

ORSEM,	}	Inter Partes Case No. 4082
Opposer,	}	Opposition to:
	}	
	}	Appln. Serial No. : 82084
-versus-	}	Date filed : 18 Aug. 1992
	}	Trademark : "NAPAMIDE"
	}	Goods : Pharmaceutical
	}	preparation for the treatment
	}	of hypertension
DOUGLAS PHARAMCEUTICALS	}	
LIMITED,	}	
Respondent-Applicant.	}	
x-----x	}	Decision No. 2003-24

DECISION

This is an opposition filed on October 12, 1994 by the herein Opposer "ORSEM" a corporation duly organized and existing under the laws of FRANCE with principal address at 92201 NEUILLY SUR-SEINE CEDEX, FRANCE for the registration of the mark "NAPAMIDE" bearing Serial No. 82084 filed on August 8, 1992 for the goods pharmaceutical preparations for the treatment of hypertension under class 5 which application was published for opposition in the MAY-JUNE 1994 issue of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette, Volume VII, No. 3 page 45 and officially released on July 7, 1994.

The Respondent-Applicant in this particular case is "DOUGLAS PHARMACEUTICAL LIMITED" a foreign corporation with alleged principal address at Lincoln, Auckland, New Zealand.

The grounds of the opposition are as follows:

- "1. Registration of the mark "NAPAMIDE" would violate Section 4 (e) of Republic Act No. 166 (Trademark Law) hereunder quoted as follows:

"Sec. 4. Registration of trademark, trade names and service marks on the principal register. x x x The owner of the trademark x x x shall have the right to register the same x x x unless it:

x x x

"(e) Consist of or comprises a mark or trade name which when applied to or used in connection with the goods, business or services of the applicant is merely descriptive or deceptively misdescriptive of them x x x."

- "2. Registration of the mark "NAPAMIDE" would likewise contradict Rule 43 (e) of the Revised Rules of Practice in Trademark Cases, which has an identical provision as the above law.
- "3. Moreover, if the application to register the mark "NAPAMIDE" is allowed, the Respondent-Applicant would appropriate a trademark which is a flagrant and veritable imitation of the generic or nonproprietary chemical name of "INDAPAMIDE", which under the law and practice cannot be exclusively acquired and registered as intellectual property.

- “4. Eventual registration of the trademark “NAPAMIDE” would violate the International Nonproprietary Name (INN) doctrine pronounced by the World Health Organization (WHO) for the selection and protection of pharmaceutical substances thus depriving other pharmaceutical companies like the herein Opposer to use the generic name “INDAPAMIDE” as accompanying description of manufacturer’s trademarks.
- “5. And lastly, registration of trademark confusingly identical with a generic name would open floodgates of brand names being registered using as basis non-proprietary names of pharmaceutical substances.

In support of its opposition, Opposer encloses the following:

- “(a) Machine copy of WHO’s international Nonproprietary Name (INN) for pharmaceutical substance, page 270, 1992 edition showing the INN “INDAPAMIDE”, as Opposer’s Exhibit “A”.
- “(b) Machine copy of THE MERCK INDEX pages 966-967, Eleventh Edition, 1989 Volume showing the chemical characteristic of “INDAPAMIDE”, as Opposer’s Exhibit “B”.
- “(c) Machine copy of International Drug Directory Index Nominum page 589, as Opposer’s Exhibit “C”.

On January 9, 1995, Respondent-Applicant filed its Answer denying all the material allegations in the opposition and further alleging the following as its special and affirmative defenses.

- “1. The Notice of Opposition is fatally defective as it does not have a certificate of non-forum shopping required by Memorandum Circular No. ISS/94-5 dated July 11, 1994.
- “2. Applicant is the owner and first user of the trademark, “NAPAMIDE”, which is registered in its name in the Patent Office of New Zealand. As such, it is entitled to the registration of the said mark in the Philippines in accordance with the provision of Republic Act No. 166 (the “Trademark Law”), specifically Section 37 thereof, and the provision of the Paris Convention for the Protection of Industrial Property of which the Philippines and New Zealand are signatories.
- “3. The registration of the Applicant’s mark “NAPAMIDE” will not violate Section 4 (e) of the Trademark Law and Rule 43 (of the Rules of Practice in Trademarks Cases as the said mark is an arbitrary and fancifully created trademark and not a generic name/mark as the Opposer claims it to be.
- “4. Opposer’s reference to the World Health Organization (WHO) list of International Nonproprietary Name (INN) for Pharmaceutical Substances is wholly misplaced as the said list is not binding upon the Honorable Office, not having been adopted by reference in a statute or

regulation enacted under the authority of the government of the Philippines.

- “5. Also, the INN’s listed in the WHO list of INN’s are mere proposed and recommended INN’s and are essentially generic terms as the Opposer contends. As a matter of fact, the INN’s listed by the WHO are merely devised and are subject to objection.
- “6. Thus, the fact that “INDAPAMIDE” is listed in the WHO’s list of INN’s does not affect the registrability of the mark “NAPAMIDE” in the name of Applicant.
- “7. Even assuming, *ex gratia argumenti*, that an INN by the WHO is not capable of appropriation as a trademark, the fact that “INDAPAMIDE” is listed as an INN will not prevent the registration of the mark “NAPAMIDE” as the said mark is, as a whole, dissimilar in appearance, spelling, pronunciation, and syllabication from “INDAPAMIDE”. Thus, while the Applicant’s mark is composed of eight (8) letters and three (3) syllables, the word “INDAPAMIDE” is composed of ten (10) letters and four (4) syllables.
- “8. The grounds for opposition relied upon by the Opposer, taken together, do not state a cause of action against the Applicant.

The parties failed to have the case amicably settled for which trial on the merit was conducted.

The ultimate issue to be resolved in the instant case is:

“WHETHER OR NOT THE TRADEMARK “NAPAMIDE” is confusingly similar to the International Nonproprietary Name or GENERIC NAME INDAPAMIDE.”

Considering that this case was filed prior to the effectivity of Republic Act No. 8293, the applicable law is Republic Act No. 166, as amended, specifically SECTION 4(e).

“SEC. 4. – *Registration of trademarks, trade name and service marks on the principal register.* There is hereby established a register trademarks, trade names and service marks which shall be known as the principal register. The owner of a trademark, trade name and service mark used to distinguished his goods, business or services of others shall have the right to register the same in the principal register, unless it:

x x x

“(e) Consist of a mark or trade name which, when applied to or used in connection with the goods, business or services of the applicant is merely descriptive or deceptively misdescriptive of them, or when applied to or used in connection with the goods, business or services of the

applicant is primarily geographically descriptive or deceptively misdescriptive of them, or is primarily merely a surname.”

During the trial, Opposer offered the evidence consisting of Exhibits “A” to “I-2” inclusive of sub markings per Order No. 96-2142 dated 05 March 1996.

On the other hand, the testimony of Mr. Kem Smart herein Respondent-Applicant’s only witness has been stricken off the record for failure to Answer the second set of cross-interrogatories under Order 2000-513 dated November 6, 2000. Moreover, Respondent-Applicant has been declared to have waived its right to present additional witness and/or evidence in support of its position (Order No. 2001-11) dated 08 January 2002.

As shown by the following evidence presented, the word “INDAPAMIDE” is listed as one of the names which is considered NONPROPRIETARY:

Exhibits “B” – International Nonproprietary Names (INN) for pharmaceutical substances published by the World Health Organization (WHO), 1992 edition.

Exhibits “B-1” – page 270 of Exhibit “B” indicating the International Nonproprietary Name of “INDAPAMIDE”.

Exhibits “E” – International Nonproprietary Names (INN) for pharmaceutical substances published by the World Health Organization (WHO), 1998 edition.

Exhibits “E-1” – page 225 of Exhibit “B” indicating the International Nonproprietary Name of “INDAPAMIDE”.

The word “INDAPAMIDE” as indicated in the Remington’s Pharmaceutical Sciences (Exhibit “G”) the preparations of which are as follows:

Preparation – p – chlorotoluene is sulfonated and converted to the sulfonamide yielding 3-chloro-4-sulfamoylbenzoic acid. This acid is reacted with thionyl chloride to form the carbonyl chloride and treated with 2-methylindole (skatole) to give the product.

Description – White crystals melting about 160°.

Uses – INDAPAMIDE is the first of a new class of diuretic / antihypertensiveness, the indolines. Its diuretic effect is similar to that induced by hydrochlorothiazide. Its antihypertensive effect results from decreased peripheral resistance, perhaps due to an alteration of transmembrane calcium events. INDAPAMIDE is used for the treatment of HYPERTENSION, alone or in combination with other antihypertensive drugs. It is also used in the management of salt and fluid retention associated with congestive heart failure.

INDAPAMIDE is preferentially and reversibly taken up by erythrocytes in peripheral blood. The whole blood/plasma ratio is about 6:1 at the time of peak concentration and decrease to 3.5: 1 at 8 hours. From 71 to 79% of INDAPAMIDE is bound to plasma proteins. INDAPAMIDE is extensively metabolized; only 7% of the unchanged drug is excreted by the kidneys. The half life in whole blood is 24 hours. Few drug interactions are being reported; INDAPAMIDE reduces the renal clearance of lithium and tends to decrease arterial responsiveness to norepinephrine.

Adverse effects are usually mild and transient. Those most commonly observed include headache, dizziness, fatigue, muscle cramps, or numbness of the extremities. Orthostatic hypotensions, premature ventricular contractions, impotence, reduced libido and hypokalemia have been reported. Patients should advise their physician if muscle weakness, cramps,

nauseas, vomiting or dizziness occur. The safe use in the pregnant and nursing mother has not been established.

Dose – usual, hypertension and edema of congestive heart failure, 2.5 mg. As a single daily dose taken in the morning; if the response is not satisfactory after 1 (edema) to 4 (hypertension) weeks, the dose is increased to 5 mg. once daily. The dose of other agents should be reduced by 50% when used in combination with INDAPAMIDE.

Dosage Form – Tablets: 2.5mg.

The trademark subject of this opposition “NAPAMIDE” containing the word PAMIDE which is a part/or portion of “INDAPAMIDE”, an International Nonproprietary Name. Napamide is a pharmaceutical preparation likewise used for the treatment of hypertension.

In line with World Health Organization (WHO) Executive Board resolution (E.B. 91. R5) it would be appreciated if trademarks were not derived from International Nonproprietary Names (INN) and if INN stems were not used in trademarks. The practice endangers the principle that INN’s are public property; it can frustrate the rational selection of further INN’s for related substances, and it will ultimately compromise the safety of patients by promoting confusion in drug nomenclature. (Exhibit “I-1”)

It must likewise be emphasized that the word “PAMIDE” is found in the alphabetical index of stems referring to World Health Organization’s pharmaceutical classification used in the WHO Drug Evaluation and Monitoring Programme. (Exhibit “I-2”)

Another point to be taken into consideration is the circular letter of the Director General of the World Health Organization (WHO) to all member states suggesting that protection of INN’s and INN stem in particular, could be best achieved by incorporating INN’s in the trademark files of the patent and trademark offices.

As shown in the consultation on International Non Proprietary Name “INDAPAMIDE” used for the treatment of hypertension alone or in combination with other hypertensive drugs the herein Respondent-Applicant is not entitled to nor could it appropriate NAPAMIDE, also a pharmaceutical preparation used for the treatment of hypertension, the same being confusingly similar to INAPAMIDE which is an International Non Proprietary Name.

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 Nonproprietary Name “PRAZEPAM”.

The trademark “LIONPAS” for medicated plaster cannot be registered because it is confusingly similar to “SALONPAS” a registered trademark also for medicated plaster. Both words have the same suffix “PAS” which denotes a plaster, with curative powers, that adheres to the body.

Although two letter of “SALONPAS” are missing in “LIONPAS” nevertheless when the two words are pronounced, the sound effects are confusingly similar. Where the goods are advertised over the radio, similarity of sound is of special significance. Similarity of sound is a sufficient ground for holding that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (MARVEX COMMERCIAL CO., INC., vs. PETRA HAWPIA, 18 SCRA 1178).

The question of infringement of trademarks is to be determined by the test of dominancy. The dissimilarity in size, form and color of the label and the place where applied are not conclusive. Duplication or exact imitation is not necessary nor is it necessary that the infringing label should suggest an effort to imitate.

In the instant case, the trademark of the Respondent-Applicant "NAPAMIDE" is confusingly similar with the generic term "INDAPAMIDE", as to sounds, not to mention the fact that the word "PAMIDE" their last appellations is present in both, but more importantly, they are both used in pharmaceutical preparations used for the treatment of hypertension, hence, confusion is a very strong possibility.

With all the foregoing, the Notice of Opposition is hereby SUSTAINED. Consequently, trademark application "NAPAMIDE" bearing Serial No. 82084 filed on 8 August 1992 by DOUGLAS PHARMACEUTICALS, LIMITED on pharmaceutical products is hereby REJECTED.

Let the filewrapper of "NAPAMIDE" subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSDB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks (BOT) for information and to update its record.

SO ORDERED.

Makati City, 15 May 2003.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs