



LES LABORATOIRES SERVIER,  
Opposer,

-versus-

THE GENERICS PHARMACY, INC.,  
Respondent-Applicant.

X-----X

}  
} IPC No. 14-2011-00426  
} Opposition to:  
} Appln No. 4-2011-000698  
} Date filed: 21 January 2011  
} TM: "PERIDIL"  
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### NOTICE OF DECISION

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105 Paseo de Roxas  
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**THE GENERICS PHARMACY INC.,**  
For the Respondent-Applicant  
459 Quezon Avenue  
Quezon City

#### GREETINGS:

Please be informed that Decision No. 2014 - 204 dated August 12, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 12, 2014.

For the Director:

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





LES LABORATOIRES SERVIER,  
Opposer,

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THE GENERICS PHARMACY, INC.,  
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IPC No. 14-2011-00426  
Opposition to:

Appln. Serial No. 4-2011-000698  
Date Filed : 21 January 2011  
Trademark: "PERIDIL"

Decision No. 2014 - 204

### DECISION

LES LABORATOIRES SERVIER ("Opposer"),<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2011-000698. The application, filed by THE GENERICS PHARMACY, INC. (Respondent-Applicant),<sup>2</sup> covers the mark "PERIDIL" for use on "pharmaceutical product for the treatment of hypertension" under classes 05 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleged:

"1. The Opposer, is the originator of the molecule and active ingredient PERINDOPRIL, a long acting ACE inhibitor used to treat hypertension, blood pressure, heart failure or stable coronary artery disease. PERINDOPRIL is the active ingredient of the antihypertensive drug, manufacture and largely sold by the Opposer and other authorized distributors around the world and in Philippines under the trademark COVERSYL. The generic name PERINDOPRIL appears prominently on the packaging of COVERSYL branded products in accordance and compliance with the requirements of the Generics Act of the Philippines.

"2. The molecule, active ingredient and generic name PERINDOPRIL is an international non-proprietary name ('INN') included in Recommended List No. 10 of the World Health Organization's ('WHO') International Non-Proprietary Names (INN) for Pharmaceutical Substances (2002). The molecule PERINDOPRIL is also listed as generic drug nomenclature in Page 1286 of THE MERCK INDEX, 13<sup>th</sup> edition (2001), as an antihypertensive preparation. Being a non-proprietary generic term, PERINDOPRIL may not be exclusively appropriated as a trademark.

"3. The Applicant's mark PERIDIL, filed to designate 'pharmaceutical product for the treatment of hypertension', is confusingly similar to the generic name PERINDOPRIL, which designate the pharmaceutical ingredient for antihypertensive drugs. Indeed, the mark PERIDIL has been simply derived from the INN PERINDOPRIL. The only difference between the generic term and the published mark consists of the removal of the letters 'N' and 'OPR' by the Applicant from the middle portions of the generic name PERINDOPRIL. This is a very insignificant difference that does not preclude the likelihood of consumer confusion because, visually, the first four letters (or two syllables), a middle letter 'D', and the last three letter (or last syllable) of the generic term PERINDOPRIL are what make up the published mark PERIDIL. PERIDIL appears

<sup>1</sup> A corporation organized and existing under the laws of France with principal office at 50, rue Carnot, 92284 Suresnes Cedex, France.

<sup>2</sup> With address at 459 Quezon Avenue, Quezon City Metro Manila.

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a Multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.



to be a very close derivative of the generic term PERINDOPRIL, all letters having been exclusively derived there from without the addition of any other letter or element. Moreover, aurally, the first two syllables and the last syllable PERINDOPRIL are what make up almost all of the Applicant's mark. The use of these common elements will inevitably lead to no other conclusion than that PERIDRIO is the same as, if not a very close derivative of PERINDOPRIL. In this regard, the registration and use by the Applicant of the trademark PERIDIL violates Sections 123.1(h) and 123.1(j) of Republic Act No. 8293, the Intellectual Property Code ('IP Code') which proscribe the registration of a mark if it 'consists exclusively of signs that are generic for the goods or services that they seek to identify' or 'consists exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose xxx or other characteristics of the goods or services.

"4. The approval of the applicant's trademark PERIDIL is based on the misrepresentation that it is the originator, true owner and first user of the trademark, which was merely copied/derived from the molecule, active ingredient and generic name PERINDOPRIL. As stated, the Opposer Les Laboratoires Servier is the true originator of the molecule and active ingredient PERINDOPRIL. The Applicant adopted the trademark PERIDIL for its own goods with the obvious intention of capitalizing on the popularity of the generic name PERINDOPRIL. The registration and use of PERIDIL will thus give undue advantage to the Applicant.

"5. The WHO, during its Forty Sixth World Health Assembly, acknowledged that the use of trademarks and brand names derived from stems or other descriptors used in international non-proprietary names, particularly in respect of single-ingredient prescription drugs, may compromise the safety of patients by creating confusion in prescribing and dispensing medicines and by interfering with the orderly development of nomenclature for international non-proprietary names, and thus, the need to discourage, as a matter of urgency, the use of trademark that are derived from international non-proprietary names. Accordingly, the Who requested member states, which includes the Philippines, to discourage the use of names derived from international non-proprietary names, and particularly names including established stems, as trademarks.

"6. The grant of registration to the impugned mark PERIDIL would be contrary to the very purpose, intent and object of INN system, namely trademarks cannot be derived from INNs to allow the rational selection of further INNs for related substances to avoid confusion, which could jeopardize the safety of patients. It is submitted that by applying for registration of the impugned mark PERIDIL after adopting the same by lifting it from the dominant portion of the INN PERINDOPRIL, the Applicant is attempting to illegally obtain statutory rights in parts of INN which is clearly contrary to the scheme and purpose of INN system.

"7. It is submitted that all legitimate manufacturers, distributors and dealers of drugs with the generic name PERINDORPIL, including the Opposer, will be damaged by the unfair use of PERIDIL which is so closely similar to the generic term such that it gives the Applicant an undue advantage in the market due to the affinity of its mark to the generic name. This undue advantage will result in diversion of trade, and damage the Opposer and all legitimate users of the generic term on pharmaceutical product which have the generic component PERINDOPRIL. Moreover, the Applicant's mark clearly violates the IP Code prohibition on registration of generic and descriptive terms and all legitimate users of such generic components in their drugs have a right to oppose its registration to implement the law, otherwise, such prohibition under the law may be rendered useless."

The Opposer's evidence consists of the following

1. Exhibit "A" - Notice of opposition;
2. Exhibit "B" - Affidavit of Opposer's witness with supporting evidence;
3. Exhibit "C" - Special Power of Attorney in favour of Opposer's counsel; and,
4. Exhibit "D" - Power of Attorney in favour of Opposer's authorized signatory.



This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 08 February 2012. Respondent-Applicant however, did not file an answer. Thus, on 12 December 2012, Order No. 2013-008 was issued declaring Respondent-Applicant in default and submitting this instant case for decision.

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

Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("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;
- (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) Consists 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 imply reference to "*every member of a genus and the exclusion of individuating characters*", or "*refer to the basic nature of the wares of 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 it if 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>4</sup>

The Opposer alleges that PERINDOPRIL is a generic name and one of the International Non-Proprietary Names ("INN") as recommended by the World Health Organization ("WHO"). Supposedly, to prove the allegation, the Opposer submitted the Affidavit of Aurelie Boissaye and other documentary evidence. Boissaye cited the WHO's Recommended INN List, marked as Exhibit "B".<sup>5</sup> A scrutiny of the document, however, shows that PERINDOPRIL is not one of the recommended INNs. While the Opposer also submitted as its Exhibit "C" a document entitled "The Merck Index (Thirteenth Edition)", there is no basis however, to consider such document or the contents thereof as equivalent to the WHO's Recommended INN List.

Also, assuming that PERINDOPRIL is a generic name, PERIDRIL is not identical or confusingly similar thereto. PERINDOPRIL and PERIDRIL may have the same first four letters ("PERI") and last three letters ("RIL"), but neither "PERI" or "RIL", or even the entire "PERIDRIL" is the generic name of the pharmaceutical product involved. There is also no showing that "PERI", "RIL" or "PERIDRIL" are the customary or usual designation of the product, nor that which serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production or other characteristics thereof.

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 or merchandise, the fruit of his industry and skill; to assure the public that they are procuring the

<sup>4</sup> Des Produits Nestle, S.A. vs. Court of Appeals (356 SCRA 207, 222-223) 2001.

<sup>5</sup> par. 4 of Affidavit, page 3.




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.<sup>6</sup> This Bureau finds that the mark applied for registration by the Respondent-Applicant has sufficient distinctive qualities to meet the aforesaid functions.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-000698 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 12 August 2014.

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

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<sup>6</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.