



ELI LILLY & CO.,
Opposer,

IPC NO. 14-2012-00259
Case Filed: 30 July 2012

-versus-

Opposition to:
Appln. Serial No. : 4-2011-14735
Filing Date: 12 December 2011

ATTY. AMBROSIO V. PADILLA III,
Respondent-Applicant.

TM: "ZYPREDIN"

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Decision No. 2013- 190

DECISION

ELI LILLY & CO.¹ filed on 30 July 2012 a Verified Opposition to Trademark Application Serial No. 4-2011-014735. The application, filed by ATTY. AMBROSIO V. PADILLA III (Respondent)², covers the mark "ZYPREDIN" for use on "pharmaceutical preparation for treatment of oral, or acute and maintenance treatment of schizophrenia and other psychoses, treatment (monotherapy or in combination with lithium or valproate treatment) of acute mania and mixed episodes in bipolar disorder, with or without psychotic features and with or without a rapid cycling course" under Class 5 of the International Classification of Goods³.

The Opposer relies on the following grounds to support its opposition:

"1. Opposer is a global pharmaceutical company engaged in the business of research, development, manufacture, marketing of novel products of high therapeutic value for human medicine, importing, exporting, manufacturing, repacking, preparing for the market, distributing, transporting and promoting the same. It is among the world's 10 leading pharmaceutical companies.

"2. Opposer is the owner of the trademark ZYPREXA for its product *olanzapine* with chemical designation 2-methyl-4 (4-methyl-1-piperazinyl)-10H-thienol[2,3-b][1,5]benzodiazepine. ZYPREXA is indicated for the treatment of schizophrenia. It is a prescription medicine used "to treat bipolar disorder,

¹ A corporation organized and existing under the laws of the United States of America, with offices at Lilly Corporate Center, Indianapolis, Indiana, 46285, USA.

² Filipino, with address at Unit 1001, 88 Corporate Center, Sedenon corner Valero Sts., Salcedo Village, Makati City

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

including: (a) manic or mixed episodes that happen with bipolar I disorder in people age 13 or older; (b) manic or mixed episodes that happen with bipolar I disorder, when used with the medicine lithium or valproate, in adults; (c) long-term treatment of bipolar I disorder in adults; (d) episodes of depression that happen with bipolar I disorder, when used with medicine fluoxetine (Prozac), in adults and (e) episodes of depression that do not get better after two other medicines, also called treatment of resistant depression, when used with the medicine fluoxetine (Prozac), in adults.

“3. In 116, ZYPREXA was introduced for commercial production and distribution. Opposer coined the fanciful word ZYPREXA as brand name for its product *olanzapine*. ZYPREXA is a word not found in the dictionary and it has no English or foreign translation. ZYPREXA is currently distributed and used in around 125 countries around the world. It is available in the following forms: tablets, in 2.5, 5, 7.5, 10, 15 and 20 mg. each, orally disintegrating tablets in 5, 10, 15, 20 mg. each and liquid contained in ampoules for intra muscular injection (10 mg vial).

“4. Opposer has registered the trademark ZYPREXA with this Honorable Office and was issued Certificate of Trademark Registration No. 4-1996-114428 on September 24, 2005 for goods under Class 5 of the Nice Classification of Goods specifically, “pharmaceutical products, namely antipsychotics”. Meanwhile, its variant ZYPREXA RELPREVV was issued Certificate of Trademark Registration No. 4-2009-011500 on April 29, 2010 also for goods under Class 5 of the Nice Classification of Goods, specifically, “pharmaceutical preparations, namely antipsychotics”.

“5. Since its founding by US Civil War veteran Col Eli Lilly in Indianapolis, Indiana in 1876, Lily has grown to be among the top 10 pharmaceutical companies in the world. Col. Lily envisioned a company that would make medicines of the highest possible quality based on the best science of the day. This vision enables Lily to achieve a firmly established worldwide presence today, operating throughout its network and subsidiaries. Lily’s clinical research is conducted in more than 55 countries, its research and development facilities are located in eight countries; its manufacturing plants are located in 13 countries; and its products are marketed in 125 countries.

“6. In the first quarter of 2012, the total worldwide net sales for ZYPREXA amounted to US\$562.7 million while revenues from sales of ZYPREXA for 2011 were US\$4.62 billion. In 2011, Lilly’s worldwide revenue increased by five percent, to \$24.29 billion, driven by the collective growth of Cymbalta, insulin products, animal health products, Alimta, Effient, Cialis and with ZYPREXA contributing US\$2.165 billion in sales in the United States and US\$2.456 in other countries, including the Philippines, for total sales of US\$4.62 billion. This proves ZYPREXA’s well known reputation and worldwide recognition as an effective anti-psychotic drug.

"7. ZYPREXA has been listed in drugs.com, webMD.com, rxlist.com, PDRhealth.com, emedTV.com and MIM.com.ph. These listings demonstrate that ZYPREXA has become internationally known not only as an effective drug, but also a mark closely associated with Opposer. In the Philippines, ZYPREXA is distributed by its local affiliate and Zuellig Pharma Corp. further, ZYPREXA has its own dedicated international website about the product ZYPREXA and how it works.

"8. Opposer has registered its trademark ZYPREXA under Class 5 of the Nice Classification and obtained certificates of registration of the ZYPREXA mark in various countries.

"9. Further the global recognition is evidenced by successful trademark oppositions initiated by Opposer for the past five years against infringers."

The Opposer's evidence consists of the following:

1. Exhibit "A" – notarized and authenticated Power of Attorney by Eli Lilly & Co.
2. Exhibit "B"- copy of Opposer's certificate of existence
3. Exhibit "C" – print-out of Opposer's website
4. Exhibit "D" – print out of website showing highlights of prescribing information on Zyprexa
5. Exhibit "E"- print-out of Medication Guide on Zyprexa
6. Exhibit "F"- copy of Certificate of Registration No. 4-1996-114428 for Zyprexa dated 24 September 2005
7. Exhibit "G" – copy of Certificate of Registration No. 4-2009-011500 for Zyprexa Relprevv dated 29 April 2010
8. Exhibit "H"- "I" print –out from Opposer's website showing information and sales
9. Exhibit "J" – print-out from Drugs.com
10. Exhibit "K" – print-out from WebMD.com
11. Exhibit "L"- print- out form Rxlist.com
12. Exhibit "M"- print-out of PDR health website

13. Exhibit "N"- print-out of eMedTV.com
14. Exhibit "O"- print-out of mim.com.ph
15. Exhibit "P- 1 to28"- copies of trademark registrations in foreign countries
16. Exhibit "Q"- "R"- print-out of Trademark Availability search on May 25, 2012 of anti-psychotic drugs
17. Exhibit "S"- copy of trademark oppositions initiated by the Opposer abroad

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 28 September 2012. The Respondent-Applicant, however did not file an Answer. Thus, this Bureau issued Order No. 2013-470 dated 5 March 2013 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark ZYPREDIN?

The records show that at the time Respondent-Applicant applied for registration of the mark "ZYPREDIN" on 12 December 2011 for goods under Class 5, the Opposer already has an existing registrations for the marks "ZYPREXA" on goods under Class 5, namely: "pharmaceutical products, namely antipsychotics" and "ZYPREXA RELPREVV" on goods under Class 5, namely: " Pharmaceutical products namely anti-psychotics".

The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁴ Thus, Sec. 123.1 (d) of R. A. No. 8293, also known as The Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application on 12 December 2011, the Opposer already has an existing registration for the trademark ZYPREXA and ZYPREXA RELPREVV issued on 24 September 2005 and 29 April 2010 respectively. The goods indicated in the Respondent-Applicant's trademark

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

application are, therefore, similar and/or closely related, if not exactly identical to those covered by the Opposer's trademark registration.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, ZYPREXA and ZYPREDIN are almost identical with respect to the word component except for the last syllable. Opposer used the suffix 'XA' while the Respondent-Applicant used 'DIN, as its suffix. Both marks differing in last syllable are still phonetically similar. When pronounced, the words ZYPREXA and ZYPREDIN sound the same and are *idem sonans*.

There are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other especially when used on the same goods under Class 5. ZYPREXA is an invented word, in fact unique, thus, highly distinctive and gives lasting impression upon the consumers. Because ZYPREDIN is used or will be used on pharmaceutical products that are similar or closely related to the goods covered by the Opposer's trademark registration, chances are, the consumers are likely to confuse the mark for the other or assume the Respondent-Applicant's mark is just a variation of the Opposer's.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁵

In conclusion, the Respondent-Applicant's trademark application is proscribed by Section 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-014735 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 7 October 2013.


Atty. **NATHANIEL S. AREVALO**
Director IV
Bureau of Legal Affairs

⁵ Del Monte Corporation et. al. v. Court of Appeals, GR No. 78325, 25 January 1990.