

RITEMED PHILIPPINES, INC.,
Opposer,

-versus-

FARMA IBERICA CORPORATION,
Respondent-Applicant.

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IPC No. 14-2016-00561
Opposition to:
Appln. Ser. No. 4-2016-006937
Date Filed: 17 June 2016

TM: FLOXACIN

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NOTICE OF DECISION

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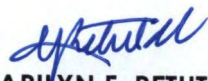
FARMA IBERICA CORPORATION
Respondent-Applicant
2204-C West Tektite Tower, PSE Center
Exchange Road, Ortigas Center
Pasig City

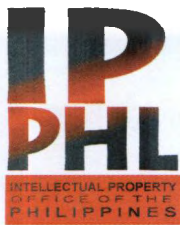
GREETINGS:

Please be informed that Decision No. 2017 - 326 dated 30 August 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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, 04 September 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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FARMA IBERICA CORPORATION,
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x-----x

IPC NO. 14-2016-00561

Opposition to:
Appln. Ser. No. 4-2016-006937
Filing Date: 17 June 2016
Trademark: FLOXACIN

Decision No. 2017 - 326

DECISION

RITEMED PHILIPPINES, INC.,¹ ("Opposer") filed an opposition to Trademark Application No. 4-2016-006937. The application, filed by FARMA IBERICA CORPORATION² ("Respondent-Applicant") covers the mark FLOXACIN for use on "*pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies, plasters, materials for dressings; material for stopping teeth, dental wax, disinfectants; preparations for destroying vermin; fungicides, herbicides*" under Class 05 of the International Classification of goods³.

The Opposer alleges that the registration of the mark FLOXACIN in the name of Respondent-Applicant will violate Section 123.1 (h) and (j) of the Intellectual Property Code of the Philippines because the mark so resembles the generic name "CIPROFLOXACIN", an antibiotic belonging to the group of drugs called fluoroquinolones.

The Opposer's evidence consists of the following:

1. Printout of relevant page of the IPO E-Gazette which was officially released on 05 September 2016;
2. Actual sample packaging of Opposer's CIPROFLOXACIN drug available in the market;
3. Certificate of Product Registration issued by the Bureau of Food and Drugs issued to Opposer;
4. Certification issued by IMS Health; and
5. Copy of International Nonproprietary Names for Pharmaceutical Substances from the Supplement to WHO Chronicle, 1984, Vol. 38, No. 6 (March).

This Bureau issued on 19 October 2016 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's on 28 October 2016. The Respondent-Applicant, however, did not file its Answer. On 27 June 2017, this Bureau declared Respondent-Applicant in default for failure to file the answer. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 56 Dolmar Bldg. EDSA, Mandaluyong City.

² A domestic corporation with office address at 2204-C West Tektite Tower, PSE Center, Exchange Road, Ortigas Center, Pasig City.

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.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Opposer.

Should the Respondent-Applicant be allowed to register the mark "FLOXACIN"?

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.⁴ Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The Opposer anchors its case on Sec. 123.1 (h) and (j) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, which provides:

Sec.123. Registrability — 123.1. 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;

x x x

(j) Consists 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, or other characteristics of the goods or services.

This Bureau finds merit in the Opposer's contention that the Respondent-Applicant's mark should not be registered because it is confusingly similar to the International Nonproprietary Name (INN) "CIPROFLOXACIN".

In *Societe Des Produits Nestle, et. Al. v. Court of Appeals*⁵ the Supreme Court had the occasion to explain what constitutes a generic or descriptive mark, to wit:

Generic marks are common words that describe an entire class of 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 '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 forthwith conveys an immediate

⁴See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

⁵ *Societe Des Produits Nestle, Et. Al. vs. Court of Appeals*. G.R. No. 112012. 4 April 2001.



idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination.

And, in *Asia Brewery, Inc. v. Court of Appeals, Et. Al.*⁶, the Supreme Court explained the reason why generic terms should not be registered as trademarks, thus:

A word or a combination of words which is merely descriptive of an article of trade, or of its composition, characteristics, or qualities, cannot be appropriated and protected as a trademark to the exclusion of its use by others . . . inasmuch as all persons have an equal right to produce and vend similar articles, they also have the right to describe them properly and to use any appropriate language or words for that purpose, and no person can appropriate to himself exclusively any word or expression, properly descriptive of the article, its qualities, ingredients or characteristics, and thus limit other persons in the use of language appropriate to the description of their manufactures, the right to the use of such language being common to all. This rule excluding descriptive terms has also been held to apply to trade-names. As to whether words employed fall within this prohibition, it is said that the true test is not whether they are exhaustively descriptive of the article designated, but whether in themselves, and as they are commonly used by those who understand their meaning, they are reasonably indicative and descriptive of the thing intended. If they are thus descriptive, and not arbitrary, they cannot be appropriated from general use and become the exclusive property of anyone. (52 Am. Jur. 542-543.)

Aptly, a generic name of a product can never function as a trademark. It is regarded by law as free for all to use. As such the registration of generic or purely descriptive marks is proscribed because they are the usual way of designating the relevant goods or services or their characteristics. A generic or purely descriptive term is the name of the product or service itself which is the very antithesis of a mark and cannot function as a mark to identify and distinguish the goods or services of one seller.⁷

"CIPROFLOXACIN" is an international nonproprietary name ("INN") or generic name for a *fluoroquinolone* antibiotic that fights bacteria in the body or used to treat different types of bacterial infections.⁸ The INN is needed for the clear identification, safe prescription and dispensing of medicines, and for communication and exchange of information among health professionals. INNs can be used freely because they are in the public domain. Thus, considering that INN is a public domain, no person may exclusively appropriate the same to himself to the exclusion of others.

The mark "FLOXACIN" is obviously derived and copied from the generic name or INN "CIPROFLOXACIN". What the Respondent-Applicant did is merely to drop "CIPRO" from CIPROFLOXACIN to come up with its mark FLOXACIN. There is no ingenuity or creativity that would give the mark a character that is distinct from the generic term. The mark FLOXACIN would not point or indicate a specific source, origin or manufacturer of the product. FLOXACIN would not be remembered by the consumers as a brand.

Further, if Respondent-Applicant's FLOXACIN mark will be allowed registration, it will not only hamper the orderly development of the INN system but its registration will also give the Respondent-Applicant, as an owner of a registered mark, the unbridled license to enjoin all third parties of the use of the INN "CIPROFLOXACIN" or other words or marks similar to it, including

⁶ G.R. No. 103543, 05 July 1993, citing *Ong Ai Gui v. Director of Patents*, 96 Phil. 673,675 [1955].

⁷ J. Thomas McCarthy, *Trademarks and Unfair Competition*, Vol. I, 1973 Ed., p. 405.

⁸ <https://www.drugs.com/ciprofloxacin.html>, last accessed <29 August 2017>



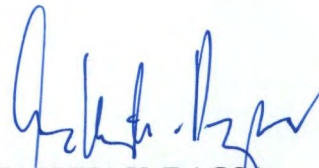
those entitled to use the term "CIPROFLOXACIN" in medical research, clinical documentation, advertising, labeling, product information and drug regulation, among others. A trademark registration is imbued with public interest and adoption of marks that may cause confusion to generic names particularly in the field of pharmaceutical products, cannot be countenanced. It is to the interest of the public that a registered mark should clearly distinguish the goods or services of an enterprise.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (h) and (j) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby *SUSTAINED*. Let the filewrapper of Trademark Application Serial No. 4-2016-006937, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 AUG 2017



MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs