

THERAPHARMA, INC.,
Opposer,

-versus-

PHIL. SHINPOONG PHARMA, INC.,
Respondent- Applicant.

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IPC No. 14-2016-00210
Opposition to:
Appln. Serial No. 4-2015-003308
Date Filed: 23 March 2015
TM: "LOZARSIN"

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NOTICE OF DECISION

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

PHIL. SHINPOONG PHARMA
Respondent-Applicant
Unit 2314 Medical Ortigas Building
San Miguel Avenue, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2017 - 214 dated June 09, 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, June 13, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

THERAPHARMA, INC.,	} IPC NO. 14-2016-00210
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2015-003308
	} Date Filed: 26 March 2015
	} Trademark: "LOZARSIN"
PHIL. SHINPOONG PHARMA, INC.,	}
Respondent-Applicant.	}
x-----x	} Decision No. 2017- 214

DECISION

THERAPHARMA, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2015-003308. The application, filed by PHIL. SHINPOONG PHARMA, INC. (Respondent-Applicant)², covers the mark "LOZARSIN", for use on "ANGIOTENSIN-II- RECEPTOR BLOCKERS Pharmaceutical preparations, agents for antihypertensive diseases. And pharmaceutical preparations for the treatment of high blood pressure, pharmaceutical preparation that may be used alone or with other agents to treat hypertension, medicine for human purpose. this compound belongs to the class of organic compounds known as biphenyltetrazoles and derivatives. These are organic compounds containing a biphenyl attached to a tetrazole. A carbon atom of the biphenyl moiety is bonded to a carbon or the nitrogen atom of the tetrazole moiety." under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The registration of the mark 'LOZARSIN' 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; xxx
- (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

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

² A corporation with address at Unit 2314 Medical Ortigas Building, San Miguel Avenue, Ortigas Center, Pasig City

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.

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 applied for by Respondent-Applicant ‘LOZARSIN’ so resembles the generic name ‘LOSARTAN’, an angiotensin II receptor antagonist drug used mainly to treat high blood pressure, Respondent-Applicant's application for the registration of the mark ‘LOZARSIN’ should be denied. ”

The Opposer alleges, among other things, that:

“9. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of the trademark “LIFEZAR”. The generic name and/or active ingredient of the pharmaceutical product is “LIFEZAR” owned by Opposer is “LOSARTAN POTASSIUM”.

“9.1. The trademark application for the trademark ‘LIFEZAR’ was filed with the IPO on 14 May 2004 by Opposer and was approved for registration on 31 October 2015 to be valid for a period of ten (10) years, or until 31 October 2015. xxx

“9.3. Thus, the registration of the trademark ‘LIFEZAR’ subsists and remains valid to date.

“10. The trademark ‘LIFEZAR’ owned by Opposer has been extensively used in commerce in the Philippines. xxx

“10.2. In order to legally market, distribute and sell this medicinal preparation in the Philippines, the product has been registered with the Bureau of Food and Drugs (now Food and Drug Administration). xxx

“10.3. A sample product label bearing the trademark ‘LIFEZAR’ actually used in commerce is hereto attached hereof as Exhibit ‘H’ and made an integral part hereof.xxx”

“10.4. 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 ‘LIFEZAR’ as one of the leading brands in the Philippines in the category of ‘C096- Angiotens-II Antag, Plain’ in terms of market share and performance.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 published for opposition;
2. Copy of Certificate of Registration No. 4-2004-004304 for the trademark "LIFEZAR" issued on 31 October 2005;
3. Copy of Declaration of Actual Use and Affidavit of Use;
4. Sample product label of "LIFEZAR";
5. Certificate of Listing of Identical Drug Product Nos. DRP-2675-01 and DRP-2676-01;
6. Copy of the certification and sales performance issued by International Marketing Services (IMS); and
7. Electronic print-out of WHO Drug Information (Vol. 6, No. 3, 1992, p.6) List 32⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 25 August 2015. The Respondent-Applicant, however, did not file an Answer. The Adjudication Officer issued on 24 February 2017 Order No. 2017-531 declaring the Respondent-Applicant in default.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "LOZARSIN" the Opposer already registered the mark LIFEZAR under Registration No. 4-2004-004304 31 October 2005. The goods covered by the Opposer's trademark registration are "Anti-hypertensive medicinal preparation" also under Class 5, same as indicated in the Respondent-Applicant's trademark application.

The marks of the contending parties are depicted below:

Opposer's mark

Respondent-Applicant's mark

Lifezar

LOZARSIN

The Opposer asserts that Respondent-Applicant's mark is confusingly similar to its generic name LOSARTAN. It is noted that LOSARTAN is a generic name and is listed in the WHO Drug Information Vol. 6, No. 3, 1992 on page 6⁵.

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*

⁴ Exhibits "A" to "J"

⁵ Exhibit "J"

Ad

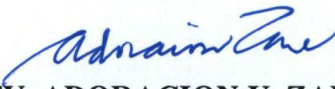
than to the more idiosyncratic characteristics of a particular product”, and are not legally protectable.⁶

In the instant case, the Respondent-Applicant appropriates five of the eight letters of the generic name LOSARTAN, substituting the letter “Z” for the letter “S”, and “SI” for the letters “TA” in the suffix, hence, LOZARSIN. By merely substituting the letter Z for S, the first two syllables still sound alike. LOSAR and LOZAR are *idem sonans*. Combined with the last syllable, SIN, the mark LOZARSIN is visually and aurally similar to its generic name LOSARTAN. The mark LOZARSIN being confusingly similar to the generic name of the product it seeks to identify, the same cannot be registered.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2015-003308 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, 09 JUN 2017


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

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