



THERAPHARMA, INC.,
Opposer,

-versus-

AMBROSIO PADILLA III,
Respondent- Applicant.

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} **IPC No. 14-2011-00134**
} Opposition to:
} Appln. Serial No. 4-2010-011162
} Date Filed: 12 October 2010
} **TM: "LOSARDIN"**
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}
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}
}

NOTICE OF DECISION

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AMBROSIO PADILLA III
Counsel for Respondent-Applicant
Unit 1001, 88 Corporate Center
Sedeno corner Valero Streets, Salcedo Village
Makati City

GREETINGS:

Please be informed that Decision No. 2014 - 234 dated September 23, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 23, 2014.

For the Director:


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



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IPC No. 14-2011-00134
 Opposition to:
 Appln. Serial No. 4-2010-011162
 Date Filed : 12 October 2010
 Trademark: **“LOSARDIN”**
 Decision No. 2014 - 234

DECISION

THERAPHARMA, INC., (“Opposer”)¹ filed an opposition to Trademark Application Serial No. 4-2010-011162. The application, filed by **AMBROSIO PADILLA III,** (“Respondent-Applicant”)², covers the mark **“LOSARDIN”** for use on “pharmaceutical preparation for the management of hypertension” under class 05 of the International Classification of Goods and Services³.

The Opposer alleged the grounds for this Opposition as follows:

“7. The registration of the mark ‘LOSARDIN’ in the name of the Respondent-Applicant will violate Sec. 123.1 (h) and (j) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

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

(i) x x x

(j) Consists exclusively of signs or of indications that may serve in trade to design ate the kind, quality, quantity, intended purpose, value, geographic origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;

“8. Under the above-quoted provision, any mark, which is similar to a generic and/or descriptive term, shall be denied registration. Thus, considering the mark ‘LOSARDIN’ owned by Respondent-Applicant so resembles the generic name ‘LOSARTAN’, a pharmaceutical drug used for treatment of hypertension, Respondent-Applicant’s application for the registration of the mark ‘LOSARDIN’ should be denied.”

The facts are alleged in summary:

¹ 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.
² An individual with office address at Unit 1001, 88 Corporate Center, Sedeno Corner Valero foreign corporation with office address at A-20, North Western Industrial Zone, Bin Qasim, Karachi-75020, Pakistan.
³ 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.

“A. Opposer will be damaged by the registration of Respondent-Applicant’s mark ‘LOSARDIN’.

“B. LOSARTAN’ is a generic and/or descriptive term. It cannot be registered.

“C. Respondent-Applicant’s mark ‘LOSARDIN’ is confusingly similar to the generic name ‘LOSARTAN’.”

The Opposer submitted the following evidence marked as Exhibits “A” to “G” inclusive of submarkings:

1. Pertinent pages of the IPO E-Gazette;
2. Acknowledgement Receipt for the application of trademark COMBIZAR;
3. Notice of Allowance and Payment of Publication Fee of trademark COMBIZAR;
4. Declaration of Actual Use of trademark COMBIZAR;
5. Sample packaging of COMBIZAR;
6. Certification from IMS Health Philippines;
7. Certificate of Product Registration; and,
8. International Nonproprietary Names for Pharmaceutical Substances.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 24 June 2011. Respondent-Applicant however, did not file an answer. Thus, this instant case is submitted for decision.

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

Section 123 of Republic Act No. 8293, also 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) 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 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 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 a customer does not have exercise powers of perception or imagination.⁴

⁴ Des Produits Nestle, S.A. v. Court of Appeals (356 SCRA 207, 222-223) 2001.

In this regard, records show that LOSARTAN is a generic name listed in the Proposed International Nonproprietary Names for Pharmaceutical Substances, List 66 WHO Drug Information (Vol. 5, No. 4, 1991).⁵

However, the mark applied for registration is LOSARDIN. LOSARTAN and LOSARDIN may have the same first two syllables (“LO-SAR”), but the suffix “DIN” of LOSARDIN creates distinct visual and aural appearance from the generic term LOSARTAN. There is also no showing that the applied mark LOSARDIN is 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.

This Bureau takes cognizance via judicial notice of the Trademark Registry which shows that LOSAR is commonly used either as a trademark, prefix or component of trademarks used on pharmaceutical products. These marks include LOSARGEN (Registration No. 42009008000); LOSARGARD PLUS (Registration No. 42009001235); LOSARITE (Registration No. 42012006661); and LOSAR (Registration No. 42012002915).⁶

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 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.⁷ This Bureau finds that the mark applied for registration by the Respondent-Applicant has sufficient distinctive qualities to meet the aforestated 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, 23 September 2014.


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

⁵ Exhibit “H” of Opposer.

⁶ IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 22 September 2014).

⁷ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.