

NOVARTIS AG,
Opposer,

-versus-

SUN PHARMA PHILIPPINES, INC.,
Respondent- Applicant.

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IPC No. 14-2015-00614
Opposition to:
Appln. Serial No. 4-2015-007168
Date Filed: 29 June 2015
TM: "ZOLEDRONIC ACID
ZOBONE"

X-----X

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

Counsel for the Opposer
Citibank Center, 10th Floor
8741 Paseo de Roxas
Makati City

SUN PHARMA PHILIPPINES, INC.

Respondent-Applicant
Unit 604, 6th Floor, Liberty Center Building
104 H.V. Dela Costa St., Salcedo Village
Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 33 dated February 08, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, February 09, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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NOVARTIS AG,
Opposer,

- versus -

"SUN PHARMA PHILIPPINES, INC.,
Respondent-Applicant.

X ----- X

IPC No. 14-2015-00614
Opposition to:

Appln. No. 4-2015-007168
Date Filed: 29 June 2015
Trademark: "**Zoledronic Acid**
Zobone 4 mg/5ml concentrate
for I.V. infusion bisphosphonate"

Decision No. 2017 - 33

DECISION

NOVARTIS AG ("Opposer"),¹ filed a Verified Opposition to Trademark Application Serial No. 4-2015-007168. The application, filed by SUN PHARMA PHILIPPINES, INC. ("Respondent-Applicant"),² covers the mark "Zoledronic Acid Zobone" for use on "*printed materials*" under class 16 of the International Classification of Goods.³

The Opposer alleges the following grounds for opposition:

"12. The mark being applied for by the respondent-applicant contains the term ZOLEDRONIC ACID which is an International Nonproprietary Name (INN) which cannot be appropriated. Under the World Health Organization (WHO) mandate recognized by Philippine law, a trademark should neither be derived from INNs nor contain common stems used in INNs. Section 1.1 of the WHO Guidelines on the Use of International Nonproprietary Names for Pharmaceutical Substances specifically states that:

"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. A nonproprietary name is also known as a generic name."

"13. The registration of the trademark Zoledronic Acid Zobone in the name of respondent-applicant will violate Section 123.1, subparagraphs (a), (g), (h), and (m) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code), to wit:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

(a) Consists of immoral, deceptive or scandalous matter, ...

¹ A corporation duly organized and existing under and by virtue of the laws of Switzerland, with business address at 4002 Basel, Switzerland.

² A corporation with business address at Unit 604, 6th Floor, Liberty Center Building, 104 H.V. Dela Costa St., Salcedo Village, Makati City, Metro Manila, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

x x x

(g) Is likely to **mislead the public** particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

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

x x x

(m) Is **contrary to public order** or morality.

"14. The registration of the mark Zoledronic Acid Zobone in the name of respondent-applicant is contrary to other provisions of the IP Code of the Philippines.

The Opposer's evidence consists of the following:

1. Copy of the Recommended International Nonproprietary Names List No. 35 published in the World Health Organization (WHO) Drug Information Volume 9, No. 3 issued in 1995;
2. Copy of the Guidelines on Marks and International Nonproprietary Names (INN) for Pharmaceutical Substances;
3. Notarized and legalized Affidavit-Testimony of witness Martine Roth dated 17 February 2016;
4. Notarized and legalized Corporate Secretary's Certificate dated 16 February 2016; and,
5. Novarits AG's Annual Report for the year 2015.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 28 March 2016. Respondent-Applicant however, did not file an answer. Thus, it is declared in default and this case is deemed submitted for decision⁴.

Should the Respondent-Applicant be allowed to register the trademark **Zoledronic Acid Zobone**?

Sec. 123 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides, in part, that a mark cannot be registered if it:

- (h) Consist exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consist 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 establishes trade practice;
- (j) Consist 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, of other characteristics of the goods or services."

⁴ Order of Default dated 15 July 2016.

Respondent-Applicant's mark is illustrated as follows:



The Opposer alleges that Respondent-Applicant's aforementioned subject mark, specifically "Zoledronic Acid" is an International Nonproprietary Name (INN) which is included in the Recommended International Nonproprietary Names List No. 35 published in the World Health Organization (WHO) Drug Information Volume 9, No. 3 issued in 1995. As such, the term "Zoledronic Acid" is a generic name. It cannot be registered because it is not capable of exclusive appropriation and it constitutes an "absolute ground for refusal".⁵ In support of this instant opposition, the Opposer submitted a copy of the Recommended International Nonproprietary Names List No. 35 published in the World Health Organization (WHO) Drug Information Volume 9, No. 3 issued in 1995⁶, and the Guidelines on Marks and International Nonproprietary Names (INN) for Pharmaceutical Substances⁷. The documents show that the term Zoledronic Acid is indeed included among the INN.

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 a genus and the exclusion of individuating characters"*, or imply reference to *"every member of a 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 or ingredients of a product to one who has never seen it and does not know what it is"*, or it if clearly denotes what goods or services are provided in such a way that the customer does not have exercise powers of perception or imagination.⁸

However, a scrutiny of the file wrapper record of the subject mark shows that the term "Zoledronic Acid" including the drug dosage provision of "4 mg/5ml concentrate for I.V. infusion bisphosphonate" was disclaimed⁹ by the Respondent-Applicant. Thus, the controversy is bolted to the determination of whether the word mark "Zobone" is registrable. It appears that the word mark "Zobone" is not identical or confusingly similar to the generic name Zoledronic Acid or Zoledronic. The subject marks' similarity consists of the first two letters of the marks. The minuscule likeness cannot be said to confuse, deceive the consuming public, or recall the brand name by reason of the presence of another. Finally, there is no showing that "Zobone" is the customary or usual designation of the product, nor that which serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production or other characteristics thereof.

⁵ p. 7, Verified Opposition.

⁶ Exhibit "A" of Opposer.

⁷ Exhibit "B" of Opposer.

⁸ Des Produits Nestle, S.A. vs. Court of Appeals (356 SCRA 207, 222-223), 2001.

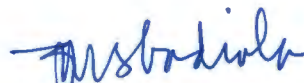
⁹ Sec. 126. Disclaimers. - The Office may allow or require the applicant an unregistrable component of an otherwise registrable mark but such disclaimer shall not prejudice or affect the applicant's or owner's rights then existing or thereafter arising in the disclaimed matter, nor such disclaimer prejudice or affect the applicant's or owner's rights on another application of later date if the disclaimed matter became distinctive of the applicant's or owner's goods, business of services.

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 or 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.¹⁰

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2015-007168 is hereby **DISMISSED**. Let the file wrapper of subject trademark application be returned, together with a copy of the Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 08 FEB 2017



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

¹⁰ Pribhdas J. Mirpuri vs. Court of Appeals (G.R. No. 114508, 19 November 1999).