



NOVARTIS AG,  
Opposer,

-versus-

TORRENT PHARMA PHILIPPINES, INC.,  
Respondent-Applicant.

}  
} IPC No. 14-2013-00253  
} Opposition to:  
} Appln No. 4-2013-00001888  
} Date Filed: 19 February 2013  
} TM: "VALZAAR"  
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### NOTICE OF DECISION

#### E. B. ASTUDILLO & ASSOCIATES

Counsel for the Opposer  
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8741 Paseo de Roxas  
Makati City

#### TORRENT PHARMA PHILIPPINES, INC.

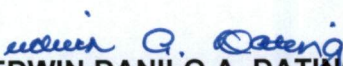
Respondent-Applicant  
Unit 601, 6/F ITC Building  
337 Sen. Gil Puyat Avenue  
Makati City

#### GREETINGS:

Please be informed that Decision No. 2015 - 46 dated April 06, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 06, 2015.

For the Director:

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





**NOVARTIS AG,**

Opposer,

-versus-

**TORRENT PHARMA PHILIPPINES, INC.,**  
Respondent-Applicant.

IPC No. 14-2013-00253

Opposition to Trademark

Application No. 4-2013-00001888

Date Filed: 19 February 2013

Trademark: **"VALZAAR"**

x ----- x Decision No. 2015- 46

### DECISION

Novartis AG<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-00001888. The contested application, filed by Torrent Pharma Philippines, Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "VALZAAR" for use on "*pharmaceutical preparation – angiotension II antagonist*" under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the provision of Section 123.1 (d), (h), (i) and (j) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code). It alleges that "VALZAAR" is confusingly similar to its mark "VALSARTAN (DIOVAN)". Also, it asserts that "VALZAAR" is similar to the generic name *valsartan*. It avers that although its registered mark is "DIOVAN", under the Generics Act of the Philippines, it is required to print on the label of the drug the generic name together with the brand name.

In support of its Opposition, the Opposer submitted the following as evidence:<sup>4</sup>

1. copy of the certificate of registration of "DIOVAN";
2. Affidavit-Testimony of Mireille Valvason; and
3. copy of Novartis AG Annual Report for the year 2012.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 23 October 2013. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 03 February 2014 Order No. 2014-144 declaring the Respondent-Applicant in default and the case submitted for decision.

<sup>1</sup> A corporation duly organized and existing under and by virtue of the laws of Switzerland, with business address at CH-4002 Basel, Switzerland.

<sup>2</sup> With known address at Unit 601 6/F ITC Building, 337 Sen. Gil Puyat Ave., Makati City, Metro Manila.

<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 Exhibits "A" to "C".

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The primordial issue in this case is whether the trademark "VALZAAR" should be allowed.

Records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing application for the mark "DIOVAN" under Certificate of Registration No. 4-1996-10948 issued on 23 June 2000. The application covers "*medicines, pharmaceutical preparations, namely cardiovascular products*".

Clearly, the Opposer's mark "DIOVAN" and the Respondent-Applicant's mark "VALZAAR" are completely different visually and aurally. The Opposer cannot claim protection from "VALSARTAN", which it has no registration. Be that as it may, the Respondent-Applicant cannot be allowed to register the mark "VALZAAR". Notwithstanding its spelling, "VALZAAR" appears to be just a part of the generic or international nonproprietary name (INN) *valsartan*. To allow the Respondent-Applicant to register the same is tantamount to giving the said company an undue advantage over its competitors and cause confusion among the consumers who would be easily deceived that what they are buying is a generic drug.

Succinctly, Section 123 of the IP Code 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) Consists 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 established trade practice;*

*(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 production of the goods or rendering of the services, or other characteristics of the goods or services; x x x" (Emphasis supplied.)*

Generic names 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 a 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 of powers of perception or imagination.<sup>5</sup>

Significantly, this Bureau takes judicial notice of Inter Partes Case No. 14-2009-000249 entitled "Sanofi-Aventis vs. Ranbaxy Laboratories Limited" wherein the opposition to the application for the registration of the mark "IRBESAR" was sustained on the ground that it is confusingly similar to and is a virtual replication of "IRBESARTAN", which is the generic name for a drug mainly used for treating hypertension. On appeal, the Director General sustained this Bureau's ruling in his decision dated 17 December 2012, to wit:

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

***3.1. All the letters in 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 o 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.***

***"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. 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 marks. x x x"***

In this case, while the Respondent-Applicant did not entirely appropriate the generic name *valsartan*, the mark "VALZAAR" is confusingly similar to the said generic name as he mark consists of a substantial part of the latter. The

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<sup>5</sup> Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.



Respondent-Applicant, in coming up with its mark, merely dropped the "tan" in *valsartan*, replaced the "s" with a "z" and added an additional letter "a". When pronounced, the applied mark still sounds like "VALSAR" as the additional letter "a" actually makes no difference and the letters "z" can easily pass off as "s". Despite these modifications, therefore, the applied mark still closely resembles the generic name as to give prospective consumers immediate idea or notice as to the kind, quality and intended purpose of the products it covers.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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 of 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.<sup>6</sup> The Respondent-Applicant's trademark fell short in meeting this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00001888 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

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