



SMITHKLINE BEECHAM LIMITED,  
Opposer,

-versus-

KOREA UNITED PHARM. INC.,  
Respondent-Applicant.

} IPC No. 14-2013-00262  
}  
} Opposition to:  
} Appln No. 4-2012-00010621  
} Date Filed: 31 August 2012  
} TM: "TOPOCAN"  
}  
}  
}  
}

X-----X

### NOTICE OF DECISION

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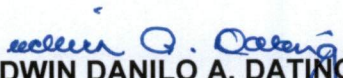
**KOREA UNITED PHARM, INC.**  
Respondent-Respondent  
154-8 Nonhyun-Dong, Kangnam-Gu  
Seoul, Republic of Korea

#### GREETINGS:

Please be informed that Decision No. 2015 - 45 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





**SMITHKLINE BEECHAM LIMITED,** IPC No. 14-2013-00262  
Opposer,  
  
-versus-  
  
**KOREA UNITED PHARM. INC.,**  
Respondent-Applicant. Trademark: **"TOPOCAN"**  
X ----- X Decision No. 2015- 45  
Date Filed: 31 August 2012

### DECISION

Smithkline Beecham Limited<sup>1</sup> ("Opposer") filed an opposition to Trademark Application No. 4-2012-00010621. The contested application, filed by Korea United Pharm. Inc.<sup>2</sup> ("Respondent-Appellant"), covers the mark "TOPOCAN" for use on "*pharmaceutical preparations*" under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer maintains that the Respondent-Applicant's applied mark "TOPOCAN" nearly resembles *topotecan*, which is the generic name for antineoplastics, topoisomerase I inhibitors. It thus anchors its opposition on Section 123.1 (h) of R.A. No. 8293, also known as Intellectual Property Code of the Philippines ("IP Code").

In support of its Opposition, the Opposer submitted a copy of the 2011 Alphabetical List Stems Together with Corresponding INNS and articles from the World Health organization (WHO).

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 10 February 2014. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 16 May 2014 Order No. 2014-640 declaring the Respondent-Applicant in default and the case submitted for decision.

Now, the issue to be resolved is whether the trademark application of Respondent-Applicant for "TOPOCAN" should be allowed.

<sup>1</sup> A domestic corporation duly organized and existing under the laws of United Kingdom, with business address at 980 Great West Road, Brentford, United Kingdom.

<sup>2</sup> With given address at 154-8 Nonhyun-Dong, Kangnam-Gu, Seoul, Republic of Korea.

<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.



A trademark is any distinctive word, name, symbol, emblem, sign, or device, or any combination thereof, adopted and used by a manufacturer or merchant on his goods to identify and distinguish them from those manufactured, sold, or dealt by others. Inarguably, it is an intellectual property deserving protection by law.<sup>4</sup>

As stated in the above definition, a trademark must, first and foremost, be capable of distinguishing one's goods apart from the other. In this case, the Respondent-Applicant's did not entirely appropriate the generic or international nonproprietary name (INN) *topotecan*, but the mark "TOPOCAN" is confusingly similar thereto. The Respondent-Applicant merely dropped or omitted the third syllable "TE" in coming up with its mark. 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.

In this connection, Section 123.1 of the IPC provides that:

"xxx

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

xxx"

The Supreme Court further explained in **Societe des Produits Nestle vs. Court of Appeals**<sup>5</sup> that:

*"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 forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination." (Emphasis supplied.)*

Based on the cited provision of law and jurisprudence, no person or entity can claim exclusive right where the trademark is generic. Significantly, this Bureau takes

<sup>4</sup> Dermaline Inc. vs. Myra Pharmaceuticals Inc., G.R. No. 190065, August 16, 2010.

<sup>5</sup> G.R. No. 112012, April 4, 2001.



judicial notice of Inter Partes Case No. 14-2009-000249 entitled "Sanofi-Aventis vs. 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 name for a drug mainly used for treating hypertension. 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"***

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 No. 4-2012-010621 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, November 19, 1999.