

THERAPHARMA INC.,
Opposer,

-versus-

EUROASIA PHARMACEUTICALS, INC.,
Respondent-Applicant.

}
}
}
}
}
}
}

IPC No. 14-2016-00412
Opposition to:
Appln. No. 4-2016-001533
Date Filed: 12 February 2016

TM: VALSAR PLUS

X-----X

NOTICE OF DECISION

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


EUROASIA PHARMACEUTICALS, INC.
Respondent- Applicant
Unit 1201 12th Floor, AIC Burgundy Empire Tower
ADB Avenue, Ortigas Business Center
Pasig City

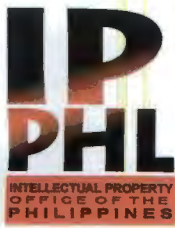
GREETINGS:

Please be informed that Decision No. 2017 - 208 dated 09 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, 09 June 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



THERAPHARMA, INC.,
Opposer,
 -versus-
 EUROASIA PHARMACEUTICALS, INC.,
Respondent-Applicant.
 -----x

IPC No. 14-2016-00412
 Opposition to:
 Application No. 4-2016-001533
 Date Filed: 12 February 2016
 Trademark: "VALSAR PLUS"

Decision No. 2017- 208

DECISION

THERAPHARMA, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2016-001533. The application, filed by Euroasia Pharmaceuticals, Inc.² ("Respondent-Applicant"), covers the mark "VALSAR PLUS" for use on "*pharmaceutical preparations*" 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 'VALSAR PLUS' 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 'VALSAR PLUS' so resembles the generic name 'VALSARTAN', an angiotensin II receptor blocker which is mainly used for treatment of high blood pressure, congestive heart failure, and to increase the chances of living longer after a heart attack, Respondent-Applicant's application for the registration of the mark 'VALSAR PLUS' 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 3RD Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

²With address at Unit 1201, 12TH Floor AIC Burgundy Empire Tower ADB Ave., Ortigas Business Center, Pasig 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, namely, metabolic and cardiovascular solutions, under which the pharmaceutical preparation 'VALSARTAN' belongs.

"10. By virtue of the foregoing, it is submitted that not only Opposer, but all users and potential users of the generic component 'VALSARTAN' will be damaged by the appropriation and registration of the mark 'VALSAR PLUS' by Respondent-Applicant as this is closely and confusingly similar to the generic and descriptive term 'VALSARTAN', which gives Respondent-Applicant undue advantage to the affinity of its mark 'VALSAR PLUS' to the generic name 'VALSARTAN'.

"11. Moreover, the registration of the mark 'VALSAR PLUS' clearly violates the IP Code's prohibition on the registration of a generic and/or descriptive term in such that all users of the generic component 'VALSARTAN' in their products as well as those who may venture in the distribution of a product with the generic component 'VALSARTAN' as a component shall have the right to oppose Respondent-Applicant's application for registration of the mark 'VALSAR PLUS', otherwise, such prohibition may be rendered nugatory.

"12. As discussed earlier, the registration of the Respondent-Applicant's mark 'VALSAR PLUS' will be contrary to Section 123.1 (h) and (j) of the IP Code. The mark 'VALSAR PLUS' applied for registration with the IPO by Respondent-Applicant so resembles the generic and/or descriptive term 'VALSARTAN', 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 'VALSARTAN' is listed in the World Health Organization (WHO) Drug Information (Vol. 7, No. 3, 1993, p. 143) List 33 as one of the International Non-proprietary Names for Pharmaceutical Preparations ('INN'). An electric print out of the WHO Drug Information (Vol. 7, No. 3, 1993) List 33 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 'VALSARTAN', 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 'VALSAR PLUS' 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) 'VALSARTAN', 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 as well as the WHO Guidelines and Mission of the INN; hence, cannot be exclusively appropriated and registered as a trademark.

"18. The generic and/or descriptive term 'VALSARTAN' and Respondent-Applicant's mark 'VALSAR PLUS' are practically identical marks in sound and appearance that they leave the same impression upon the public

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

"20. 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.

"21. 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 'VALSAR PLUS' 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 'VALSARTAN'.

"25. In support of the foregoing, the instant Notice of Opposition is herein verified by Ms. Rowena S. Keyser, 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 4 July 2016; and a copy or an electronic print of the WHO Drug Information (Vol. 7, No. 3, 1993) List 33.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 6 September 2016. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark VALSAR PLUS?

⁴Marked as Exhibits "A" and "B", inclusive.

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.

The VALSAR PLUS mark, subject of this opposition is reproduced below:

Valsar Plus

Respondent-Applicant's mark

Respondent-Applicant adopted the name of VALSARTAN or the term used to refer to an angiotensin II receptor antagonist (commonly called an ARB, or angiotensin receptor blocker), that is selective for the type I (AT₁) angiotensin receptor⁵, except that it deleted the last three (3) letters "TAN" and included/inserted a second word "PLUS" to come up with the mark VALSAR PLUS. Here the word "VALSARTAN" is generic as it is used to treat high blood pressure, congestive heart failure, and increase the chances of living longer after a heart attack⁶ 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.

⁵en.wikipedia.org/wiki/Valsartan.

⁶*Ibid.*

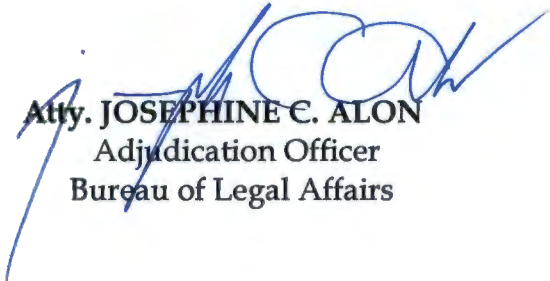
It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public 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.⁷ 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. 4-2016-001533 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, 09 JUN 2017.


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

⁷ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe 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).