

L.R. IMPERIALS, INC.,
Opposer,

-versus-

CATHAY YSS DISTRIBUTORS CO. INC.,
Respondent-Applicant.

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IPC No. 14-2013-00284
Opposition to:

Appln. Serial No. 4-2012-00013694
Date Filed: 12 November 2012

TM: METFOR XR

NOTICE OF DECISION

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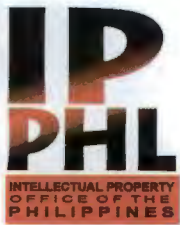
GREETINGS:

Please be informed that Decision No. 2016 - 502 dated 23 December 2016 (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, 03 January 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



L.R. IMPERIALS, INC.,
Opposer,

IPC No. 14-2013-00284
Opposition to:

- versus -

Appln. No. 4-2012-00013694
Date Filed: 12 November 2012
Trademark: "METFOR XR"

CATHAY YSS DISTRIBUTORS CO. INC.,
Respondent-Applicant.

Decision No. 2016 - 502

x ----- x

DECISION

L.R. IMPERIALS, INC. ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2012-00013694. The application, filed by CATHAY YSS DISTRIBUTORS CO., INC. ("Respondent-Applicant")², covers the mark "METFOR X" for use under class 05, particularly as "*anti-diabetic*" of the International Classification of Goods.³

The Opposer alleges the following grounds for opposition:

"7. The registration of the mark 'METFOR XR' in the name of the Respondent-Applicant will violate Sec. 1123.1 (h) and (j) of the IP Code, which 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) x x x

(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; (Emphasis supplied)

"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 'METFOR XR' owned by Respondent-Applicant so resembles the generic name 'METFORMIN', a pharmaceutical drug used as anti-diabetic, Respondent-Applicant's application for the registration of the mark 'METFOR XR' should be denied.

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

² A domestic company, with address at 2nd Floor Vernida I, Amorsolo St., Legazpi Village, Makati City, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

The Opposer's evidence consists of the following:

1. Copy of the pertinent page of the IPO E-Gazette on the subject trademark METFOR XR;
2. Copy of Certificate of Registration No. 4-2001-003304 for the trademark GLUMET;
3. Certified true copies of the Declaration of Actual Use and Affidavit of Use;
4. Sample product label bearing the trademark GLUMET and the generic name METFORMIN;
5. Certified true copy of the Certificate of Product Registration issued by the FDA for GLUMET;
6. Certifications and sales performance issued by the Intercontinental Marketing Services; and,
7. Electronic print-out of the WHO Drug Information - List 40.

On 13 November 2013, Respondent-Applicant filed its Answer, alleging among others, the following Special and Affirmative Defenses:

"18. The language of the provisions of Republic Act No. 9502, otherwise known as the Universally Accessible Cheaper and Quality Medicines Act of 2008 puts forth as mandatory not only by government health agencies and personnel, but also by all private practitioners. In fact, Sec. 6 (b) of Republic Act 6675, as amended, merely adds as an option the inclusion of the brand name of the drug product.

"19. Respondent-Applicant's METFOR XR and Opposer's GLUMET, being prescriptive drugs, will only be dispensed by licensed pharmacists upon the presentation of a prescription from licensed physicians. And, in prescribing the drugs, physicians are mandated to use the generic name. Unless indicated by private practitioners, if so desired, the brand METFOR XR or GLUMET will not even appear on physicians' prescriptions, eliminating any instance of 'unfair use' or 'undue advantage' as far as Respondent-Applicant's METFOR XR mark is concerned.

x x x

"22. Opposer claims that Respondent-Applicant's METFOR XR appears and sounds almost the same as METFORMIN, and therefore, misappropriating upon itself the latter. However, by merely looking at, and pronouncing, the syllables of the marks, it cannot be gainsaid that the two marks give different visual and aural impressions. Respondent-Applicant is not trying to register the generic name, but METFOR XR, which is entirely different in sound and appearance from METFORMIN."

The Respondent-Applicant's evidence consists of the following:

1. Secretary's Certificate issued by Nona F. Crisol;
2. List of product names of drugs and medicines approved by FDA;
3. Affidavit of Nona F. Crisol; and,
4. Certified true copy of the trademark METFOR.

Thereafter, the Preliminary Conference was held and terminated on 14 April 2014. Parties submitted their respective position papers⁴. Hence, this case is submitted for decision.

⁴ Opposer submitted Position Paper on 14 April 2014; Respondent-Applicant submitted Position Paper on 28 April 2014.



Should the Respondent-Applicant be allowed to register the trademark METFOR XR?

Sec. 123 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides, in part, that a mark cannot be registered if it:

- (h) Consist exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consist 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 establishes trade practice;
- (j) Consist 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, of other characteristics of the goods or services."

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 characters"*, or imply reference to *"every member of a genus and the exclusion of individuating characters"*, or *"refer to the basic nature of the wares of 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 it clearly denotes what goods or services are provided in such a way that the customer does not have exercise powers of perception or imagination.⁵

The Opposer alleges that METFORMIN is a generic name and one of the International Non-Proprietary Names ("INN") as recommended by the World Health Organization ("WHO"). In support of this instant opposition, the Opposer submitted an electronic print-out of the World Health Organization (WHO) Drug Information - List 40⁶. A scrutiny of the said document, however, shows there is no basis to consider such document or the contents thereof because it is not a complete document. It appears to be an excerpt of the WHO Drug Information document, which is not even accompanied by any form or manner of authentication of said electronic document⁷. Thus, there is no basis to consider such document or the contents thereof.

Nevertheless, assuming that METFORMIN is a generic name, METFOR XR is not identical or confusingly similar thereto. METFORMIN and METFOR XR may have the same first six letters, but it is not the generic name of the pharmaceutical product involved, more particularly because of the additional letters X and R. Further, there is no showing that METFOR is the customary or usual designation of the product, nor that which serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production or other characteristics thereof.

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 or merchandise, the fruit of his industry and skill; to assure the public that they are procuring the

⁵ Des Produits Nestle, S.A. vs. Court of Appeals (356 SCRA 207, 222-223), 2001.

⁶ Exhibit "G" of Opposer. (check marking)

⁷ R.A. No. 8792, 2000.

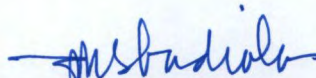
genuine article, to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁸

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-00013694 is hereby **DISMISSED**. Let the file wrapper of subject trademark application be returned, together with a copy of the Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City.

23 DEC 2016



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

⁸ Pribhdas J. Mirpuri vs. Court of Appelas (G.R. No. 114508, 19 November 1999).