

SANOFI-AVENTIS
Opposer,

- versus-

BROWN & BURK PHILIPPINES, INC.
And MICRO LABS., LRD.,
Respondent-applicant.

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IPC No. 14-2008-00138
Opposition to:
Appln. Serial No. 4-2007-012417
Trademark: ZOLPID
Class 5: "pharmaceutical product"

Decision No. 2009-111

DECISION

For decision is the Notice of Opposition filed by Sanofi-Aventis, formerly known as Sanofi-Synthelabo, (hereinafter referred to as Opposer), a corporation organized and existing under the laws of France, with address at 174 Avenue de France, 75013 Paris, France against Application Serial No. 4-2007-012417 for the mark ZOLPID covering goods under class 5 namely: "pharmaceutical product used as a hypnotic in the short term management of insomnia" in the name of Brown & Burke Philippines, Inc., a corporation organized under Philippine laws with address at 302-B RCI Bldg., 105 Rada St., Legaspi Village, Makati City and Micro labs., Ltd., a corporation organized under the laws of India with address at Sipcot, Hosur 635 126, Bangalore, India

The grounds for the opposition are as follows:

1. The trademark ZOLPID being applied for by the Respondent-applicant is confusingly similar to the International Nonproprietary Name (INN) or generic name ZOLPIDEM as to be likely, when applied to or used in connection with the goods of Respondent-applicant, to cause confusion, mistake, and deception on the part of the purchasing public.
2. The registration of the trademark ZOLPID in the name of the Respondent-Applicant will violate Section 123.1 subparagraph (h), (i), (j) of Republic Act 8293, otherwise known as the Intellectual Property Code of the Philippines and the International Nonproprietary Names (INN) system of the World Health Organization (WHO), to which the Philippines is a Member State.
3. The registration and use by Respondent-Applicant of the trademark ZOLPID will defeat the objectives of the INN system, i.e. clear identification, safe prescription and dispensing of medicines to patients, and effective communication and exchange of information among health professionals and scientists worldwide.
4. The registration of the trademark ZOLPID in the name of Respondent-applicant will create an undue advantage, not only against Opposer, but also against all owners/registrants of marks whose generic name is ZOLPIDEM.
5. The registration of the trademark ZOLPID in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines."

In support of the opposition, opposer submitted the following exhibits with submarkings,
to wit:

EXHIBIT	DESCRIPTION
"A"	Copy of Certificate of Registration No. 45305
"B"	World Health Organization letter to opposer

“C”	Affidavit-testimony of Edith Gourtay
“D”	Sanofi-Aventis Business Report fro 2006
“E”	Certificate of Registration No, 45305
“F”	World Health Organization Letter

The Notice to Answer dated June 30, 2008 was received on July 21, 2008. However, records show that no Answer was filed.

The issue for consideration is whether the mark ZOLPID is registrable considering the provisions of Section 123.1 (h), (i) and (j) of the Intellectual Property Code. The law provides:

“Sec. 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 of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- (j) Consists exclusively of signs or of indications that may serve on trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time, or production of goods or rendering of services, or other characteristics of the goods.”

A mark cannot be registered if is generic for the goods it seek to identify. Opposer points out that respondent-applicant's mark ZOLPID is used for the drug which generic name is ZOLPIDEM. It has brought this issue to the attention of the World Health Organization which acknowledged opposer's action in a letter dated April 9, 2008. (Exhibit “B” and Exhibit “F”).

As shown in the web site of the World Health Organization, the definition of an International Nonproprietary Name (INN), is that it "identify a pharmaceutical solution or active pharmaceutical ingredients. Each INN is a unique name that is globally recognized and is public property. A non-proprietary name is also known as a generic name."

Opposer argues that the registration of the mark ZOLPID will give undue advantage to the respondent-applicant. For its part, opposer showed that it has been manufacturing and formulating a pharmaceutical product for the treatment of the central nervous system with the generic name ZOLPIDEM and adopted the trademark STILNOX under Certificate of Registration no. 45305 (Exhibit "E") issued in June 23, 1989. In page 53 of its Business Report (Exhibit "0"), opposer shows that indeed, ZOLPIDEM is the generic name for its pharmaceutical product STILNOX.

The Bureau finds that ZOLPID is unregistrable as a trademark for being generic. In the case of *Societe Des Produits Nestle v. Court of Appeals*, [G.R. No. 112012. April 4, 2001.], the Supreme Court held:

"Generic terms are those which constitute "the common descriptive name of an article or substance," or comprise the "genus of which the particular product is a species," or are "commonly used as the name or description of a kind of goods," or "imply reference to every member of a genus and the exclusion of individuating characters," or "refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product," and are not legally protectable."

Likewise in *Ong Ai Gui v. Director of the Philippine Patent Office*, [G.R. No. L-6235. March 28, 1955.], the Supreme Court held:

"Although a combination of words may be registered as a trade-name, it is no justification for not applying the principle that the use of a descriptive or generic term in a trade-name is always subject to the limitation that the registrant cannot acquire the exclusive right to the descriptive or generic term or word."

WHEREFORE, premises considered the OPPOSITION filed by opposer, Sanofi-Aventis is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 4-2007-012417 for the mark ZOLPID for goods covering class 5 namely "pharmaceutical product used as a hypnotic in short term management of insomnia" filed by respondent-applicant, Brown & Burk Philippines Inc. and Micro Labs, Ltd. is, as it is, hereby given REJECTED.

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

Makati City, 26 August 2009.

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