



THERAPHARMA, INC.,  
Opposer,

-versus-

ZYDUS PHILIPPINES, INC.,  
Respondent-Applicant.

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}  
} IPC No. 14-2010-00275  
} Opposition to:  
} Appln. Serial No. 4-2010-002699  
} Filing Date: 10 March 2010  
} TM: "ATORVA"

### NOTICE OF DECISION

**OCHAVE & ESCALONA**  
Counsel for the Opposer  
66 United Street, Mandaluyong City  
Metro Manila


**ZYDUS PHILIPPINES, INC.,**  
Respondent-Applicant  
Unit Pethouse 1, 19<sup>th</sup> Floor Gold Loop Tower A  
Escriva Drive, Brgy. San Antonio  
Ortigas Center, Pasig City 1605

#### GREETINGS:

Please be informed that Decision No. 2013 - 21 dated January 31, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, January 31, 2013.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



**THERAPHARMA, INC.,**  
*Opposer,*

**IPC No. 14-2010-00275**  
Opposition to:

**-versus-**

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**ZYDUS PHILIPPINES, INC.,**  
*Respondent.*

**TM: "ATORVA"**

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**Decision No. 2013- 21**

## DECISION

**THERAPHARMA, INC.** ("Opposer")<sup>1</sup> filed on 15 November 2010 an opposition to Trademark Application Serial No. 4-2010-002699. The application, filed by **ZYDUS PHILIPPINES, INC.** ("Respondent-Applicant")<sup>2</sup>, covers the mark "**ATORVA**" for use on "*atorvastatin (pharmaceutical product namely:dyslipidaemic agent*", under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer alleges, among other things, that it is the registrant of the trademark "**AVAMAX**" used on a pharmaceutical product the generic name or active ingredient of which is "*atorvastatin*". According to the Opposer, the mark **ATORVA** so resembles the generic name "*atorvastatin*", which is listed by the World Health Organization ("WHO") one of the International Nonpropriety Names ("INN") for Pharmaceutical Substances. The Opposer, thus, contends that the registration of **ATORVA** in favor of the Respondent-Applicant will violate Sec. 123, paragraphs (h) and (j) 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 pages of the IPO E-Gazette and documents relating to the mark **AVAMAX**, specifically, certified true copy of the Cert. of Reg. No. 4-2009-002292, sample product label, certification by the Intercontinental Marketing Services on market share and sales performance, certified true copy of the Certificate of Product Registration issued by the Bureau of Food and Drugs, and the electronic print-out of the first four (4) pages of the World Health Organization Drug Information (Vol. 9, No. 3. 1995) list 35.<sup>4</sup>

The Hearing Officer assigned to the instant opposition case issued a Notice to Answer addressed to the Respondent-Applicant. No Answer however, was filed.

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

<sup>1</sup> A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 3<sup>rd</sup> Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

<sup>2</sup> With office address at Unit 603 DonTim Building, 5438 Osmena Highway, Makati City.

<sup>3</sup> 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.

<sup>4</sup> Marked as Annexes "A" to "F", inclusive.

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

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

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. On the other hand, 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 imagination<sup>5</sup>.

There is no dispute that "*atorvastatin*" is a generic name listed in the WHO Drug Information.<sup>6</sup> In this regard, this is not the first time that this Bureau and the Intellectual Property Office of the Philippines has 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 wit<sup>7</sup>:

"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.

<sup>5</sup> See *Des Produits Nestle, S.A. v. Court of Appeals* (356 SCRA 207, 222-223) 2001.

<sup>6</sup> Exh. "F".

<sup>7</sup> Appeal No.14-2010-0042.

“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.<sup>8</sup> 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 must be a visible sign capable of distinguishing the goods or services of an enterprise<sup>9</sup>. 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 them<sup>10</sup>”.

This Bureau finds no cogent reason to rule otherwise in the instant case.

**WHEREFORE**, premises considered the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-002699 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 31 January 2013.

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

<sup>8</sup> See Sec. 138, IP Code.

<sup>9</sup> See Sec. 121.1, IP Code.

<sup>10</sup> *East Pacific Merchandising Corp. v. Director of Patents*, G.R. No. L-14377, 29 Dec. 1960.