SANOFI-AVENTIS, *Opposer*, -vs- PHARMA-DYNAMIC, INC., *Respondent-Applicant*.	} } } } } } } }	Inter Partes Case No. 14-2009-00095 Case Filed: 23 March 2009 Opposition to: Appl'n. Serial No. : 4-2008-012069 Date Filed : 03 October 2008 Trademark : "CLOPIDREL" Decision No. 2009-129

DECISION

This pertains to the opposition filed against the registration of the mark "CLOPIDREL" bearing application Serial No. 4-2008-012069 filed on 03 October 2008 covering the goods "*pharmaceutical preparations used as thrombolytic agent and for the production of atherosclerotic events*" falling under class 5 of the International Classification of goods which trademark application was published for opposition in Intellectual Property Philippines (IPP) Electronic Gazette (E-Gazette), which was officially released for circulation on 21 November 2008.

The Opposer in the instant case is "SANOFI-AVENTIS", a corporation duly organized and existing under and by virtue of the laws of France with business address at 174 Avenue De France, 751013 Paris, France.

On the other hand, the Respondent-Applicant is "PHARMA-DYNAMIC, INC.", with address at 71 Maysilo Street, Mandaluyong City.

The grounds of the opposition are as follows:

"1. The Respondent-Applicant's "CLOPIDREL" mark lacks the distinctiveness required of a mark under Section 121 and 123 of the Intellectual Property Code and Rule 101 of the Implementing Rules and Regulations on Trademarks.

"2. The Respondent-Applicant's mark "CLOPIDREL" is confusingly similar to the INN "CLOPIDOGREL"

"3. The Respondent-Applicant's mark appropriates a substantial part of the common stem-GREL of the INN system.

Opposer submitted the following as its exhibits in support of its opposition.

Annex	Description
Annex "A"	Certified copy of Certificate of Registration No. 63004 issued on May 21, 1996 for the mark "PLAVIX" the Opposer's pharmaceutical preparation for "CLOPIDOGREL"
Annexes "B" to "B-2"	Copies of excerpts from the WHO's International Non Proprietary Names (INN) for Pharmaceutical substances cumulative list No. 7,8 and 9 as well as the certification of the WHO Regional Office Assistant Librarian Ms. Constancia D. Basilio
Annex "B-3"	The use of common stems in the selection of International Nonproprietary Names for pharmaceutical substances "except of the said WHO's publication"

Annex “C”	Copy of the use of the common stems in the selection of International nonproprietary names (INN) for pharmaceutical substances
Annex “D”	Copy of the *Orsen vs. Douglas Pharmaceutica, Ltd.,* case
Annex “E”	Original notarized and legalized affidavit of Ms. Lalirette B. Carag with annexes
Annex “F”	Original notarized and legalized affidavit of Ms. Sylvie Guillas
Annex “G”	Original notarized and legalized Special Power of Attorney executed by Ms. Sylvie Guillas

On 31 July 2009, Respondent-Applicant filed its Verified Answer to the Notice of Opposition whereby it denied all the material allegations of the verified notice of opposition and further alleged the following special and affirmative defenses.

“1. Respondent-Applicant has been in the pharmaceutical business since 1984. It has various medicines in different brand names that are sold and distributed in the Philippines. Attached herewith as Annexes “1” and “1-A” are copies of the Certificate of Registration of Respondent-Applicant and made an integral part hereof.

“2. Respondent-Applicant has no intention of labeling its applied trademark “clopidrel” to cause confusion or appropriate upon itself the generic name “clopidogrel”, which the Opposer would like this Honorable Office to believe.

“3. Respondent-Applicant came up with the brand name since it intended to introduce an affordable medicine to prevent formation of the thrombus. Hence, the applied brand name “clopidrel”.

“4. It should likewise be noted that Respondent-Applicant has yet to put in the market the brand name “clopidrel”.

“5. Contrary to the allegation of Opposer, the applied trademark “clopidrel” is not patently different and dissimilar with generic name “clopidogrel” and will not result in any confusion to the general public nor would it allow Respondent-Applicant to appropriate the generic name “clopidogrel” unto itself.

“6. As to pronunciation and spelling, the applied brand name “clopidrel” is not confusingly similar or identical to the generic name “clopidogrel”. It bears stress that Respondent-Applicant’s applied brand name has 3 syllables while the generic name has 4 syllables. Moreover, the letters “O-G” appearing on the generic name is emphasized in the pronunciation. Thus, it would be very difficult for the consumer to misunderstand the two words. Thus, Respondent-Applicant’s brand name will not cause confusion and mistake to the general public.

“7. While the spelling of the generic name and the applied brand name have the same letters except for the letters “O-G”, the same is not sufficient to deny the application of Respondent-Applicant’s brand name “clopidrel”.

“8. As held by the Supreme Court in the case *American Cyanamid Company vs. The Director of Patents, et. al.* citing the landmark case of *Etepha vs. Director of Patents,* the High Court ruled:

"Etepha vs. Director of Patents, Westmont Pharmaceuticals, Inc., is another case in point. In Etepha, the question was whether the trademark "ATUSSIN" of Westmont may be registered in the Philippines notwithstanding the objection of Etepha which claimed that it would be damaged because "ATUSSIN" is so confusingly similar with "PERTUSSIN" registered in this country on September 25, 1957. The Director of Patents approved in the application for the registration of the trademark "ATUSSIN" and his decision was appealed to this Court. In disposing of the appeal, the Court affirmed the decision of the Director of Patents holding, *inter alia,* that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display; that taking a causal look at the two labels it is shown that they are entirely different in color, contents, arrangement of words thereon, sizes, shape and general appearance so that the label of one cannot be mistaken for that of the other; that the use of the word "tussin" as a component of both trademarks cannot be considered as a factor for declaring the two confusingly similar for "tussin" is descriptive and generic and is open for appropriation by anyone, and hat while the word itself cannot be used exclusively to identify one's goods it may properly become a subject of a trademark by combination with another word or phrase; hence, Etepha's "pertussin" and Westmont's "atussin". *[Emphasis supplied]*

"9. It also emphasized that the generic name "clopidogrel" is a prescriptive drug and may not be bought over-the-counter or dispensed without the appropriate prescription of the duly licensed medical practitioner. Such being the case, it is highly improbable if not impossible that pharmacist would confuse the applied brand name "clopidrel" to the generic name "clopidogrel", knowing fully well that doctors are mandated to prescribe the generic name and not the brand name.

"10. As mandated in Republic Act No. 6675 otherwise known as the Generic Act of 1988, what is primordial importance is the generic name of the medication and not the brand name. Thus, it is not surprising that under Section 6 of said law, it states that:

"SECTION 6. Who Shall Use Generic Terminology – (a) All government health agencies and their personnel as well as other government agencies shall use generic terminology or generic names in all transactions related to purchasing, prescribing, dispensing and administering of drugs and medicines.

(b) All medical, dental and veterinary practitioners, including private practitioners, shall write prescriptions using the generic name. The brand name may be included if so desired.

(c) Any organization or company involved in the manufacture, importation, repacking, marketing and/or distribution of drugs and medicines shall indicate prominently the generic name of the product. In the case

of brand name products, the generic name shall appear prominently and immediately above the brand name in all product labels as well as in advertising and other promotional materials.

(d) Drug outlets, including drugstores, hospital and non-hospital pharmacies and non-traditional outlets such as supermarkets and stores, shall inform any buyer about any and all other drug products having the same generic name, together with their corresponding prices so that the buyer may adequately exercise, his option. With one (1) year after approval of this Act, the drug outlets referred to herein, shall post in conspicuous places in their establishments, a list of drug products with the same generic name and their corresponding prices." [Emphasis supplied]

"11. Moreover, in the "Additional Guidelines on Prescribing Medicines Pursuant to the Generic Act of 1998" issued by the Department of Health, it clearly instructs the physician on how to prescribed a medication. Under said guidelines, it states:

"* Generic names shall be used in all prescription for:

Drugs with a single active ingredient, the generic name of the active ingredients shall be used in prescribing.

Drugs with two or more active ingredients, the generic name of the active ingredients as determined by the Bureau of Food and Drugs shall be used in prescribing.

* The generic name must be written in full but the salt of chemical form may be abbreviated.

* The generic name of the drug ordered must be clearly written on the prescription immediately after the Rx symbol, or on the order chart.

In addition to the generic name, a brand name may also be indicated. In such cases, the following shall be observed.

* If written on a prescription pad, the brand name enclosed in parenthesis shall be written below the generic name.

* If written on a patient's chart, the brand name enclosed in parenthesis shall be written after the generic name.

* Only one drug product shall be prescribed on one prescription form." [Emphasis supplied]

"12. Clearly, under the cited law and guidelines, what is specifically mandated is the use of the generic terminology or generic name of the medication which shall be written and used, while the mention of the brand name is merely optional. There is clearly no confusion that will arise from the use of Respondent-Applicant of the brand name "clopidrel".

"13. It is equally important to stress that anti-thrombosis medicine is not ordinary cold and/or cough medicines that may be brought over-the-counter but are prescriptive drugs. Usually one patient is known to be predisposed of such condition or is required to take such medication only after consulting a physician. And as discussed previously, physicians are mandated to prescribe medicine based on the generic name of the medicine NOT on the brand name. The reference to a brand name is merely optional or discretionary on the part of the physician. It should also be borne in mind that the person who purchases medicines products is not your ordinary purchaser or those who are completely unwary customers. The purchasers of medicines are the ordinary intelligent purchasers who buy a product for a particular purpose taking much weight to the prescription of the physician and its price.

Respondent-Applicant submitted the following in support of its trademark application subject of the instant opposition.

Annex	Description
Annex "1"	Articles of Incorporation
Annex "1-A"	Certification issued by the Securities and Exchange Commission (SEC).

The ultimate issue to be resolved in this particular case is:

WHETHER OR NOT THE RESPONDENT-APPLICANT'S MARK "CLOPIDREL" IS CONFUSINGLY SIMILAR TO THE INTERNATIONAL NON-PROPRIETARY NAME (INN) OR GENERIC NAME "CLOPIDOGREL"

The International Non-Proprietary Name (INN) or generic name "CLOPIDOGREL" and the Respondent-Applicant's mark "CLOPIDREL" are reproduced for comparison and scrutiny.

CLOPIDOGREL	CLOPIDREL
(INN) Generic name	Respondent-Applicant's mark

As can be gleaned from a side-by-side comparison of the Respondent-Applicant's mark with the generic name "CLOPIDOGREL", it is evident, both visually and phonetically that they are confusingly similar. In fact, all the letters comprising the Respondent-Applicant's mark consists of a substantial part of the common stem-GREL of the INN system. The only distinction between the Respondent-Applicant's mark and the generic name is the presence of the letters "O" and "G' in the generic name and omitted in the Respondent-Applicant's mark. However, this slight distinction will not in anyway avoid confusing similarity.

To be noted is the fact that "CLOPIDOGREL" is an anti-platelet drug inhibits the ability of platelets to clump together as part of a blood clot and therefore reduces the risk of heart attacks and strokes. It is marketed for secondary prevention of thrombotic complications in patients with a history of myocardial infection (MI) ischemic stroke or peripheral arterial disease.

In 1987, "CLOPIDOGREL" was adopted as an International Non-Proprietary Name (INN) by the World Health Organization (WHO), Annex "B".

International Non-Proprietary Name (INN) is word used to identify a pharmaceutical substance and is a word intended for use in pharmacopoeias, labeling products information, advertising and promotional material, drug regulation and scientific literature. In layman's terms, an (INN) is the *generic* term for a particular drug or pharmaceutical preparation. Annex "F" of the affidavit of Ms. Sylvie Guillas, paragraph 4(d).

In the case "Etepha AG vs. Director of Patents and Westmont Pharmaceuticals, Inc., (G.R. No. L-20635, March 31, 1996) the Supreme Court held that in a word combination *the part that comes first is the most pronounced.* "CLOPIDOGREL's" stem "GREL" is included in the World Health Organization (WHO)'s list of International Non-Proprietary Names (INN) for pharmaceutical substances (Annex "C").

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory (*not in juxtaposition*) of the trademark said to be infringed. (87 C.J.S. pp. 288-291) Some factors such as sound; appearance; form, style, shape, size or format; color, idea connoted by the mark; the *meaning, spelling* and *pronunciation* of the words used; and the setting in which the words appear may be considered, (87 C.J.S. pp. 291-292) for indeed, trademark infringement is a form of unfair competition (Clark vs. Manila Candy Co., 36 Phil. 100, 106; Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4).

As previously discussed, it is very clear that the Respondent-Applicant's mark "CLOPIDREL" and the International Non-Proprietary Name (INN) or generic name "CLOPIDOGREL" are confusingly similar in *appearance.*

A generic name is one that conveys the nature of the product to the consumer. No one may appropriate generic name or descriptive words as the law regards them as free for all to use and such in the public domain.

A generic name is one that conveys the nature of the product to the consumer. No one may appropriate generic name or descriptive words as the law regards them as free for all to use and such in the public domain.

J. Thomas McCarthy, in his book "McCarthy on Trademarks and Unfair Competition" quotes the United States Supreme Court when he wrote:

> *"Generic names are regarded by law as free for all to use. They are in the public domain.* As the Supreme Court stated: *"sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all – and in the free exercise of which the consuming public is deeply interested. To grant an exclusive right to one firm or use of the generic name of a product would be equivalent to creating a monopoly in that particular product something that the trademark laws were never intended to accomplish.* Judge friendly remarked that to permit exclusive trademark rights in a generic name "*would grant the owner of the mark a monopoly, since a competitor could not described his goods as what they are.*"

Moreover, Section 123 of Republic Act No. 8293, prohibits the registration of marks that are generic to the goods that they seek to identify. It provides that:

> "Section 123. *Registrability.* – 123.1. A mark cannot be registered if it:
>
> x x x

(h) consists exclusively of signs that are generic for the good or services that they seek to identify;"

The Respondent-Applicant's mark "CLOPIDREL" describes what the products I used for and what the products actually is. It describes the product rather than distinguish it from all the other "CLOPIDOGREL" products in the market.

WHEREFORE, with all the foregoing, the Opposition is, as it is, hereby SUSTAINED. Consequently, Trademark Application bearing No. 4-2008-012069 filed on October 03, 2008 by PHARMA-DYNAMICS, INC., for the registration of the mark "CLOPIDREL" is, as it is hereby REJECTED.

Let the filewrapper of the trademark "CLOPIDREL" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 19 October 2009.

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