

THERAPHARMA, INC.,
Opposer,

-versus-

SYNERGY ASIA PTE LTD.,
Respondent- Applicant.

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IPC No. 14-2011-00138
Opposition to:
Appln. Serial No. 4-2010-012527
Date Filed: 19 NOVEMBER 2010
TM: ATORVASYN

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 106 dated April 10, 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, April 17, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

<p>THERAPHARMA, INC., Opposer,</p> <p>-versus-</p> <p>SYNERGY ASIA PTE LTD., Respondent-Applicant.</p> <p>x-----x</p>	<p>} IPC NO. 14-2011-00138</p> <p>} Opposition to:</p> <p>}</p> <p>} Appln. Ser. No. 4-2010-012527</p> <p>} Date Filed: 19 November 2010</p> <p>} Trademark: "ATORVASYN"</p> <p>}</p> <p>}</p> <p>} Decision No. 2017- 106</p>
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DECISION

THERAPHARMA, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-012527. The application, filed by SYNERGY ASIA PTE LTD. (Respondent-Applicant)², covers the mark "ATORVASYN", for use on "pharmaceuticals: antihyperlipidaemic agents" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The registration of the mark 'ATORVASYN' 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:

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

(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 characteristic of the goods or services xxx"

"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 'ATORVASYN' owned by Respondent-Applicant so resembles the generic name 'ATORVASTATIN', a pharmaceutical drug used for lowering blood cholesterol, Respondent-Applicant's

¹ A corporation duly organized and existing under the laws of the Philippines with address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City

² A foreign corporation with address at 10 Anson Road, #21-02 International Plaza, Singapore 069113

³ 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.

application for registration of the mark 'ATORVASYN' should be denied.

According to the Opposer:

"9. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. Opposer is the registered owner of the trademark 'AVAMAX'. The generic name or the active ingredient of the pharmaceutical product 'AVAMAX' owned by Opposer is 'ATORVASTATIN'.

"10. The trademark application for 'AVAMAX' was filed with the IPO on 4 March 2009 by Opposer and was approved for registration on 6 February 2010 to be valid for a for a period of ten (10) years or until 6 February 2020. Thus, the registration of the trademark 'AVAMAX' subsists and remains valid to date.

"11. The trademark 'AVAMAX' has been used in commerce in the Philippines. A sample of product label bearing the trademark 'AVAMAX' and the generic name 'ATORVASTATIN' actually used in commerce is hereto attached.

"12. 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 'AVAMAX' as one the leading brands in the Philippines in the category of 'C10A – Cholest and Trigly Regulator' in terms of market share and sales performance.

"13. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, Opposer registered the product with the Bureau of Food and Drugs Administration ('BFAD').

"14. By virtue of the foregoing, it is submitted that Opposer will be damaged by the unfair use of the mark 'ATORVASYN' by Respondent – Applicant as this is closely and confusingly similar to the generic name 'ATORVASTATIN', which gives the Respondent-Applicant as undue advantage due to the affinity of the mark 'ATORVASYN' to the generic name 'ATORVASTATIN'. xxx

"15. As enunciated earlier, the registration of Respondent-Applicant's mark 'ATORVASYN' will be contrary to Section 123.1 (h) and (j) of the IP Code. The mark 'ATORVASYN' owned by Respondent-Applicant so resembles the generic name 'ATORVASTATIN', incapable of being appropriated.xxx

"17.. Further, the generic name 'ATORVASTATIN' is listed in the World Health Organization (WHO) Chronicle (Vol. 36, No. 6, December 1982, p.5) List 22 as one of the International Nonproprietary Names for Pharmaceutical Substances (INN).

"17. The INN' x x x is the official non-proprietary or generic name given to a pharmaceutical substance, as designated by the World Health Organization (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.

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

'Guidance

International Nonproprietary Names (INN) facilitate the identification of pharmaceutical substances or active pharmaceutical ingredients. Each INN is a unique name that is globally recognized and is public property. A nonproprietary name is also a generic name.

Mandate

WHO has a constitutional mandate to 'develop, establish and promote international standards with respect to biological, pharmaceutical and similar products.'

The World Health Organization collaborates closely with INN experts and national nomenclature committees to select a single name of worldwide acceptability for each active substance that is to be marketed as a pharmaceutical. To avoid confusion, which could jeopardize the safety of patients, trade-marks should neither be derived from INNs nor contain common stems used in INNs. The selection and publication of INNs falls under the responsibility of the HSS/EMP/QSM team of the INN Programme.

"19. Clearly, to allow the registration of Respondent-Applicant's mark 'ATORVAsYN' 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) 'ATORVAsTATIN', which is 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.xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application;
2. Copy of Certificate of Registration 4-2009-002292 dated 6 February 2010 for the mark "AVAMAX";
3. Sample product label of "AVAMAX";
4. Certification issued by IMS Health Philippines, Inc. dated 6 October 2010;
5. Certificate of Product Registration of the brand name "AVAMAX" issued by the Bureau of Food and Drugs dated 25 June 2009; and
6. Selected pages of WHO Drug Information, Vol. 9, No. 3, 1995⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 8 June 2011. The Respondent-Applicant, however, did not file an answer.

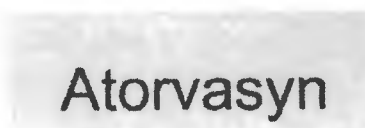
Should the Respondent-Applicant be allowed to register the trademark ATORVASYN?

Records show that at the time Respondent-Applicant applied for registration of the mark "ATORVASYN" the Opposer already registered the mark "AVAMAX" under Certificate of Registration No. -2009-002292 dated 6 February 2010. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?



Opposer's mark



Respondent-Applicant's mark

The marks are similar with respect to the letter "A" as the first letter and one in its suffix. Such similarities however, are not sufficient to conclude that confusion among the consumers is likely to occur. However, it is noted that ATORVASTATIN is a generic name and is listed in the WHO Chronicle as International Nonproprietary Names (INN) for Pharmaceutical Products⁵. The Respondent-Applicant's mark is a substantially identical to the generic term of the product its mark seeks to identify.

Sec. 123.1 of the 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;

⁴ Exhibits "A" to "F"

⁵ Exhibit "F"

(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 bona fide 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.

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 characteristics*", or "*refer to the basic nature of the wares or the 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 clearly denotes what goods or services are provided in such a way that the customer does not have to exercise powers of perception or imagination.⁶

In this regard, this is not the first time that this Bureau and the Intellectual Property Office of the Philippines has passed upon the same issue of whether a mark that is obviously a replication of the generic name of the goods on which the mark is used or attached should be allowed to be registered or not. This Bureau takes judicial notice of Inter Partes Case No. 14-2009-000249 entitled *Sanofi-Aventis v. Ranbaxy Laboratories Limited*. This Bureau decided the cited case by sustaining the opposition to the application for the registration of the mark "IRBESAR" on the ground that it is confusingly similar to and is a virtual replication of "IRBESARTAN", which is the generic term for a drug mainly used for treating hypertension. The decision of the Bureau was upheld by the Office of the Director General in Appeal No. 14-2010-0042⁷, where it held, that:

"Accordingly, the similarities in IRBESAR and IRBESARTAN are very obvious that to allow the registration of IRBESAR is like allowing the registration of a generic term like IRBESARTAN. The similarities easily catches one's attention that the purchasing public may be misled to believe that IRBESAR and IRBESARTAN are the same and one product.

"A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto as specified in the certificate.⁸ Significantly, the registration of IRBESAR would give the Respondent-Applicant the exclusive right to use this mark and prevent others from using similar marks including the generic name and

⁶ *Des Produits Nestle, S.A. v. Court of Appeals* (356 SCRA 207, 222-223) 2001.

⁷ 17 December 2012

⁸ Sec. 138, IP Code

INN IRBESARTAN. This cannot be countenanced for it is to the interest of the public that a registered mark should clearly distinguish the goods of an enterprise and that generic names and those confusingly similar to them to be taken outside the realm of registered trademarks.

“The main characteristics of a registrable trademark is its distinctiveness. A trademark must be a visible sign capable of distinguishing the goods and services of an enterprise.⁹ From the foregoing, IRBESAR cannot be considered a distinctive mark that would merit trademark registration. IRBESAR is substantially similar to the generic name IRBESARTAN that the use of the former can only be construed as an abbreviation of the latter. In one case, the Supreme Court held that:


...known words and phrases indicative of quality are the common property of all mankind and they are not appropriated by one to a mark as 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 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.”¹⁰

In the instant case, ATORVASYN is substantially similar to the generic name ATORVASTATIN. Thus, this Bureau finds no cogent reason to rule otherwise in the instant case.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-012527 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 APR 2017


ATTY. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁹ Sec. 121.1, IP Code

¹⁰ *East Pacific Merchandising Corp. v. Director of Patents*, G.R. No. L- 14377, 29 December 1960.