



UNITED LABORATORIES, INC.,
Opposer,

-versus-

EUROASIA PHARMACEUTICALS, INC.,
Respondent-Applicant.

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}
} **IPC No. 14-2015-00436**
} Opposition to:
} Appln. Serial No. 4-2015-004055
} Date Filed: 16 April 2015
} **TM: "PARABUFEN"**
}

NOTICE OF DECISION

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EUROASIA PHARMACEUTICALS, INC.
Respondent- Applicant
Unit 1201 12/F AIC Burgundy Empire Tower
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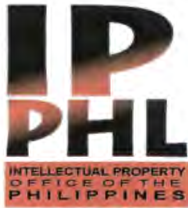
GREETINGS:

Please be informed that Decision No. 2016 - 269 dated July 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 28, 2016.

For the Director:

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



UNITED LABORATORIES, INC., }
Opposer, }
 -versus- }
 EUROASIA PHARMACEUTICALS, INC., }
Respondent-Applicant. }
 x-----x

IPC No. 14-2015-00436
 Case Filed: 16 September 2015
 Opposition to:
 Application No. 4-2015-004055
 Date Filed: 16 April 2015
 Trademark: "PARABUFEN"

Decision No. 2016- 269

DECISION

UNITED LABORATORIES, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-004055. The application, filed by Euroasia Pharmaceuticals, Inc.² ("Respondent-Applicant"), covers the mark "PARABUFEN" for use as "pharmaceutical preparations" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"GROUNDS FOR OPPOSITION

"The grounds for this Verified Notice of Opposition are as follows:

"7. The registration of the mark 'PARABUFEN' in the name of the Respondent-Applicant will violate Sec. 123.1 (h) and (j) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

"8. Under the above-quoted provision, any mark, which is similar to a generic and/or descriptive term, shall be denied registration. Thus, considering the mark 'PARABUFEN' applied by Respondent-Applicant so resembles the generic name 'IBUPROFEN', a non-steroidal anti-inflammatory drug (NSAID) used for relieving pain, helping with fever and reducing fever, Respondent-Applicant's application for the registration of the mark 'PARABUFEN' should be denied.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

¹A corporation duly organized and existing under the laws of the Philippines with principal office located at No. 66 United St., Mandaluyong City, Philippines.

²A domestic corporation with address at Unit 1201 12/F AIC Burgundy Empire Tower, ADB Ave., Ortigas Business Center, Pasig City, Metro Manila, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"In support of this Verified Notice of Opposition, Opposer will rely upon and prove the following facts:

"9. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. Opposer is the owner of the trademark 'MEDICOL'. The generic name and/or active ingredient of the pharmaceutical product 'MEDICOL' is 'IBUPROFEN'.

"9.1. The Trademark Application for the trademark 'MEDICOL' was filed with the Philippine Patent Office and was approved for registration on 1 August 1984 to be valid for a period of twenty (20) years, or until 1 August 2004. A certified true copy of the Certificate of Registration No. 33517 issued by the Philippine Patent Office is hereto attached x x x

"9.2. Before the expiration of the registration, Opposer's sister company, Myra Pharmaceuticals, Inc. ('Myra') filed an application for renewal of registration for the trademark 'MEDICOL' with the IPO, which was accordingly granted to be valid for another period of ten (10) years from 1 August 2004, or until 1 August 2014. A certified true copy of the Certificate of Renewal of Registration No. 33517 is hereto attached x x x

"9.3. In the meantime, on 10 October 2005, Myra assigned the trademark 'MEDICOL' to Opposer's affiliate, Unam Brands (BVI) Ltd. ('Unam'). A certified true copy of the Assignment of Registered Trademark is hereto attached x x x

"9.4. Subsequently, on 24 October 2007, Unam assigned the trademark 'MEDICOL' to herein Opposer. A certified true copy of the Assignment of Registered Trademark is hereto attached x x x

"9.5. Prior to the expiration of the Certificate of Renewal of Registration No. 33517, Opposer filed a Petition for Renewal of Registration of the trademark 'MEDICOL' with the IPO, which was accordingly granted. A certified true copy of the Petition for Renewal of Registration for the trademark 'MEDICOL' is hereto attached x x x and the Notice of Issuance by the IPO is hereto attached x x x

"10. The trademark 'MEDICOL' has been extensively used in commerce in the Philippines.

"10.1. Opposer's sister company, Myra, and Opposer have dutifully filed Affidavits of Use pursuant to the requirement of the law. Certified true copies of the Affidavits of Use filed are hereto attached x x x.

"10.2. A sample product label bearing the trademark 'MEDICOL', which shows the generic name 'IBUPROFEN', actually used in commerce is hereto attached x x x.

"10.3. No less than the Intercontinental Marketing Services ('IMS') itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand

'MEDICOL' as one of the leading brands in the Philippines in the category of 'M01A - Antirheumatic Non-Steroids and N02B - Non-Narcotic Analgesics with Ibuprofen molecule' in terms of market value. The Certification is hereto attached x x x

"10.4. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, Opposer registered the product with the Food and Drugs Administration ('FDA'). A certified true copy of the Certificate of Product Registration issued by the FDA for 'MEDICOL' is hereto attached x x x.

"11. By virtue of the foregoing, it is submitted that Opposer will be damaged by the unfair use of the mark 'PARABUFEN' by Respondent-Applicant as this is closely and confusingly similar to the generic name 'IBUPROFEN', which gives Respondent-Applicant an undue advantage to the affinity of its mark 'PARABUFEN' to the generic name 'IBUPROFEN'.

"12. Moreover, the registration of the mark 'PARABUFEN' clearly violates the IP Code's prohibition on registration of a generic and/or descriptive term in such that all legitimate users, including Opposer, of the generic component 'IBUPROFEN' in their pharmaceutical product have a right to oppose Respondent-Applicant's application for registration of the mark 'PARABUFEN' to implement the law, otherwise, such prohibition may be rendered nugatory.

"13. As enunciated earlier, the registration of Respondent-Applicant's mark 'PARABUFEN' will be contrary to Section 123.1 (h) and (j) of the IP Code. The mark 'PARABUFEN' owned by Respondent-Applicant so resembles the generic name and/or descriptive term 'IBUPROFEN', which is incapable of being appropriated.

"14. In *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [356 SCRA 207, 222-223 [2001]], the Supreme Court defined generic and descriptive terms as follows:

x x x

"15. Further, the generic name 'IBUPROFEN' is listed in the World Health Organization (WHO) Chronicle 1967 (Vol. 21) List 7 as one of the International Nonproprietary Names (INN) for Pharmaceutical Substances. An electronic print out of the WHO Chronicle 1967 (Vol. 21) List 7 is hereto attached x x x

"16. 'The INN is the official non-proprietary or generic name given to a pharmaceutical substance, as designated by the WHO. The plethora of named proprietary preparations containing a given substance can lead to confusion about the identity of the active ingredient. INNs facilitate communication by providing a standard name for each substance; they are designed to be unique and distinct so as to avoid confusion in prescribing.

"17. Under the WHO Guidance and Mission of the INN, INN drugs such as 'IBUPROFEN', is referred to as generic and thus, cannot be appropriated as trademark for any pharmaceutical product, to wit:

x x x

"18. Clearly, to allow registration of Respondent-Applicant's mark 'PARABUFEN' will violate Section 123.1 (h) and (j) of the IP Code on the ground that

such mark is closely and confusingly similar to the generic name (an INN) 'IBUPROFEN', which is the generic and/or descriptive term of the active ingredient of the kind, quality and intended purpose of goods covered by Respondent-Applicant's mark; hence, cannot be exclusively appropriated and registered as a trademark.

"19. The generic name 'IBUPROFEN' and Respondent-Applicant's mark 'PARABRUFEN' are practically identical marks in sound and appearance that they leave the same impression upon the public.

"20. Yet, Respondent still filed a trademark application for 'PARABRUFEN' despite its knowledge of the generic name 'IBUPROFEN', which is confusingly similar thereto in both its sound and appearance. To allow the registration of Respondent-Applicant's mark 'PARABRUFEN' will have the unintended effect of Respondent-Applicant having appropriated the generic name 'IBUPROFEN' for itself, and thus, giving it an undue advantage by reason of the affinity of its mark 'PARABRUFEN' to the generic name 'IBUPROFEN'.

"21. Significantly, this is not the first time that this Honorable Bureau has passed upon the issue of whether a mark that is obviously a replication of the generic name should be allowed to be registered or not.

"21.2. In Inter Partes Case No. 14-2010-00275 entitled: Therapharma, Inc. vs. Zydus Philippines, Inc., this Honorable Bureau, citing the Decision of the Director General of the IPO in Inter Partes Case No. 14-2009-00249 entitled: Sanofi-Aventis vs. Ranbaxy Laboratories, Limited, denied the application for registration of the mark 'ATORVA' owned by Zydus Philippines, Inc. for being confusingly similar to the generic name 'ATORVARSTATIN'.

"22. It is clear, therefore, that the denial of the application for registration of Respondent-Applicant's mark 'PARABRUFEN' is warranted and authorized under the IP Code on the ground that it is confusingly similar, if not substantially identical, to the generic name and/or descriptive term 'IBUPROFEN'.

"23. In support of the foregoing, the instant Notice of Opposition is herein verified by Mr. Jose Maria A. Ochave, which will likewise serve as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783, 792-793 [1990]).

The Opposer's evidence consists of a copy of the pertinent page of the IPO E-Gazette officially released on 17 August 2015; a copy of the Certificate of Registration No. 33517 for the trademark MEDICOL; a copy of the Certificate of Renewal of Registration No. 33517; a copy of the Assignment of Registered Trademark to Unam Brands (BVI) Ltd.; a copy of the Assignment of Registered Trademark to United Laboratories, Inc.; a copy of the Petition for Renewal of Registration for the trademark MEDICOL and a copy of the Notice of Issuance issued by the IPO; copies of the Affidavits of Use for the trademark MEDICOL; a sample product label bearing the trademark MEDICOL; a copy of the Certification issued by the Intercontinental Marketing Services ('IMS'); a copy of the Certificate of Product Registration issued by FDA for MEDICOL; and an electronic print-out of the WHO Chronicle 1967 (Vol. 21)

List 7 which listed the generic name IBURPOFEN as one of the International Nonproprietary Names (INN).⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 07 October 2015. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark PARABRUFEN?

In this regard, the Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123. Registrability. - 123.1. 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;
- x x x
- (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.

Hence, the question, does PARABUFEN resemble the generic name IBUPROFEN such that confusion or deception is likely to occur? The marks are shown below:

Ibuprofen

Parabufen

Generic Name for MEDICOL

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur in this instance. Although the contending marks have the same number of letters and syllables, the visual and aural properties in respect of the Respondent-Applicant's mark has rendered said mark a character that is distinct from the Opposer's. While the marks are common as to the letters "B", "U", "P", "R", "F", "E" and "N", the arrangement of the syllables and the use of the letter "A" to come up with the first two (2) syllables PARA in Respondent's mark make it easier for the consumers to distinguish Respondent's PARABUFEN from the generic name IBUPROFEN.


⁴Marked as Exhibits "A" to "K", inclusive.

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.⁵ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2015-004055 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 28 JUL 2016.


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

⁵Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.