

RITEMED PHILIPPINES, INC.,
Opposer,

-versus-

AMDIPHARM MERCURY INTERNATIONAL LIMITED,
Respondent-Applicant.

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IPC No. 14-2014-00299

Opposition to:

Appln. Serial No. 4-2014-000510

Date Filed: 13 January 2014

TM: ERYTHROCIN

NOTICE OF DECISION

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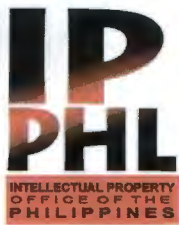
GREETINGS:

Please be informed that Decision No. 2017 - 143 dated 25 April 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, 25 April 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



RITEMED PHILIPPINES, INC.,

Opposer,

-versus-

AMDIPHARM MERCURY INTERNATIONAL

LIMITED,

Respondent-Applicant.

} **IPC NO. 14-2014-00299**

} Opposition to:

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} Appln. Ser. No. 4-2014-000510

} Date Filed: 13 January 2014

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} Trademark: "ERYTHROCIN"

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x-----x } Decision No. 2017- 143

DECISION

RITEMED PHILIPPINES, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-000510. The application, filed by AMDIPHARM MERCURY INTERNATIONAL LIMITED (Respondent-Applicant)², covers the mark "CALCITECT", for use on "anti-thrombotic agent (tablets)" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The registration of the mark 'ERYTHROCIN' 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 signs that are generic for the goods or services that they seek to identify;

(j) consists exclusively of sign 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 the rendering of the services, or other characteristics of the goods or services.

¹ A domestic corporation organized and existing under the laws of the Philippines with address at 56 Dolmar Bldg., Edsa, Mandaluyong, Metro Manila

² A foreign corporation with address at Aztec Group Houswe, 11-15 Seaton Place, St. Helier, New Jersey, JE4 0QH, United States of America

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.

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“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 applied for by Respondent-Applicant ‘ERYTHROCIN’ so resembles the generic name ‘ERYTHROMYCIN’, an antibiotic used to treat infections caused by bacteria, Respondent-Applicant’s application for the mark ‘ERYTHROCIN’ should be denied.

Opposer alleges, among others, that:

“9. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products, one of which is ‘ERYTHROMICIN’. xxx

“9.2. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, product has been registered with the Food and Drug Administration. xxx

“9.3. 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 ‘ERYTHROMICIN’ product of the Opposer as one of the leading brands in the Philippines in the category of ‘j01F Macrolides and Similar Type’ in terms of market share and performance. xxx

“10. By virtue of the foregoing, it is submitted that not only Opposer, but all users of the generic component ‘ERYTHROMYCIN’ in their products, as well, will be damaged by the appropriation and registration of the mark ‘ERYTHROCIN’ by Respondent-Applicant as this closely and confusingly similar to the generic name ‘ERYTHROMYCIN’ gives Respondent-Applicant undue advantage due to the affinity of its mark ‘ERYTHROCIN’ to the generic name ‘ERYTHROMYCIN’. xxx”

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

1. Print-out of relevant page of Intellectual Property Office (“IPO”) E-Gazette showing published marks;
2. Sample packaging of pharmaceutical product “ERYTHROMYCIN”;
3. Copy of Certificate of Product Registration of “ERYTHROMYCIN” from the Food and Drugs Administration (FDA) dated 27 April 2018;
4. Certification from Intercontinental Marketing Services dated 2 July 2014; and
5. Print-out of WHO Chronicle (Vol 13, No. 12, December 1959)⁴

The Respondent-Applicant, in its Answer dated 6 November 2014, alleged among other things, the following:

⁴ Exhibits “A” to “E”

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“7. The Fifth Report of the WHO Expert Committee on the Use of Essential Drugs is categorical:

The procedure for selecting INNs allows manufacturers to contest names that are either identical or similar to their licensed trademarks. In contrast, trade-mark applications are disallowed, in accordance with the present procedure, only when they are identical to an INN. A case for increased protection of INNs is now apparent as a result of competitive promotion of products no longer protected by patents. Rather than marketing these products under generic name companies apply for a trademark derived from an INN and in particular, including the INN common stem.xxx

“8. From the above, it is abundantly clear that while identical or similar licensed trademarks may preclude the selection of INNs, only trademark applications identical to INNs may not be registered.

“9. A side by side comparison of the marks shows that Respondent’s ERYTHROCIN is not identical to and is clearly distinct from ERYTHROMYCIN. Hence, the registration of the ERYTHROCIN mark should be allowed.xxx”

To support its defense, the Respondent-Applicant submitted as evidence the following:

1. Original notarized and legalized Verified Answer;
2. Notarized and legalized Affidavit of Michael Cullen dated 20 October 2014;
3. Table of trademark registrations of “ERYTHROCIN”;
4. Assignment of Trademarks dated 31 August 2007;
5. Director’s Certificate dated 20 October 2014;
6. Special Power of Attorney dated 20 October 2014⁵

The Preliminary Conference was terminated on 12 November 2015. Order No. 2015-1704 directed the parties to file their position papers. The Opposer and the Respondent-Applicant filed their position papers on 18 December 2015 and 17 December 2015, respectively.

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

Records show that Respondent-Applicant applied for registration of the mark “ERYTHROCIN” on 13 January 2014. The Opposer’s product, is branded as “ERYTHROMICIN” and acknowledged as a leading brand by IMS.

⁵ Annex “A” to “B”; Exhibits “1” to “2”

The Respondent-Applicant's mark is reproduced below:

ERYTHROCIN

The Opposer alleged that Respondent-Applicant's mark ERYTHROCIN so resembles its generic name ERYTHROMYCIN. It quotes WHO Guidelines and Mission, to wit:

"The World Health Organization collaborates 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. Xxx"

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 registration 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. 14-2010-0042⁶, 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.⁷ 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 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.

⁶ 17 December 2012

⁷ Sec. 138, IP Code

"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.⁸ 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."⁹

The Bureau finds no cogent reason to rule otherwise in the instant case. ERYTHROCIN is substantially similar to the generic name ERYTHROMYCIN, thus the Respondent-Applicant's application should not be allowed. Also, the Bureau notes that Opposer's brand name ERYTHROMICIN¹⁰, which based on the evidence on record, is not a registered mark, is phonetically the same or *idem sonans* to the generic name ERYTHROMYCIN.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-000510 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, 25 APR 2017


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

⁸ Sec. 121.1, IP Code

⁹ *East Pacific Merchandising Corp. v. Director of Patents*, G.R. No. L- 14377, 29 December 1960.

¹⁰ Exhibit "D"