because the WHO discourages the use of international non-proprietary names of their stems as trademarks.

3. The registration and use by respondent of “TRIZIDINE” as trademark will give it undue advantage over opposer, which has been using the active ingredient TRIMETAZIDINE for the products bearing the registered mark VASTAREL, owned by BIOFARMA, affiliated company, as it appears prominently on the packaging of VASTAREL products in accordance and compliance with the requirements of the Generics Act.

This Bureau issued a Notice to Answer dated 07 May 2007 directing herein respondent-applicant to file its verified answer within thirty (30) days from receipt hereof, pursuant to Office Order No. 79, series of 2005. However, after lapse of reasonable days after said Notice was duly served to the named respondent-applicant, this Bureau did not receive any motion or pleading related thereto. Consequently, opposer’s reply dated 04 August 2007 cannot be regarded as a responsive pleading to an answer which was not filed. Hence, this instant case shall be decided on the basis of the opposition and the attaching evidence, in accord to existing rules.

The Issue –

WHETHER OR NOT RESPONDENT-APPLICANT’S TRADEMARK “TIZIDINE” MAY BE ALLOWED REGUSTRATION DESPITE OPPOSER’S ALLEGATION OF CONFUSING SIMILARITY TO THE INTERNATIONAL NON PROPRIETARY NAME OR GENERIC NAME “TRIMETAZIDINE”.

This Bureau rules in the negative.

This instant case was filed during the effectivity of Republic Act (RA) No. 8293, and is therefore governed by such law or the New Intellectual Property Code of the Philippines, particularly Section 123.1 (h) and (j), which provide as follows:

“Sec. 123 Registrability. - 123.1 A mark cannot be registered if it”

- (h) Consists exclusively of signs that are generic for the goods or services that they seek to identify.
- (i) Consists exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time production of the goods or rendering of the services, or other characteristics of the goods.”

(Emphasis Ours.)

The word “TRIMETAZIDINE” is established to be molecule, an active ingredient of the anti-angina preparation and a generic name, as proved in the following documentary evidence of the opposer, to wit:

1. Exhibit “B” - “The Merck Index”, An Encyclopedia of Chemicals, Drugs and Biologicals, 1989; entry no. 9619 shows “TRIMETAZIDINE” as a coronary vasodilator.
2. Exhibit “C” - “World Health Organization (WHO) International Non-proprietary Names (INN) for Pharmaceutical Substances”; Table of Contents showing cumulative list no. 10.
3. Exhibit “C-1” - Copy of page 1320 of the WHO INN for Pharmaceutical Substances Cumulative List No. 10: this shows entry for INN “TRIMETAZIDINE”
4. Exhibit “D” - “The International Drug Directory Index Nominum”, pages 1225 – 1226 of the 18th edition;
5. Exhibit “E” - “Wikipedia encyclopedia”, web print-out; this indicates “TRIMETAZIDINE” as a long-term treatment of angina pectoris.
6. Exhibit “H” - “The use of stems in the selection of International Non-proprietary Names (INN) for Pharmaceutical Substances”, this shows copy of the alphabetical list of stems in which “INE” is found.

A relevant matter for consideration is the resolution WHA 46.19 passed in the Forty-Sixth World Health Assembly, evidenced by Exhibit “F”, which was held in Geneva. Among others, it stated to be “Aware of the concern expressed by the Sixth International Conference of Drug Regulatory Authorities (1991) about the increasing use of pharmaceutical brand names that are very similar to or derived from international non-proprietary names.” It further noted “the recommendation made by the WHO Expert Committee on the Use of Essential Drugs, in its fifth report (WHO Technical Report Series, No. 825, 1992), on the need to discourage, as a matter of urgency, the use of trade marks that are derived from international non-proprietary names”.

Thus member States request, “(2) to develop policy guidelines on the use and protection of international non-proprietary names, and to discourage the stems, as trademarks.” Lastly, the Assembly “calls on the Director-General to intensify his consultation with governments and representatives of the pharmaceutical industry on ways of reducing to a minimum the problems arising from drug nomenclatures that may create confusion and jeopardize the safety of patients.”

The instant opposition case reveals a non-arguable fact that the subject trademark “TRIZIDINE” is part and/or portion of the international non-proprietary name “TRIMETAZIDINE”. In one case, the Federal Supreme Court of Germany refused the registration of the word “PRAZEPAMIN” as a trademark on the ground that it conflicts with the International Non-proprietary Name “PRAZEPAM”.

Clearly so, "TRIZIDINE" resembles the generic name of the pharmaceutical ingredient for cardiovascular drugs "TRIMETAZIDINE". This brings this Bureau's inference that respondent-applicant's "TRIZIDINE" was merely derived from the generic name "TRIMETAZIDINE".

A common or generic name of a product or article is merely descriptive of the character, qualities or composition of an article cannot be monopolized as a trademark or trade name. (East Pacific Merchandising Corp. vs. Director of Patents, 110 Phil. 443; Masso Hermanos, S.A. vs. Director of Patents, 94 Phil. 136)

In addition to the foregoing discussions, respondent-applicant's "TRIZIDINE" is confusingly similar to the generic name "TRIMETAZIDINE". First. This Bureau noted the luculent visual and aural similarities between the marks. This is the application of the idem sonans rule as held in the case of SAPOLIN CO. vs. BALMACEDA, 67 Phil. 795, that confusion is likely to arise between words which when pronounced sounds alike. Second. The contending marks cover the same class 5 of the Nice classification of goods. Therefore, confusion is very likely to happen.

Verily, the question of infringement of trademarks is to be determined by the test of dominancy where duplication or the exact imitation is not necessary nor is it necessary that the infringing label should suggest an effort to imitate. As its title implies, the Test of Dominancy focuses on the similarity of the prevalent features, or the main, essential and dominant features of the competing trademarks which might cause confusion or deception.

In fact, the Honorable Supreme Court has consistently relied on the Dominancy Test in determining questions of infringement of trademark in a string of cases which including Asia Brewery, Inc. vs. Court of Appeals, 224 SCRA 437; Co Tiong vs. Director of Patents, 95 Phil. 1; Lim Hoa vs. Director of Patents, 100 Phil. 214; American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544; Philippines Nut Industry, Inc. vs. Standard Brands, Inc., 65 SCRA 575; Converse Rubber Corp. vs. Universal Rubber Products, Inc., 147 SCRA 154.

This test of dominancy is even explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the "colourable imitation of a registered mark x x x or a dominant feature thereof."

WHEREFORE, premises considered the Notice of Opposition filed by Les Laboratoires Servier is as it is hereby SUSTAINED. Accordingly, Application Serial No. 4-2005-007431 Filed by respondent-applicant, Gamot Philippines, Inc. on 03 August 2005 for the mark "TRIZIDINE" under Class 5, as it is hereby, REJECTED.

Let the file wrapper of "TRIZIDINE", subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with the decision.

SO ORDERED.

Makati City, 28 September 2007.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office

