

MYRA PHARMACEUTICALS, INC.,
Opposer,

-versus-

EDGARDO Q. SANTOS,
Respondent- Applicant.

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}
} IPC No. 14-2015-00296
} Opposition to:
} Appln. Serial No. 4-2014-501778
} Date Filed: 25 November 2015
} TM: "AMINOCID"

NOTICE OF DECISION

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

EDGARDO Q. SANTOS
Respondent-Applicant
782 San Rafael Street
Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2016 - 164 dated June 02, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 02, 2016.

For the Director:

Edwin O. Datinc
Atty. EDWIN DANIL(A) A. DATINC
Director III
Bureau of Legal Affairs

MYRA PHARMACEUTICALS, INC.,
Opposer,

-versus-

EDGARDO Q. SANTOS,
Respondent-Applicant.

IPC NO. 14-2015-00296

Opposition to:
App. Serial No. 4-2014-501778
Date Filed: 26 November 2015
TM: "AMINOCID"

Decision No. 2016- 164

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DECISION

MYRA PHARMACEUTICALS, INC. ("Opposer"),¹ filed an opposition to the Trademark Application Serial No. 4-2014-501778. The application filed by EDGARDO Q. SANTOS ("Respondent-Applicant")², covers the mark "AMINOCID" for use on "*multivitamins amino acids*" under Class 05 of the International Classification of Goods.³

The Opposer alleges that the registration of the mark AMINOCID in the name of Respondent-Applicant will violate Section 123.1 (h) and (j) of the IP Code. Opposer claims that the mark AMINOCID so resembles the generic name AMINO ACID, an organic compound that combines to form proteins and which is a source of energy by the human body.

Opposer's evidence consists of the following:

1. Exhibit "A" - Copy of the pertinent page of IPO e-Gazette dated 25 April 2015;
2. Exhibit "B" - copy of the Trademark Registration No. 34977 for the mark REVICON;
3. Exhibit "C" - copy of the Certificate of Renewal of Registration No. 34977;
4. Exhibits "D" to "G" - copies of Affidavits of Use;
5. Exhibit "H" - sample product label bearing the trademark REVICON which shows the generic name AMINO ACIDS;
6. Exhibit "I" - Certificate of Product Registration of Revicon issued by BFAD (now FDA); and
7. Exhibit "J" - print-out of pertinent page of wikipedia relating to amino acid.

This Bureau issued on 02 July 2015 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 09 July 2015. The Respondent-Applicant, however, did not file the Answer. On 11 November 2015, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed

¹ A domestic corporation with principal office address at 4th Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A Filipino citizen with address at #782 Rafael Street, Mandaluyong City.

³The 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.

submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **AMINOCID**?

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;

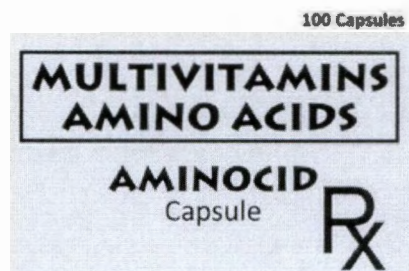
x x x

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 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 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."⁴

In this regard, record show that AMINO ACID is a generic name used for certain vitamins and supplements. An amino acid is a type of organic acid that contains an acid functional group and an amine functional group on adjacent carbon atoms. Amino acids are considered to be the building blocks of proteins.

The mark of Respondent-Applicant is reproduced below:



It appears that Respondent-Applicant's mark is confusingly similar to or a replication of the generic name amino acid. To arrive at the subject mark, Respondent-

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

Applicant merely removed the letter "A" in " acid" and combine the word "amino" to the "cid" to form the mark AMINOCID.

The similarity is very obvious that to allow the registration of Respondent-Applicant's mark would allow exclusive appropriation of the generic name amino acid and prevent others from using similar mark as well as the generic name amino acid. 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.⁵


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.⁶ From the foregoing, AMINOCID cannot be considered a distinctive mark that would merit trademark registration. AMINOCID is substantially similar to the generic name AMINO ACID 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 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.⁷

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-501778, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 JUN 2016


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

⁵ See BLA Decision No. 2014-233 of IPC No. 14-2011-00153 promulgated on 22 September 2014.

⁶ Intellectual Property Code of the Philippines (IP Code), Section 121.1

⁷ East Pacific Merchandising Corp. v. Director of Patents, G.R. No. L-14377, 29 December 1960.