

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

SYDENHAM LABORATORIES, INC.,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2015-00601
} Opposition to:
} Appln. No. 4-2015-006973
} Date Filed: 24 June 2015
} TM: "SYTIRIZINE"
}
}
}

NOTICE OF DECISION

OCHAVE AND ESCALONA
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No. 66 United Street
Mandaluyong

SYDENHAM LABORATORIES, INC.
Respondent-Applicant
Km. 34 E. Aguinaldo Hi-Way near cor. Governors Drive
Dasmariñas 4114, Cavite

GREETINGS:

Please be informed that Decision No. 2017 - 81 dated March 17, 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, March 17, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

WESTMONT PHARMACEUTICALS, INC.,

Opposer,

-versus-

SYDENHAM LABORATORIES, INC.,

Respondent-Applicant.

IPC No. 14-2015-00601

Opposition to Trademark

Application No. 4-2015-006973

Date Filed: 24 June 2015

Trademark: "**SYTIRIZINE**"

X ----- X Decision No. 2017- 81

DECISION

Westmont Pharmaceuticals, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-006973. The contested application, filed by Sydenham Laboratories, Inc.² ("Respondent-Applicant"), covers the mark "SYTIRIZINE" for use on "*pharmaceutical preparations used for the symptomatic relief of allergic conditions namely: rhinitis and chronic urticarial*" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on the provision of Section 123.1 subparagraphs (h) and (j) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges, among others, that "SYTIRIZINE" is closely and confusingly similar to the generic name *cetirizine*. In support of its Opposition, the Opposer submitted the following as evidence:⁴

1. copy of the pertinent page of the IPO E-Gazette publishing the mark "SYTIRIZINE";
2. certified true copy of Certificate of Registration No. 4-2004-011660;
3. certified true copies of the Declaration of Actual Use and Affidavit of Use for its registered mark "ALNIX";
4. sample product label bearing the mark "ALNIX"; and,
5. certification from the International Marketing Association.


This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 20 January 2016. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Adjudication Officer issued on 17 August 2016

¹ A corporation duly organized and existing under and by virtue of the laws of the Philippines with business address at 4F Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

² A corporation organized and existing under and by virtue of the laws of the Philippines with known address at Km. 34 E. Aguinaldo Hi-way near cor. Governors Drive, Dasmariñas 4114, Cavite, Philippines.

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

⁴ Marked as Exhibits "A" to "F".


Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Order No. 2016-1328 declaring the Respondent-Applicant in default and the case submitted for decision.

The primordial issue in this case is whether the trademark "SYTIRIZINE" should be allowed.

The applied mark and the generic name *cetirizine*, although different in spelling, are similar, if not identical, in pronunciation. To allow Respondent-Applicant to register "SYTIRIZINE" is thus tantamount to giving the said company an undue advantage over its competitors and cause confusion among the consumers who would be easily deceived that what they are buying is a generic drug.

Succinctly, Section 123.1 (h) and (j) of the IP Code provides that 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 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; x x x"

Generic names 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 a reference to "*every member of a 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 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 exercise of powers of perception or imagination.⁵

Significantly, this Bureau takes judicial notice of Inter Partes Case No. 14-2009-000249 entitled "Sanofi-Aventis vs. Ranbaxy Laboratories Limited". This Bureau decided the cited case by sustaining the opposition to the application for the

⁵ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

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 name for a drug mainly used for treating hypertension. The Director General sustained this Bureau's ruling in his decision dated 17 December 2012, to wit:

"As correctly pointed out by the Appellee (Sanofi-Aventis):

3.1. All the letters in Respondent-Applicant's mark IRBESAR form part of the INN 'IRBESARTAN'. In fact, all the seven (7) letters in the Respondent-Applicant's IRBESAR mark constitute the first seven (7) letters of the INN o generic name 'IRBESARTAN'.

3.2. The last three letters of the Respondent-Applicant's IRBESAR mark, namely, the letters S, A and R, consist of a substantial part of the common stem- SARTAN of the INN system.

3.3. It bears stressing that the INN 'IRBESARTAN' and the Respondent-Applicant's mark IRBESAR are both used for pharmaceutical products, the former being the generic name of the latter.

"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. Their 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 specified in the certificate. 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 be taken outside the realm of registered marks. x x x"


It is emphasized that 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.⁶ The Respondent-Applicant's trademark fell short in meeting this function.

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2015-006973 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **17 MAR 2017**


ATTY. ZISA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs