

**L.R. IMPERIALS, INC.,**  
*Opposer,*

**-versus-**

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

**IPC No. 14-2015-00495**  
Opposition to:  
Appln. Ser. No. 4-2015-001486  
Date Filed: 11 February 2015

**TM: METFOR**

X-----X

### NOTICE OF DECISION

#### **OCHAVE & ESCALONA**

*Counsel for Opposer*  
No. 66 United Street,  
Mandaluyong City

#### **BELLO VALDEZ CALUYA & FERNANDEZ (JG LAW)**


*Counsel for Respondent-Applicant*  
17<sup>th</sup> Floor, Robinsons Equitable Tower  
4 ADB Avenue corner P. Poveda Drive  
Ortigas Center, Pasig City 1605

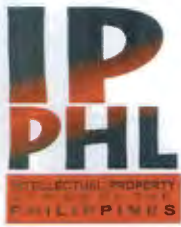
#### **GREETINGS:**

Please be informed that Decision No. 2017 - 330 dated 05 September 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, 07 September 2017.

  
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



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- versus -

**CATHAY YSS DISTRIBUTORS CO. INC.,**  
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IPC No. 14-2015-00495  
Opposition to:

Appln. No. 4-2015-001486  
Date Filed: 11 February 2015  
Trademark: "METFOR"

Decision No. 2017 - 330

### DECISION

L.R. IMPERIALS, INC. ("Opposer")<sup>1</sup>, filed an opposition to Trademark Application Serial No. 4-2015-001486. The application, filed by CATHAY YSS DISTRIBUTORS CO. INC. ("Respondent-Applicant")<sup>2</sup>, covers the mark "METFOR" for use under class 05, particularly as "*anti-diabetes tablet*" of the International Classification of Goods.<sup>3</sup>

The Opposer alleges the following grounds for opposition:

"7. The registration of the mark 'METFOR' 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:**

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' owned by Respondent-Applicant so resembles the generic name 'METFORMIN', a

<sup>1</sup> 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.

<sup>2</sup> A domestic corporation, with address at 2nd Floor Vernida I, Amorsolo St., Legazpi Village, Makati City, Philippines.

<sup>3</sup> 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.

pharmaceutical drug used as anti-diabetic, Respondent-Applicant's application for the registration of the mark 'METFOR' should be denied.

The Opposer's evidence consists of the following:

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

On 04 January 2016, Respondent-Applicant filed its Answer, alleging among others, the following Special and Affirmative Defenses:

"18. Opposer imagines that the registration of Respondent-Applicant's METFOR will cause damage to its GLUMET products because of the former's close resemblance to the product's generic name, METFORMIN. The reality, however, is the contrary. It is highly unlikely that the registration of METFOR will cause damage to Opposer's GLUMET given the provisions of Republic Act No. 9502, otherwise known as the Universally Accessible Cheaper and Quality Medicines Act of 2008, x x x

"19. The language of the law above-quoted 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.

"20. Respondent-Applicant's METFOR 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. Judicial notice must be had of the fact that physicians and pharmacists are trained to distinguish one medicine from another. This means that it would be much easier for them to differentiate drugs that have varying generic names and indications. Unless indicated by private practitioners, if so desired, the brand METFOR 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 mark is concerned.

x x x

"22. Opposer claims that Respondent-Applicant's METFOR 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 , 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. Affidavit of Nona F. Crisol; and,
3. Certificate of Registration No. 4-2012-000226 dated 26 July 2012 for METFOR.

The Preliminary Conference was held and terminated on 25 July 2016. Thereafter, the parties submitted their respective position papers<sup>4</sup>. Hence, this case is submitted for resolution.

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

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.<sup>5</sup>

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 40<sup>6</sup>. A scrutiny of the said document,

<sup>4</sup> Opposer submitted Position Paper on 04 August 2016; Respondent-Applicant submitted Position Paper on 03 August 2016.

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

<sup>6</sup> Exhibit "I" of Opposer.

however, shows there is no basis to consider a photocopy of such document or the contents of an incomplete document. It is not also accompanied by any form or manner of authentication of said electronic document<sup>7</sup>. Thus, there is no basis to consider such document or the contents thereof.

Nevertheless, assuming that METFORMIN is the generic name, METFOR is not identical or confusingly similar thereto. METFORMIN and METFOR may have the same first six letters, but it is not the generic name of the pharmaceutical product involved. 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 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>8</sup>

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2015-001486 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. 05 SEP 2017

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

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<sup>7</sup> R.A. No. 8792, 2000.

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