

**MERCK KGAA,**  
*Opposer,*

**-versus-**

**ZYDUS PHILIPPINES, INC.,**  
*Respondent-Applicant.*

X-----X

}	<b>IPC No. 14-2014-00046</b>
}	Opposition to:
}	Appln. Serial No. 4-2013-012868
}	Date Filed: 24 October 2013
}	
}	
}	<b>TM: BISOLOL</b>

**NOTICE OF DECISION**

**CASTILLO LAMAN TAN PANTALEON & SAN JOSE**  
*Counsel for Opposer*  
2<sup>nd</sup>, 3<sup>rd</sup>, 4<sup>th</sup>, 5<sup>th</sup> and 9<sup>th</sup> Floors, The Valero Tower  
122 Valero Street, Salcedo Village,  
Makati City

**ZYDUS PHILIPPINES, INC.**  
*Respondent- Applicant*  
Unit Penthouse 1, 19<sup>th</sup> Floor Goldloop Tower A  
Escriva Drive, Barangay San Antonio  
Ortigas Center, Pasig City

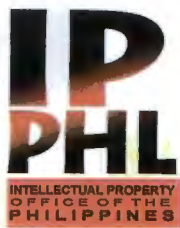
**GREETINGS:**

Please be informed that Decision No. 2017 - 287 dated 29 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPPL 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, 03 July 2017.

*Marilyn F. Retual*  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



MERCK KGAA,

Opposer,

- versus -

IPC NO. 14 – 2014- 00046

Opposition to:  
Appln Serial No. 4-2013-012868  
TM: BISOLOL

ZYDUS PHILIPPINES, INC.,  
Respondent-Applicant.

DECISION NO. 2017 - 287

X-----X

## D E C I S I O N

MERCK KGAA (“Opposer”)<sup>1</sup> filed an Opposition to Trademark Application Serial No. 4-2013-012868. The application, filed by ZYDUS PHILIPPINES, INC., (Respondent-Applicant)<sup>2</sup>, covers the mark “BISOLOL,” for use on “*pharmaceutical product: beta-blockers*” under Class 5 of the International Classification of Goods.<sup>3</sup>

The Opposer’s based its Opposition on the following grounds:

- a. Respondent’s mark “BISOLOL” is a virtual replication of the generic name “BISOPROLOL.” As derivative of a recommended INN and the common INN stem “-OLOL,” “BISOLOL” is non registrable for being generic and merely descriptive.
- b. By Appropriating the prefix “BISO” and the common INN stem “-OLOL” from “BISOPROLOL,” Respondent aims to gain a monopoly over generic name, to the damage and prejudice of Merck, and wholly poses a serious danger to the health and safety of the public.

<sup>1</sup> A corporation organized and existing under the laws of Germany with office address at Frankfurter Strasse 250, 64293 Darmstadt, Germany.

<sup>2</sup> A corporation organized and existing under the laws of India with business address at Unit 903 and 904, Eco Tower, 32<sup>nd</sup> Street cor 9<sup>th</sup> Avenue, Bonifacio Global city, Taguig.

<sup>3</sup> 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.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,  
Taguig City 1634 Philippines • [www.ipophil.gov.ph](http://www.ipophil.gov.ph)  
T: +632-2386300 • F: +632-5539480 • [mail@ipophil.gov.ph](mailto:mail@ipophil.gov.ph)

The pertinent portions of the Opposition are quoted, to wit:

9. Merck secures sustainable success in the pharmaceutical industry with innovative products and solutions that help improve the quality of life. Known and established throughout the world, the products and services of Merck enjoy a high level of trust. Among its well-known products are Glucophage® and Glucovance® for diabetes, Rebif® for the treatment of multiple sclerosis, Erbitux® for colorectal cancer, Pergoveris® for infertility, Euthyrox® for the treatment of euthyroid goiter and suppressive therapy of differentiated thyroid cancer, and Concor® as the first line treatment for hypertension

10. Specifically, Concor® is Merck's international brand name for the pharmaceutical drug "BISOPROLOL," a type of beta-blocker used for the treatment of hypertension and certain heart ailments, alone or in combination with other agents. A pharmaceutical substance, "BISOPROLOL," reduces blood pressure, and by blockade of the cardiac beta1-receptors, reduces cardiac action, and resulting in myocardial oxygen demand.

11. "BISOPROLOL," is an International Nonproprietary Name, or INN, used to identify pharmaceutical substances or active pharmaceutical ingredients. *Each INN is a unique name that is globally recognized and deemed public property. In fact, the World Health Organization treats INNs as generic name for substances.*

*As unique names, INNs have to be distinctive in sound and spelling, and should not be liable to confusion with other names in common use. To make INN universally available, they are formally placed by the WHO in the public domain, hence their designation as "nonproprietary". They can be used without any restriction whatsoever to identify pharmaceutical substances.*

*To avoid confusion, which could jeopardize the safety of patients, trademarks cannot be derived from INN and, in particular, must not include their common stems*

12. Accordingly, "BISOPROLOL," is cited as a Recommended INN in List 23 of the WHO List of INNs for Pharmaceutical substances

13. Merck is well aware of this rule and, in conceptualizing its brand name for "BISOPROLOL," it purposely avoided using "BISOPROLOL" or any of its parts as basis for its brand. Thus, it came up with Concor®. To protect its brand for "BISOPROLOL," Merck registered Concor® in Class 05 of the Nice International Classification with various trademark registry offices all over the world. At present, the Concor® trademark is registered in People's Republic of China, India, Italy, Nicaragua, Pakistan, Peru, Sweden, Thailand, and Trinidad & Tobago, among others.

14. In the Philippines, Merck has also registered the trademark "CONCORE" with this Honorable Office on February 4, 1994, with registration No. 56942 for goods under Class 5 of the Nice International Classification

15. It bears emphasis that opposer's brands Concor® and Concore® are completely distinct from the generic INN "BISOPROLOL."

In support of its Opposition, the Opposer submitted the following:

- Exhibit "A" – print out from Merck website;
- Exhibit "B" – copy of Power of Attorney;
- Exhibit "C" – General Information Sheet of Zydus Philippines, Inc.
- Exhibit "D" – Copy of the Company Publication;
- Exhibit "E" – Merck Interim Report Q3 of 2013;
- Exhibit "F" – print out from Merck website on Glucophage;
- Exhibit "F-1" – print out from Merck website on Glucovance;
- Exhibit "F-2" – print out from Merck website on Rebif;
- Exhibit "F-3" – print out from Merck website on Erbitux;
- Exhibit "F-4" – print out from Merck website on Pergoveris;
- Exhibit "F" – print out from Merck website on Euthyrox;
- Exhibit "G" – print out from Merck website on Concor;
- Exhibit "G-1" – print out from the Merck Manual for Health Care Professionals;
- Exhibit "G-2" – print out on Concor 5;
- Exhibit "H" – print out on World Health Organization website on Guidance on INN;
- Exhibit "I" – print out of Supplement to WHO Chronicle 1983 vol 37, No.6 (December) on International Nonproprietary Names for Pharmaceutical Substance;
- Exhibit "J" – List of the Trademark Registration of Concor in different countries;
- Exhibit "J-1" to "J-10" – Copies of Trademark Registration issued by different countries;
- Exhibit "K" – certification by IPOPHL on Concore trademark awaiting renewal;
- Exhibit "K-1" – picture of Concore packaging and label;
- Exhibit "L", "L-1", "L-2" – Certificate of Product Registration of Concore from FDA;
- Exhibit "M" – print out on General principles for guidance in devising INN;
- Exhibit "N" – print out of the use of stems in the selection of INN for pharmaceutical substance;
- Exhibit "O" – print out from WIPO Philippine Trademark database of Certificate of Registration 42013012868;
- Exhibit "P" and "P-1" – copy of the decisions in Sanofi-Aventis vs. Ranbaxy Laboratories Ltd;
- Exhibit "Q" – WHO Nonproprietary Names for Pharmaceutical Substances; and
- Exhibit "R" – Affidavit of Ulrike Tobler and Gandalf Wentzel

A Notice to Answer was issued on 24 April 2014 and served a copy to the Respondent-Applicant on 2 May 2014. However, the Respondent-Applicant did not file an Answer to the Opposition. This Office issued an Order dated 14 August 2014, declaring the Respondent-Applicant in default. Consequently, this case was submitted for Decision.

The issue to resolve in the present case is whether the respondent - applicant should be allowed to register the trademark "BISOLOL"

*3/14*

Section 123 of the IP Code provides, in part, 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;*

(i) *Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;*

(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”*

Following the above provision, the Respondent-Applicant cannot be allowed to register the mark “BISOLOL” as it is just a part of the generic or international nonproprietary name (INN) *bisoprolol*. To allow Respondent-Applicant to register “BISOLOL” is 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.

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.<sup>4</sup>

This Bureau agrees with the Opposer when it cited the Inter Partes Case No. 14-2009-000249 entitled “Sanofi-Aventis vs. Ranbaxy Laboratories Limited”. The cited case is instructive in the present case because in that case this Bureau sustained the opposition to the application for the 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. As also pointed out by the Opposer, the said decision was affirmed by the Director General in his decision dated 17 December 2012, to wit:

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

---

<sup>4</sup> Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

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"

Verily, the registration of "BISOLOL" would give the Respondent-Applicant the exclusive right to use this mark and unreasonably prevent others from using similar marks including the generic name "BISOPROLOL" to the detriment of the consuming public.

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.<sup>5</sup> The practice of using a trademark that is closely or confusingly similar to the generic term for the goods it represent, is not sanctioned by the IP Code, as it is against the very function of a trademark.

**WHEREFORE**, premises considered, the instant Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-

---


<sup>5</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

5/10/13

012868 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 29 JUN 2017

  
**Atty. Leonardo Oliver Limbo**  
Adjudication Officer  
Bureau of Legal Affairs