

L.R. IMPERIAL, INC.,  
Opposer,

-versus-

THE CATHAY YSS DISTRIBUTORS  
COMPANY, INC.,  
Respondent- Applicant.

X-----X

}  
} **IPC No. 14-2015-00494**  
} Opposition to:  
} Appln. Serial No. 4-2015-0001487  
} Date Filed: 11 February 2015  
} **TM: "FORMIN"**  
}  
}  
}  
}  
}

**NOTICE OF DECISION**

**OCHAVE & ESCALONA**  
Counsel for the Opposer  
No. 66 United Street  
Mandaluyong City

**BELLO VALDEZ CALUYA & FERNANDEZ**  
Counsel for Respondent-Applicant  
6<sup>th</sup> Floor, SOL Building, 122 Amorsolo Street  
Legaspi Village, Makati City

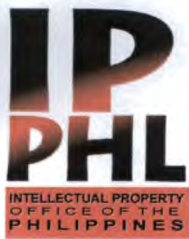
**GREETINGS:**

Please be informed that Decision No. 2016 - 210 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



L.R. IMPERIAL, INC.,	}	IPC NO. 14-2015-00494
Opposer,	}	
	}	
-versus-	}	Opposition to:
	}	App.Serial No. 4-2015-0001487
	}	Date Filed: 11 February 2015
THE CATHAY YSS DISTRIBUTORS	}	TM: "FORMIN"
COMPANY, INC.,	}	
Respondent-Applicant.	}	
	}	Decision No. 2016 - <u>210</u>
X-----X		

**DECISION**

L.R. IMPERIAL, INC. ("Opposer")<sup>1</sup>, filed an opposition to Trademark Application Serial No. 4-2015-0001487. The application filed by THE CATHAY YSS DISTRIBUTORS COMPANY, INC. ("Respondent-Applicant")<sup>2</sup> covers the mark "FORMIN" for use on "*non-insulin treatment for diabetes*" under Class 5 of the International Classification of Goods.<sup>3</sup>

The Opposer alleges that the registration of the mark FORMIN in the name of Respondent-Applicant will violate Section 123.1 (h) and (j) of the IP Code. According to Opposer, under the said provision, any mark which is similar to a generic and/or descriptive term, shall be denied registration. Thus, considering that the mark applied for by Respondent-Applicant FORMIN so resembles the generic name METFORMIN, an oral diabetes medicine that helps control blood sugar levels, Respondent-Applicant's application for registration of the mark FORMIN should be denied.

Opposer's evidence consists of the following:

1. Copy of the pertinent page of IPO E-Gazette published on 21 September 2015;
2. Certificate of Registration No. 4-2001-003304 for the mark GLUMET issued to Opposer ON 08 July 2004;
3. Copy of the Notice of Issuance with Document No. 2014/115667 for the mark GLUMET
4. Declaration of Actual Use for the mark GLUMET filed on 06 February 2004;
5. Affidavit of Use for the 5<sup>th</sup> Anniversary for the mark GLUMET filed on 23 July 2009;
6. Actual product label of Opposer's GLUMET ;
7. Certification and sales performance issued by IMS for the brand GLUMET; and

<sup>1</sup> A corporation organized and existing under the laws of the Philippines with business address at Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan, Metro Manila.

<sup>2</sup> A domestic corporation with address at 2/F Vernida I, Amorsolo Street, Legaspi Village, Makati City.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

8. Certificate of Product Registration issued by the Food and Drug Administration for GLUMET; and
9. Electronic printout of the World Health Organization (WHO) Chronicle (Vol. 23, No. 4, 1969, p. 11) List 21.

This Bureau issued on 05 November 2015 a Notice to Answer and personally served a copy thereof upon the Respondent-Applicant on 24 November 2015. On 04 January 2016, Respondent-Applicant filed the Answer alleging the following Special and Affirmative Defenses:

"Opposer will not be damaged by the registration of Respondent-Applicant's mark FORMIN.

Contrary to Opposer's claim, FORMIN is not confusingly similar to METFORMIN.

Respondent-Applicant's evidence consists of the following:

1. Secretary's Certificate; and
2. Affidavit of Nona F. Crisol;

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation. On 01 February 2016, the Bureau's ADR Services submitted a report that the parties failed to settle the dispute. The preliminary conference was terminated on 10 May 2016 and the parties were directed to submit position papers. On 20 May 2016, the parties submitted their respective Position Papers.

Should the Respondent-Applicant be allowed to register the mark FORMIN?

Section 123.1 of Republic Act No. 8293, as amended, also known as the Intellectual Property Code of the Philippines ("IP Code") provides, in part, that a mark cannot be registered if it:

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

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 production of the goods or rendering of the services, or other characteristics of the goods or services;

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 the genus and the exclusion of individuating characters", or refer to the basic nature of the wares of 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 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 a customer does not have to exercise power of perception or imagination."<sup>4</sup>

METFORMIN is recognized as one of the International Nonproprietary Names for pharmaceutical substances or active pharmaceutical substances by the World Health Organization. Metformin is the generic name for drugs used to treat high blood sugar levels that are caused by a type of diabetes mellitus or sugar diabetes called type 2 diabetes.<sup>5</sup>

In this case, Opposer claims that Respondent-Applicant's mark resembles the generic name METFORMIN. The mark of Respondent-Applicant is reproduced below:

## FORMIN

It appears that Respondent-Applicant's mark is confusingly similar to the generic name METFORMIN. To arrive at the subject mark, Respondent-Applicant merely removed the letters "M-E-T" in "METFORMIN" to form the mark FORMIN. There is no real creativity or ingenuity in the adoption of the mark FORMIN as the Respondent-Applicant merely dropped the letters "MET" from "Metformin". The mark or brand name itself suggests or tells the consumers the goods or service it covers and/or its kind, use, purpose or nature thereof.

The similarity is very obvious that to allow the registration of Respondent-Applicant's mark would allow exclusive appropriation of the generic name "Metformin" and prevent others from using similar mark as well as the generic name "Metformin". Appropriation like this cannot be countenanced for it is the interest of the public that a registered mark should clearly distinguish the goods of the enterprise and that generic names and those confusingly similar to them be taken outside the realm of registered marks.<sup>6</sup>

Finally, the main characteristic of registrable trademark is its distinctiveness. A trademark must be a visible sign capable of distinguishing the goods or services of an enterprise.<sup>7</sup> From the foregoing, FORMIN cannot be considered a distinctive mark that would merit trademark registration. FORMIN is substantially similar to the generic name METFORMIN that the use of the former can only be construed as an abbreviation of the latter. The Supreme Court in one case ruled that:

[K]nown 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

<sup>4</sup> *Des Produits Nestle S.A. v. Court of Appeals*, (356 SCRA 207, 222-223), 2001.

<sup>5</sup> <http://www.mayoclinic.org/drugs-supplements/metformin-oral-route/description/drg-20067074>

<sup>6</sup> See BLA Decision No. 2014-233 of IPC No. 14-2011- 00153 promulgated on 22 September 2014.


<sup>7</sup> *Intellectual Property Code of the Philippines (IP Code)*, Section 121.1

one who first uses them is to form them a trademark for him expressing only of origin with himself, if they do not in fact show forth the quality and composition of the article sold by him, he may not be protected in the exclusive use of them.<sup>8</sup>

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2015-0001487, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, **30 JUN 2018**

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

---

<sup>8</sup> *East Pacific Merchandising Corp. v. Director of Patents, G.R. No. L-14377, 29 December 1960.*