



SANOFI AVENTIS,
Opposer,

-versus-

SUHITAS PHARMACEUTICALS, INC.,
Respondent-Applicant.

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}
} IPC No. 14-2010-00033
} Opposition to:
} Application No.4-2009-003942
} Date filed: 21 April 2009
} TM: "DOGREL"

NOTICE OF DECISION

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SUHITAS PHARMACEUTICALS, INC.
c/o MARYLOU S. PAGANA
For Respondent-Applicant
3rd Floor, Centerpoint Building
Pasong Tamo corner Export Bank Drive
Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 141 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:


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



SANOFI AVENTIS,
Opposer,

-versus-

SUHITAS PHARMACEUTICALS, INC.,
Respondent-Applicant.

IPC No. 14-2010-00033
Opposition to Trademark
Application No. 4-2009-003942
Date Filed: 21 April 2009
Trademark: "**DOGREL**"

x ----- x *Decision No. 2015-141*

DECISION

Sanofi Aventis¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-003942. The contested application, filed by Suhitas Pharmaceuticals, Inc.² ("Respondent-Applicant"), covers the mark "DOGREL" for use on "*pharmaceutical (anti-thrombotic)*" under Class 05 of the International Classification of Goods³.

The Opposer claims to have discovered and developed the drug "CLOPIDOGREL", which is an anti-platelet drug, that is, a drug that inhibits the ability of platelets to lump together as part of a blood clot and therefore reduces the risk of heart attacks and strokes. It avers that it marketed the drug using the trademark "PLAVIX", which it also registered in the Philippines on 21 May 1996. It alleges that in 1987, "CLOPIDOGREL" was adopted by the International Nonproprietary name (INN) by the World Health Organization (WHO) and as such, "CLOPIDOGREL" is globally recognized and is public property. It asserts that the Respondent-Applicant's mark "DOGREL" should not be allowed registration as it lacks distinctiveness and is confusingly similar to the INN "CLOPIDOGREL".

In support of its Opposition, the Opposer submitted a copy of its registration for "PLAVIX", copies of the excerpts of WHO's INN for Pharmaceutical Substances Cumulative List No. 7, 8 and 9 as well as the certification of the WHO Regional Office Assistant Librarian, Ms. Constancia D. Basilio.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 01 March 2010. The Respondent-Applicant, however, did not file an Answer.

¹ A corporation duly organized and existing under and by virtue of the laws of France, with business address at 174 avenue De France, 75013 Paris, France.

² A corporation organized and existing under and by virtue of the laws of the Philippines with office address at 3rd Floor Centerpoint Building, Pasong Tamo corner Export Bank Drive, Makati City.

³ 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.

⁴ Marked as Exhibits "B" to "D", inclusive.

The issue to be resolved is whether the trademark "DOGREL" should be allowed.

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"

Thus, the Respondent-Applicant cannot be allowed to register the mark "DOGREL" as it is just a part of the generic or international nonproprietary name (INN) *clopidogrel*. To allow Respondent-Claimant to register "DOGREL" 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.

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.⁵

Significantly, this Bureau takes 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

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

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 or 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"

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.⁶ Respondent-Applicant's trademark fell short in meeting this function.

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

Finally, records show that in IPC Case No. 14-2014-000267⁷, which involves the same trademark application, this Bureau already rendered a decision⁸, the dispositive portion of which provides:

“WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-003942 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.”

This Bureau finds no reason to deviate from its ruling in the said case.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-003942 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 June 2015.


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

⁷ Novartis AG vs. Suhitas Pharmaceuticals, Inc.

⁸ Decision No. 2014-267, 24 October 2014.