



PEDIATRICA, INC.,
Opposer,

-versus-

YUNG SHIN (PHILIPPINES), INC.,
Respondent-Applicant.

} IPC No. 14-2010-00256
} Opposition to:
} Appln. Serial No. 4-2010-004033
} Date Filed: 16 April 2010
} TM: "LORADINE"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 43 dated February 26, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 26, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



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- versus -

YUNG SHIN (PHILIPPINES), INC.,

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Decision No. 2013- 43

DECISION

PEDIATRICA, INC. ("Opposer")¹ filed on 27 October 2010 an opposition to Trademark Application Serial No. 4-2010-004033. The application, filed by YUNG SHIN (Philippines), INC. ("Respondent-Applicant")², covers the mark "LORADINE" used on "*pharmaceutical/antihistamines*" under Class 5 of the International Classification of goods.³

The Opposer alleges that LORADINE is confusingly similar to its registered mark "LORAPED" considering that both marks are used on similar pharmaceutical products ("*antihistamines*"). According to the Opposer, the registration of LORADINE will violate Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted as evidence copies of the pertinent page of the "IPO E-Gazette", certified copies of Cert. of Reg. No.4-2006-003580 for the mark LORAPED and of the Declaration of Actual Use thereof, sample product label bearing the mark LORAPED, certification and sales performance, and Certificate of the Product Registration issued by the Bureau of Food and Drugs for the brand/mark LORAPED.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 07 January 2011. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the mark LORADINE?

It is emphasized that the essence of the trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of the industry and skill; to assure to 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.⁵

The Opposer anchors its opposition on Sec. 123.1 (d) of the IP Code which provides that

¹ Is a domestic corporation duly organized and existing under the laws of the Philippines, with office address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines

² Appears to be a domestic corporation, with office address at 4th Floor, Cacho-Gonzales Building, 101 Aguirre Street, Legaspi 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.

⁴ Marked as Exhibits "A" to "F".

⁵ *Pribhadas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

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 mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 16 April 2010, the Opposer has an existing trademark registration for LORAPED (Cert. of Reg. No. 4-2006-003580) for use on "*medicinal preparations, namely, antihistamine/nasal decongestant*". Clearly, the goods indicated in the Respondent-Applicant's trademark application are similar to those covered by the Opposer's trademark registration.

In this regard, the competing marks both start with the syllables "LO" and "RA". This Bureau, however, noticed that "LORA" is derived from the generic name "LORATADINE PHENYLEPHRINE HCl" ("*Loratadine*", for brevity)⁶. Obviously, "LORA" is a common prefix of marks or brand used on said pharmaceutical product. Aptly, what will distinguish the Opposer's mark from other marks with the prefix "LORA" and used on "*Loratadine*" are the letters and/or syllables succeeding the said prefix. In the Respondent-Applicant's mark, what follows the prefix LORA is the syllable "DINE". Obviously, one can easily differentiate "DINE" from the syllable "PED", in looks and in sound. While the consumers would know that both marks are for similar pharmaceutical products, it is unlikely that they would confuse one mark or brand with the other.

What is more likely is for the consumers to confuse LORADINE with the generic name "*Loratadine*". While the Respondent-Applicant removed from "*Loratadine*" the letters or syllable "TA", LORADINE still looks and sound like the generic name. Allowing the Respondent-Applicant to register LORADINE in its favor would give the said party undue advantage over its competitors and sow confusion among the consumers. LORADINE could easily be mistaken as the generic name.

Sec. 123.1 of the IP Code provides, in part, that a mark cannot be registered if it:

(h) Consist exclusively of signs that are generic for the goods or services that they seek to identify;

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.

Corollarily, paragraphs (i) and (j) of the same provision of law prohibit the registration of a mark that:

(i) Consist 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 establishes trade practice;

(j) Consist exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the

⁶ See Exhibit "D".

goods or rendering of the services, or other characteristics of the goods or services;

A term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is, or if it clearly denotes what goods or services are provided in such a way that the customer does not have exercise powers of perception or imagination⁷.

This Bureau and the Director General of the Intellectual Property Office of the Philippines have already passed upon the issue of whether a mark that is obviously a replication of the generic name of the goods on which the mark is used or attached should be allowed to be registered or not. This Bureau takes judicial notice of Inter Partes Case No.14-2009-000249 entitled *Sanofi-Aventis v. Ranbaxy Laboratories Limited*. This Bureau decided the cited case by sustaining the opposition to the application for the registration of the mark "IRBESAR" on the ground that it is confusingly similar to and is a virtual replication of "IRBESARTAN", which is the generic term for a drug mainly used for treating hypertension. The Director General sustained this Bureau's ruling in his decision of 17 December 2012, to wit⁸:

"As correctly pointed out by the Appellee (Sanofi-Aventis):

3.1. All the letters in the Respondent-Applicant's mark IRBESAR form part of the INN 'IRBESARTAN'. In fact, all the seven (7) letters in the Respondent-Applicant's IRBESAR mark constitute the first seven (7) letters of the INN or generic name 'IRBESARTAN'.

3.2. The last three letters of the Respondent-Applicant's IRBESAR mark, namely, the letters S, A and R, consist of a substantial part of the common stem-SARTAN of the INN system.

3.3 It bears stressing that the INN 'IRBESARTAN' and the Respondent-Applicant's mark IRBESAR are both used for pharmaceutical products, the former being the generic name of the latter.

"Accordingly, the similarities in IRBESAR and IRBESARTAN are very obvious that to allow the registration of IRBESAR is like allowing the registration of a generic term like IRBESARTAN. Their similarities easily catches one's attention that the purchasing public may be misled to believe that IRBESAR and IRBESARTAN are the same and one product.

"A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.⁹ Significantly, the registration of IRBESAR would give the Respondent-Applicant the exclusive right to use this mark and prevent others from using similar marks including the generic name and INN IRBESARTAN. This cannot be countenanced for it is to the interest of the public that a registered mark should clearly distinguish the goods of an enterprise and that generic names and those confusingly similar to them be taken outside the realm of registered trademarks.

"The main characteristic of a registrable trademark is its distinctiveness. A trademark

⁷ See *Des Produits Nestle, S.A. v. Court of Appeals* (356 SCRA 207, 222-223) 2001.

⁸ Appeal No. 14-2010-0042.

⁹ See Sec. 138, IP Code.

must be a visible sign capable of distinguishing the goods or services of an enterprise¹⁰. From the foregoing, IRBESAR cannot be considered a distinctive mark that would merit trademark registration. IRBESAR is substantially similar to the generic name IRBESARTAN that the use of the former can only be construed as an abbreviation of the latter. In one case the Supreme Court held that:

“...known words and phrases indicative of quality are the common property of all mankind and they may not be appropriated by one to mark an article of his manufacturer, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him. Even when the sole purpose of the one who first uses them is to form them a trademark for him expressing only of origin with himself, if they do in fact show forth the quality and composition of the article sold by him, he may not be protected in the exclusive use of them¹¹”.

It must be emphasized that an opposition proceedings proceeding is basically a review of the trademark application in question, succinctly, to determine whether the mark in question meets the requirements of registration under the law.

WHEREFORE, the opposition is hereby **SUSTAINED** for the reasons stated above. Let the filewrapper of Trademark Application Serial No. 4-2010-004033 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 26 February 2013.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs



¹⁰ See Sec. 121.1, IP Code.

¹¹ *East Pacific Merchandising Corp. v. Director of Patents*, G.R. No. L-14377, 29 Dec. 1960.