

UNILAB, INC. (formerly American
Pharmaceuticals, Inc.),
Opposer,

-versus-

SYDENHAM LABORATORIES,
Respondent-Applicant.

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IPC No. 14-2016-00551

Opposition to:
Appln. Ser. No. 4-2016-007087
Date Filed: 22 June 2016

TM: SYTHROMYCIN

NOTICE OF DECISION

OCHAVE & ESCALONA

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Respondent- Applicant's Representative
Penthouse, Legaspi Towers 200
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GREETINGS:

Please be informed that Decision No. 2017 - 325 dated 30 August 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, 04 September 2017.

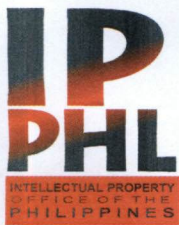
MARILYN F. RETUTAL

IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Filing Date: 22 June 2016

Trademark: SYTHROMYCIN

Decision No. 2017 - 325

DECISION

UNILAB, INC.¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2016-007087. The application, filed by SYDENHAM LABORATORIES² ("Respondent-Applicant") covers the mark SYTHROMYCIN for use on "*pharmaceuticals such as antibacterial medicine*" under Class 5 of the International Classification of goods³.

The Opposer alleges that the registration of the mark SYTHROMYCIN 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 "AZITHROMYCIN", an antibiotic useful for the treatment of a number of bacterial infections.

The Opposer's evidence consists of the following:

1. Certified copy of the Articles of Incorporation of Opposer;
2. Printout of IPOPHL E-Gazette dated 30 August 2016;
3. Certified copy of Certificate of Registration No. 4-2009-009769 for the mark ZENITH;
4. Actual product packaging bearing the trademark "ZENITH";
5. Certification issued by IMS Health;
6. Certificate of Listing of Identical Drug Product issued by the Food and Drug Administration (FDA); and
7. Copy of International Nonproprietary Names for Pharmaceutical Substances taken from WHO Drug Information Vol. 2, No. 3, 1998.

This Bureau issued on 18 October 2016 a Notice to Answer and served a copy thereof to the Respondent-Applicant's counsel on 27 October 2016. The Respondent-Applicant, however, did not file an answer. On 27 June 2017, an Order was issued declaring Respondent-Applicant in default for failure to file the Answer. Accordingly, 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 Opposer.

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at No. 66 United Street, Mandaluyong City.

² A domestic corporation with address at Km. 34 E. Aguinaldo Hi-way near cor. Governor's Drive, Damariñas, Cavite.

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.

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Should the Respondent-Applicant be allowed to register the mark **SYTHROMYCIN**?

Section 123.1 (h) and (j) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), as amended 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.

In *Societe Des Produits Nestle, et. Al. v. Court of Appeals*⁴ the Supreme Court had the occasion to explain what constitutes a generic or descriptive mark, to wit:

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 the 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 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 a customer does not have to exercise power of perception or imagination.

"AZITHROMYCIN" is recognized as one of the International Nonproprietary Names for pharmaceutical substances or active pharmaceutical substances by the World Health Organization. Azithromycin is the generic name for semi-synthetic macrolide antibiotic structurally related to Erythromycin.⁵ It has been used in the treatment of *Mycobacterium avium* intracellular infections, toxoplasmosis, and cryptosporidiosis.⁶

In this case, Opposer claims that Respondent-Applicant's mark resembles the generic name AZITHROMYCIN. The mark of Respondent-Applicant is reproduced below:

SYTHROMYCIN

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

⁵ <https://pubchem.ncbi.nlm.nih.gov/compound/azithromycin#section=Top> <last accessed 30 August 2017>

⁶ *Supra*.

A scrutiny of Respondent-Applicant's mark shows that it is confusingly similar to the generic name AZITHROMYCIN. To arrive at the subject mark, Respondent-Applicant merely removed the letters "A-Z-I" then replaced it with letters "S" and "Y" and copied the letters "T-H-R-O-M-Y-C-I-N" in Azithromycin come up with its mark SYTHROMYCIN. There was no real creativity or ingenuity was infused in the adoption of the mark SYTHROMYCIN. Thus, the similarity is very obvious that to allow the registration of Respondent-Applicant's mark would allow exclusive appropriation of the generic name Azithromycin and prevent others from using of the use of the INN "AZITHROMYCIN" or other words or marks similar to it, including those entitled to use the term Azithromycin in medical research, clinical documentation, advertising, labeling, product information and drug regulation, among others. Appropriation like this cannot be countenanced for it is the interest of the public that a registered mark should clearly distinguish the goods of the enterprise and that generic names and those confusingly similar to them be taken outside the realm of registered marks.⁷


Finally, the main characteristic of registrable trademark is its distinctiveness. A trademark must be a visible sign capable of distinguishing the goods or services of an enterprise.⁸ From the foregoing, SYTHROMYCIN cannot be considered a distinctive mark that would merit trademark registration. SYTHROMYCIN is substantially similar to the generic name AZITHROMYCIN. The Supreme Court in one case ruled that:

[K]nown words and phrases indicative of quality are the common property of all mankind and they may not be appropriated by one to mark an article of his manufacturer, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him. Even when the sole purpose of the one who first uses them is to form them a trademark for him expressing only of origin with himself, if they do not in fact show forth the quality and composition of the article sold by him, he may not be protected in the exclusive use of them.⁹

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2016-007087, 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. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁷ BLA Decision No. 2014-233, IPC No. 14-2011- 00153 promulgated on 22 September 2014.

⁸ Intellectual Property Code of the Philippines (IP Code), Section 121.1

⁹ East Pacific Merchandising Corp. v. Director of Patents, G.R. No. L-14377, 29 December 1960.