



L. R. IMPERIAL, INC.,
Opposer,

-versus-

}
} IPC No. 14-2011-00099
} Opposition to:
} Application No.4-2010-011228
} Date filed: 13 October 2010
} TM: "FEDIPINE"
}
}
}
}
}

CNN GENERICS DISTRIBUTION, INC.,
Respondent-Applicant.

X-----X

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
66 United Street
Mandaluyong City

RYAN C. MENDOZA
For Respondent-Applicant
CNN GENERICS DISTRIBUTION, INC.
2nd Floor, LC Building
459 Quezon City


GREETINGS:

Please be informed that Decision No. 2015 - 48 dated April 06, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 06, 2015.

For the Director:

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


CERTIFIED TRUE COPY
DATE: APR 08 2015
Sharon S. Alcantara
SHARON S. ALCANTARA
Administrative Officer III
Bureau of Legal Affairs



L.R. IMPERIAL, INC.,
Opposer,

- versus -

CNN GENERICS DISTRIBUTION, INC.,
Respondent-Applicant.

x ----- x

IPC No. 14-2011-00099

Opposition to:

Appln. No. 4-2010-011228

Date Filed: 13 October 2010

Trademark : "FEDIPINE"

Decision No. 2015 - 48

DECISION

L.R. IMPERIAL, INC., ("Opposer")¹ filed on 21 March 2011 a verified opposition to Trademark Application Serial No. 4-2010-011228. The application, filed by CNN GENERICS DISTRIBUTION, INC., ("Respondent-Applicant")², covers the mark "FEDIPINE" for use of goods under class 05³ namely: pharmaceutical preparation.

The Opposer alleges the following grounds for opposition:

"7. The registration of the mark 'FEDIPINE' 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

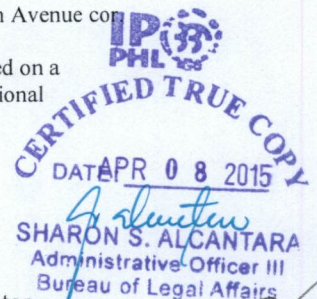
(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time, or other characteristics of the goods or services;

"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 'FEDIPINE' owned by Respondent-Applicant so resembles the generic name 'FELODIPINE', a pharmaceutical drug used as antihypertensive, Respondent-Applicant's application for the registration of the mark 'FEDIPINE' should be denied."

¹ A corporation duly organized and existing under the laws of the Philippines with office address at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan, Philippines.

² A domestic corporation with office address at 2nd Floor, Lawyers Cooperative Bldg., 459 Quezon Avenue cor Banawe, Quezon City.

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.



The Opposer's evidence consists of the following:

1. Exhibit "A"- "A-1" - Pertinent pages of the IPO E-Gazette;
2. Exhibit "B" - Certificate of Registration No. 4-2003-001760 for VERSANT;
3. Exhibit "C" - Sample product bearing the generic name FELODIPINE and the trademark VERSANT; and,
4. Exhibit "D" - Certification and sales performance by IMS Health Philippines, Incorporated.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 16 May 2014. Respondent-Applicant however, did not file an answer. Thus, it is declared in default and this case is deemed submitted for decision.⁴

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

Sec. 123 of the Intellectual Property Code, otherwise known as 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;
- (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.

Records show that the Opposer has registration for the trademark VERSANT dated 26 February 2003⁵ for goods under Classification 05 for antihypertensive/calcium channel blocker pharmaceutical preparation.⁶ The generic name of VERSANT is **FELODIPINE**. Respondent-Applicant, on the other hand, applied for the trademark **FEDIPINE** on 13 October 2010 for good also under Classification 05 for pharmaceutical preparation.⁷

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", "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 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.⁸

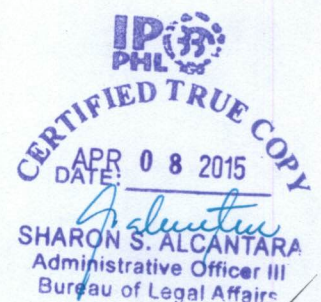
⁴ Order No. 2015-362 dated 06 March 2015.

⁵ Registration No. 4-2003-001760.

⁶ Exhibit "B" of Opposer.

⁷ Filewrapper records.

⁸ Des Produits Nestle, S.A. v. Court of Appeals (356 SCRA 207, 222-223), 2001.



The instant case shows that Respondent-Applicant's FEDIPINE forms part of the generic name FELODIPINE. The only difference is the deletion of the second syllable LO in FELODIPINE. Moreover, the contending pharmaceutical products are used for the same Classification 05 of goods for pharmaceutical preparation which Respondent-Applicant's product may also cover the illness intended to be treated by that of the Opposer.

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 wit:⁹

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

"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.¹⁰ 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.¹¹ 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 exclusive use of them."¹²

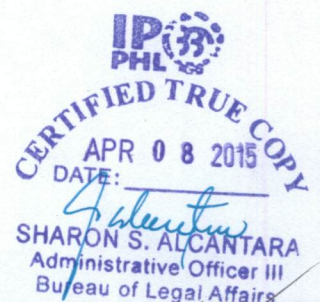
This Bureau finds no cogent reason to rule otherwise in the instant case. The Respondent-Applicant, in coming up with the mark FEDIPINE, merely dropped the syllable LO. This failed to confer a distinctive character on the mark. In looks and in sound, it is practically the same as FELODIPINE. If allowed to register FEDIPINE, it would give the Respondent-Applicant undue advantage over its

⁹ Appeal No. 14-2010-0042

¹⁰ Sec. 138, IP Code.

¹¹ Sec. 121.1, IP Code.

¹² East Pacific Merchandising Corp. v. Director of Patents, G.R. No. L-14377, 29 Dec. 1960.





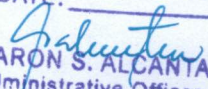
competition and cause confusion among the consumers who would be deceived or be mistaken in believing that what they are buying is a generic drug.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-011228 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 April 2015.


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


CERTIFIED TRUE COPY
DATE: APR 08 2015

SHARON S. ALCANTARA
Administrative Officer III
Bureau of Legal Affairs