



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES

BIOMEDIS INC.,
Opposer,

-versus-

AMBICA INTERNATIONAL CORPORATION,
Respondent-Applicant.

X-----X

}	IPC No. 14-2016-00041
}	Opposition to:
}	Appln. Serial No. 4-2015-010203
}	Date Filed: 04 September 2015
}	
}	
}	TM: TAMOXEN

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
No. 66 United Street,
Mandaluyong City


AMBICA INTERNATIONAL CORPORATION
Respondent- Applicant
#9 Amsterdam Extension
Merville Park Subdivision
Parañaque City

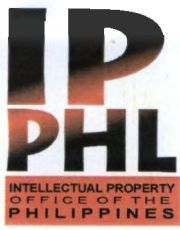
GREETINGS:

Please be informed that Decision No. 2017 - 188 dated 02 June 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, 02 June 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



BIOMEDIS INC., }
Opposer, }
 -versus- }
 AMBICA INTERNATIONAL CORPORATION, }
Respondent-Applicant. }
 x-----x

IPC No. 14-2016-00041
 Opposition to:
 Application No. 4-2015-010203
 Date Filed: 04 September 2015
 Trademark: "TAMOXEN"
 Decision No. 2017- 188

DECISION

BIOMEDIS, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-010203. The application, filed by Ambica International Corporation² ("Respondent-Applicant"), covers the mark "TAMOXEN" for use on "pharmaceutical preparations namely oncology" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"GROUNDS FOR OPPOSITION"

"7. The registration of the mark 'TAMOXEN' in the name of 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 applied for by Respondent-Applicant 'TAMOXEN' so resembles the generic name 'TAMOXIFEN', medicine used for the treatment of invasive breast cancer in men and women, Respondent-Applicant's application for the registration of the mark 'TAMOXEN' should be denied.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION"

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

¹With address at 66 United Street, Mandaluyong City, Metro Manila, Philippines.
²With address at #9 Amsterdan Extension, Merville Park Subdivision, Parañaque 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.

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

"9.1. The trademark application for the trademark 'FENELSA' was filed with the IPO on 26 August 2015 by Opposer. A certified true copy of the Acknowledgment issued by the IPO acknowledging the receipt of the Trademark Application for the trademark 'FENELSA' on 26 August 2015 is attached hereto
x x x

"10. By virtue of the foregoing, it is submitted that not only Opposer, but all users of the generic component 'TAMOXIFEN' in their products, as well, will be damaged by the appropriation and registration of the mark 'TAMOXEN' by Respondent-Applicant as this is closely and confusingly similar to the generic name 'TAMOXIFEN', which gives Respondent-Applicant undue advantage to the affinity of its mark 'TAMOXEN' to the generic name 'TAMOXIFEN'.

"11. Moreover, the registration of the mark 'TAMOXEN' clearly violates the IP Code's prohibition on the registration of a generic and/or descriptive term in such that all users, including Opposer, of the generic component 'TAMOXIFEN' in their products have a right to oppose Respondent-Applicant's application for registration of the mark 'TAMOXEN', otherwise, such prohibition may be rendered nugatory.

"12. As discussed earlier, the registration of the Respondent-Applicant's mark 'TAMOXEN' will be contrary to Section 123.1 (h) and (j) of the IP Code. The mark 'TAMOXEN' applied for registration with the IPO by Respondent-Applicant so resembles the generic name 'TAMOXIFEN', medicine used for the treatment of invasive breast cancer in men and women, which is incapable of being appropriated.

"13. 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

"14. Further, the generic name 'TAMOXIFEN' is listed in the World Health Organization (WHO) Chronicle (Vol. 27, No. 10, 1973, p. 7) List 13 as one of the International Non-proprietary Names for Pharmaceutical Substances ('INN'). An electric print out of the WHO Chronicle (Vol. 27, No. 10, 1973, p. 7) List 13 is attached hereto x x x

"15. 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'.

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

"17. Clearly, to allow the registration of Respondent-Applicant's mark 'TAMOXEN' 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) 'TAMOXIFEN', which is the generic and/or descriptive term of the active ingredient of the kind, quality and intended for purpose of goods covered by Respondent-Applicant's mark; hence, cannot be exclusively appropriated and registered as a trademark.

"18. Respondent-Applicant's mark 'TAMOXEN' is confusingly similar to the generic name and/or descriptive term 'TAMOXIFEN'.

"18.1. Respondent-Applicant's mark 'TAMOXEN' appears and sounds almost the same as the generic name and/or descriptive term 'TAMOXIFEN'.

"18.2. Respondent-Applicant's mark 'T-A-M-O-X-E-N' is the first five (5) and last two (2) letters of the generic name (INN) 'T-A-M-O-X-I-F-E-N'.

"19. Clearly, Respondent-Applicant's mark 'TAMOXEN' is confusingly similar to the generic name and/or descriptive term 'TAMOXIFEN'.

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

"21. Yet, Respondent-Applicant still filed a trademark application for 'TAMOXEN' despite its knowledge of the generic name 'TAMOXIFEN', which is confusingly similar thereto in both its sound and appearance. To allow the registration of Respondent-Applicant's mark 'TAMOXEN' will have the unintended effect of Respondent-Applicant having appropriated the generic name 'TAMOXIFEN' for itself, which is clearly prohibited under the WHO Guidelines and Mission of the INN.

"22. Significantly, this is not the first time that this Honorable Bureau and the IPO have 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.

"23. Relevantly, 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 'ATORVASTATIN'.

"24. It is clear, therefore, that the denial of the application for registration of the Respondent-Applicant's mark 'TAMOXEN' 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 'TAMOXIFEN'.

"25. In support of the foregoing, the instant Notice of Opposition is herein verified by Mr. Hector R. Pagalilauan, which will likewise serve as his affidavit (Nasser vs. Court of Appeals, 191 SCRA 783, 792-793 [1990])

The Opposer's evidence consists of copies of pertinent page of the IPO E-Gazette released on 21 December 2015; a copy of the Acknowledgement issued by the IPO acknowledging the receipt of the Trademark Application for the trademark 'FENELSA'

on 26 August 2015; and print out of the WHO Chronicle (Vol. 27, No. 10, 1973, p. 7) List 13.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 22 February 2016. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on Section 123.1 paragraphs (h) and (j) of Republic Act No. 8293, also 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:

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.

Records show that at the time the Respondent-Applicant filed its trademark application on 04 September 2015, the Opposer has an existing trademark application for the mark "FENELSA" under Application Serial No. 4-2015-009725 filed on 26 August 2015. The application covers "pharmaceutical preparations" under Class 05. The generic name and/or active ingredient of the pharmaceutical product "FENELSA" is "TAMOXIFEN". On the other hand, the trademark application of Respondent-Applicant covers the mark "TAMOXEN" for use on "pharmaceutical preparations namely oncology" under Class 05.

The TAMOXEN mark, subject of this opposition is reproduced below:

TAMOXEN

Respondent-Applicant's mark

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

Respondent-Applicant adopted the name of TAMOXIFEN (TMX) or the term used to refer to a medication that is used to prevent breast cancer in women and treat breast cancer in women and men⁵, except that it deleted the sixth letter "I" and seventh letter "F" in the generic name TAMOXIFEN to come up with the mark TAMOXEN. Here the word "TAMOXIFEN" is generic as it is used to treat and prevent some types of breast cancer and therefore cannot be appropriated by Respondent-Applicant for its exclusive use.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

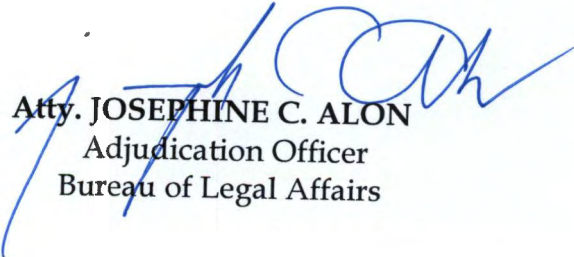
It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public 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 This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1 paragraphs (h) and (j) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2015-010203 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 JUN 2017.


Atty. JOSEPHINE C. ALON
Adjudication Officer
Bureau of Legal Affairs

⁵ en.wikipedia.org/wiki/Tamoxifen.

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepa v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).