



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES

UNITED LABORATORIES, INC.,
Opposer,

-versus-

CJ HEALTHCARE CORPORATION,
Respondent-Applicant.

X-----X

} **IPC No. 14-2016-00407**
}
} Opposition to:
} Appln. No. 4-2016-501888
} Date Filed: 06 April 2016

} **TM: CINEZOLID**

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for Opposer
No. 66 United Street,
Mandaluyong City

HECHANOVA and CO. INC.

Respondent-Applicant's Representative
GF Salustiana D. Ty Tower,
104 Paseo de Roxas Ave., Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 209 dated 09 June 2017 (copy enclosed) was promulgated in the above entitled case.

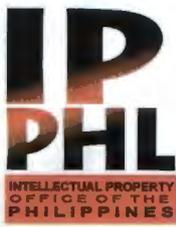
Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 09 June 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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UNITED LABORATORIES, INC.,
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CJ HEALTHCARE CORPORATION,
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}IPC NO. 14-2016-00407

}Opposition to:

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}Appln. Ser. No. 4-2016-501888

}Date Filed: 6 April 2016

} Trademark: "CINEZOLID"

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x-----x}Decision No. 2017- 209

DECISION

UNITED LABORATORIES, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2016-501888. The application, filed by CJ HEALTHCARE CORPORATION (Respondent-Applicant)², covers the mark "CINEZOLID", for use on "antibiotics, anti-inflammatory preparations, milk sugar for pharmaceutical purposes, microorganisms for medical purposes" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The registration of the mark 'CINEZOLID' 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 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 'CINEZOLID' so resembles the generic name 'LINEZOLID', an antibiotic used for the treatment of serious infections

¹ A corporation duly organized and existing under the laws of the Philippines with address at 66 United Street, Mandaluyong City.

² A foreign corporation with address at CJ Cheiljedang Center, 330 Dongho-ro, Jung-gu, Seoul, Korea

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.

caused by Gram-positive bacteria that are resistant to other antibiotics, Respondent-Applicant's application for the registration of the mark 'CINEZOLID' should be denied.

The Opposer alleges, among other things, that:

"9. Opposer is a company which develops, manufactures, markets and sells a wide range of prescription and consumer health products covering all major therapeutic categories, including but not limited to the therapeutic category where 'LINEZOLID' belongs.

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

"11. Moreover, the registration of the mark 'CINEZOLID' 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 'LINEZOLID' in their products as well as those who may venture into the distribution of a product with the generic component 'LINEZOLID' as a component shall have the right to oppose Respondent-Applicant's application for registration of the mark 'CINEZOLID', otherwise the prohibition may be rendered nugatory. xxx

"14. Further, the generic name 'LINEZOLID' is listed in the World Health Organization (WHO) Drug Information Non-proprietary Names for Pharmaceutical Preparations (INN). xxx

"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 Guidance and Mission of the INN, INN drugs such as 'LINEZOLID', is referred to as generic and thus, cannot be appropriated as trademark for any pharmaceutical product, to wit:

'Guidance

International Nonproprietary Names (INN) facilitate the identification of pharmaceutical substances or active pharmaceutical ingredients. Each

INN is a unique name that is globally recognized and is public property. A nonproprietary name is also known as a generic name.

Mandate

WHO has a constitutional mandate to 'develop, establish and promote international standards with respect to biological, pharmaceutical and similar products.'

The World Health Organization collaborates closely 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. The selection and publication of INNs falls under the responsibility of the HSS/EMP/QSM team of the INN Programme. xxx

"18. Clearly, to allow the registration of Respondent-Applicant's mark 'CINEZOLID' 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) 'LINEZOLID', which is generic and/or descriptive term of the active ingredient of the kind, quality and intended purpose of goods covered by Respondent-Applicant's mark as well as the WHO Guidelines and Mission of the INN and BFAD Circular 21 s. 1999, hence, cannot be exclusively appropriated and registered as a trademark. xxx"

To support its opposition, the Opposer submitted as evidence the following: Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application and Print-out of pages of WHO Drug Information Vol., No. 3, 1997.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 1 September 2016. The Respondent-Applicant, however, did not file an answer. Thus, the Adjudication Officer issued on 7 March 2017 an order declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark CINEZOLID? The Respondent-Applicant's mark is reproduced below:

CINEZOLID

⁴ Exhibits "A" and "B"

The Opposer asserts that Respondent-Applicant's mark is confusingly similar to its generic name LINEZOLID. It is noted that LINEZOLID is a generic name and is listed in the WHO Drug Information Vol., No. 3, 1997 on page 171⁵.

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

In the instant case, the Respondent-Applicant appropriates eight of the nine letters of the generic name LINEZOLID, substituting the letter "C" for the letter "L", hence CINEZOLID. By merely changing the first letter of the prefix "LI" to "CI", without changing the three succeeding syllables makes the mark CINEZOLID confusingly similar to the generic name LINEZOLID, both visually and aurally.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2016-501888 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

⁵ Exhibit "B"

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