

**BIOFARMA and LES LABORATOIRES  
SERVIER,**

Opposer,

**-versus-**

**CNN GENERICS DISTRIBUTION INC.,**

Respondent- Applicant.

X-----X

**IPC No. 14-2011-00146**

Opposition to:

Appln. Serial No. 4-2010-000370

Date Filed: 12 January 2010

**TM: "GLAZIDE"**

**NOTICE OF DECISION**

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**CNN GENERICS DISTRIBUTION, INC.**

Respondent- Applicant

2<sup>nd</sup> Floor, LC Building

459 Quezon Avenue, Quezon City

**GREETINGS:**

Please be informed that Decision No. 2016 - 64 dated March 01, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 01, 2016.

For the Director:

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

**Republic of the Philippines  
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**DECISION NO. 2016 - 64**

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## DECISION

BIOFARMA and LES LABORATOIRES SERVIER (“Opposer”) <sup>1</sup> filed an Opposition to Trademark Application Serial No. 4-2010-000370. The application, filed by CNN GENERICS DISTRIBUTION INC., (Respondent-Applicant) <sup>2</sup>, covers the mark “GLAZIDE,” for use on “*Pharmaceutical preparations*” under Class 05 of the International Classification of Goods. <sup>3</sup>

The Opposer alleges, among other things, that the mark “GLAZIDE” is very similar to, if not almost identical and so resembles, the generic name for antidiabetic drugs “GLICLAZIDE.” According to the Opposer, the registration of “GLAZIDE” will violate Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) which proscribes the registration of a mark if it “consists exclusively of signs that are generic for the goods or services that they seek to identify” or “consist exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose xxx or other characteristics of the goods or services.” <sup>4</sup>

In support of its Opposition, the Opposer submitted the following:

1. Exhibit “A” – authenticated copy of the Affidavit of Aurelie Boissaye;

<sup>1</sup> A corporation organized and existing under the laws of the France with office address at 22 Rue Garnier 92200 Neuilly-sur-Seine, France.

<sup>2</sup> A corporation organized and existing under the laws of the Philippines with business address at @nd Flr. LC Bldg. 459 Quezon Ave. Quezon City

<sup>3</sup> *The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.*

<sup>4</sup> Verified Notice of Opposition dated 30 March 2011 pp 2-3

2. Exhibit "B" – copy of the List of International Nonproprietary Names for Pharmaceutical Substances Reprinted from WHO Chronicle Vol. 25 No. 10;
3. Exhibit "B-1" – French copy of the List of International Nonproprietary Names for Pharmaceutical Substances;
4. Exhibit "C" – copy of the pertinent portion Merck Index 13th edition;
5. Exhibit " D" – print out of the Pharmaprojects document on Gliclazide;
6. Exhibit "E" – copy of document on 46 World Health Assembly dated 3-14 May 1993 regarding Resolution WHA46.19 on Nonproprietary names for pharmaceutical substances;
7. Exhibit "F" – copy of IPOPHL Bureau of Legal Affairs of Decision dated 15 May 2003 on the trademark NAPAMIDE;
8. Exhibit "G" – copy of IPOPHL Bureau of Legal Affairs of Decision dated 26 November 2007 on Trademark TRIMETAZEL;
9. Exhibit "H" to "H-3"– Copy of the translated Decision of Asst. Registrar of Trade Marks of India on the trademark GLICLA;
10. Exhibit "I" – Certificate of Registration of the Trademark Diamicon owned by Respondent-Applicant;
11. Exhibit "J" – Affidavit of Jacques Servier certifying for the Biofarma and Les Laboratoires Servier as affiliated companies of Servier group;
12. Exhibit "K" – copy of Sales Orders and Invoices of Zuellig Pharma Philippines (Servier) of their product Diamicon;
13. Exhibit "L" – The copy of the packaging of product Diamicon in the Philippines; and
14. Exhibit "L-1" – the copy of the articles on diabetes and advertisements of the product Diamicon in DIABETEASE Magazines.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 6 June 2011. The Respondent-Applicant, however did not file an Answer. Hence, in an Order dated 12 August 2013, the Respondent-Applicant was declared in default.

The issue to resolve in the present case is whether the Respondent - Applicant should be allowed to register the trademark "GLAZIDE."

The Supreme Court has held that 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.<sup>5</sup> Succinctly, the primary function of a trademark is to distinguish one's goods from that of the others.

Under Section 123.1 of the IP Code a mark cannot be registered if it:

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<sup>5</sup> Dermaline Inc. vs. Myra Pharmaceuticals Inc., G.R. No. 190065, 16 August 2010

“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 bonafide and established trade practice;

(j) Consists 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; xxx”

In the instant case, the trademark being applied for registration by the Respondent-Applicant is very similar, if not almost identical and so resembles a generic or international nonproprietary name (“INN”). The Respondent-Applicant’s mark is composed of seven (7) of the ten (10) letters of the generic pharmaceutical substance. The Respondent-Applicant merely removed the middle three letters “ICL” in the International Non-proprietary Name “GLICLAZIDE” to form its trademark “GLAZIDE.” The Respondent-Applicant’s modification was not sufficient to effectively render the mark distinctive and distinguishable from the generic name. In fact even “GLAZIDE” is almost identical to “CLAZIDE” in looks and in sound. If pronounced, there is hardly any difference between “GLAZIDE” and the syllables “CLAZIDE” such that the syllable “GLI”, is almost of no consequence.

The Supreme Court held that the generic terms are those which constitute the common descriptive name of an article or substance, or comprise of 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.<sup>6</sup> No person or entity can claim exclusive right where the trademark is generic mark.

As correctly pointed out by the Opposer, issues identical to the present case have already been previously resolved by the Office and thus, instructive in the present case. In Inter Partes Case No. 4082 entitled “*Orsem vs. Douglas Pharmaceuticals Limited*”, this Bureau sustained the Opposition against the registration of the trademark “NAPAMIDE” for being confusingly similar with the generic term “INDAPAMIDE.” Similarly, this Bureau held in Inter Partes Case No. 14-2007-00069 entitled “*Biofarma vs. Therapharma*” that the

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<sup>6</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 4 April 2001



mark "TRIMETAZEL" cannot be registered on the ground of confusing similarity with the generic term and INN "TRIMETAZIDINE."

In line with the above pronouncement, the Director General has further elucidated in Inter Partes Case No. 14-2010-0042 entitled "*Ranbaxy Laboratories Limited vs. Sanofi-Aventis*" regarding the opposition of the trademark "IRBESAR", as follows:

Under the law, a generic word is free for all to use and cannot be registered as a mark. In the pharmaceutical field, generic name or generic terminology is the identification of drugs and medicines by their scientifically and internationally recognized active ingredients or by their official generic name as determined by the Bureau of Food and Drugs of the Department of Health. On the other hand, in the international field for pharmaceutical substances, a generic name is also known as a nonproprietary name and an International Nonproprietary Name ("INN") identifies a pharmaceutical substance or active pharmaceutical ingredient by a unique name that is globally recognized and is public property.

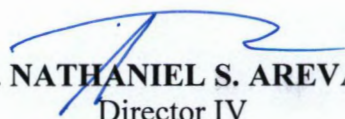
Verily, the registration of "GLAZIDE" would give the Respondent-Applicant the exclusive right to use this mark and unreasonably prevent others from using similar marks including the generic name "GLICLAZIDE" to the detriment of the consuming public. The same is not sanctioned under our trademark laws.

Time and again, it is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article 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 products.<sup>7</sup> The trademark applied for registration by the Respondent-Applicant does not meet this function.

**WHEREFORE**, premises considered, the instant opposition to Trademark Application Serial No. 42010000370 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42010000370 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

**SO ORDERED.**

Taguig City, 1 March 2016

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

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<sup>7</sup> *Mirpuri vs. Court of Appeals* G.R. No. 114508, 19 November 1999