



WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

RANBAXY LABORATORIES LTD.,
Respondent-Applicant.

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}
} IPC No. 14-2011-00141
} Opposition to:
} Appln. Serial No. 4-2010-500588
} Date filed: 27 April 2010
} TM: "IRBESAR HCT"
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NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
66 United Street
Mandaluyong City

BENGZON NEGRE UNTALAN
INTELLECTUAL PROPERTY ATTORNEYS
Counsel for the Respondent-Applicant
2/F SEDCCO Bldg., Rada corner Legaspi Streets
Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 10 dated January 21, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 21, 2013.

For the Director:


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



WESTMONT PHARMACEUTICALS,
INC.,

Opposer,

-versus-

RANBAXY LABORATORIES LTD.,

Respondent.

X-----X

IPC No. 14-2011-00141
Case Filed: 18 April 2011

Opposition to:
Appln. Serial No.: 4-2010-500588
(Filing Date: 27 April 2010)

TM: "IRBESAR HCT"

Decision No. 2013- 10

DECISION

WESTMONT PHARMACEUTICALS, INC. ("Opposer")¹ filed on 16 April 2011 an opposition to Trademark Application Serial No. 4-2010-500588. The application, filed by RANBAXY LABORATORIES LTD. ("Respondent-Applicant")², covers the mark "IRBESAR HCT" for use on "*pharmaceutical and medicinal preparations for human and veterinary use*" under Class 05 of the International Classification of Goods³.

The Opposer alleges, among other things, that the mark "IRBESAR" so resembles the generic name of the drug/medicine "IRBESARTAN", such that the registration thereof in favor of the Respondent-Applicant will violate Sec. 123, paragraphs (h) to (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 page three (3) of the "IPO E-Gazette" and the electronic print-outs of the first fourteen (14) pages of the World Health Organization Drug Information (Vol. 9, No.3. 1995) list 35.⁴

The Respondent-Applicant filed its Answer on 24 August 2011, denying all the material allegations in the opposition and contending that its mark is not confusingly similar to the generic name "IRBESARTAN". It submitted as evidence a certified true copies of Trademark Application Serial No. 4-2010-500588 and the Bureau of Trademark's Registrability Report dated 9 August 2010, response to an office action of the Trademark Examiner, and the Notice of Allowance⁵.

This Bureau noticed that the Respondent-Applicant disclaimed "HCT" as part of its mark; hence what is actually sought to be registered is the word "IRBESAR".⁶

Sec. 123 of the IP Code provides, in part, that a mark cannot be registered if it:

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A foreign corporation with principal office address at 19 Nehru Place, New Delhi 110019, India.

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 Annexes "A" to "B", inclusive.

⁵ Marked as Exhibits "1" to "4".

⁶ See Exh. "3" (Response to Paper No. 2 filed on 15 Oct. 2010).

(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 imagination⁷.

In this regard, there is no dispute that IRBESARTAN is a generic name listed in the (WHO) World Health Organization, Drug Information (Vol 9, No. 3, 1995) list 35 as one of the International Non-Proprietary Name ("INN") for pharmaceutical substance.⁸

Significantly, 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 wit⁹:

"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.

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

⁸ Annexes "B" to "B-13".

⁹ 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.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 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’.

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. 4-2010-500588 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 January 2013.


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

⁹ See Sec. 138, IP Code.

¹⁰ See Sec. 121.1, IP Code.

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