



WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

METRO PHARMA PHILS., INC.,
Respondent-Applicant.

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}
} IPC No. 14-2012-00566
} Opposition to:
} Appln. Serial No. 4-2012-008882
} Date Filed: 20 July 2012
} TM: "OMEPRIM"
}
}
}

NOTICE OF DECISION

OCHAVE & ESCALONA

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GREETINGS:

Please be informed that Decision No. 2013 - 196 dated October 09, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 09, 2013.

For the Director:



Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



WESTMONT PHARMACEUTICALS, INC.,
Opposer,

IPC No. 14-2012-00566
Case Filed : 05 December 2012

-versus-

Opposition to:
Appln. Serial No. : 4-2012-008882
Date Filed: 20 July 2012

METRO PHARMA PHILS., INC.,
Respondent-Applicant.

Trademark: "OMEPRIM"

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Decision No. 2013 - 196

DECISION

WESTMONT PHARMACEUTICALS, INC. ("Opposer")¹ filed on 05 December 2012 an opposition to Trademark Application Serial No. 4-2012-008882. The application, filed by METRO PHARMA PHILS., INC. ("Respondent-Applicant")², covers the mark "OMEPRIM" for use on "pharmaceutical preparation" under Class 05 of the International Classification of Goods and Services³.

The Opposer alleges among other things, the following:

"1. The trademark "OMEPRIM" so resembles "OMEPRON" trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "OMEPRIM". The trademark "OMEPRIM", which is owned by Respondent-Applicant, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "OMEPRIM" is applied for the same class of goods as that of trademark "OMEPRIM", i.e. Class (5);

"2. The registration of the trademark "OMEPRIM" in the name of the Respondent-Applicant will violate Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provides, in part, that a mark cannot be registered if it:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

i. the same goods or services, or

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 4th Floor, Bonaventure Plaza, Greenhills, San Juan City.

² A domestic corporation with principal address at 600 Shaw Boulevard, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

- ii. closely related goods or services; or
- iii. if it nearly resembles such a mark as to be likely to deceive or cause confusion; (Emphasis supplied)

Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"3. Respondent-Applicant's use and registration of the trademark "OMEPRIM" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "OMEPRON".

The Opposer, in support of its opposition, submitted in evidence the following:

1. Annex "A" - Pertinent page of the IPO E-Gazette;
2. Annex "B" - Certificate of Registration for the trademark "OMEPRON";
3. Annexes "C" and "D" - Copies of the Affidavits of Use filed by the Opposer;
4. Annex "E" - Sample of product label bearing the trademark OMEPRON actually used in commerce; and
5. Annex "F" - Copy of the Certificate of Product Registration issued by the BFAD for the mark OMEPRON.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 25 January 2013. However, instead of filing the required Verified Answer, the Respondent-Applicant filed a Motion for Extension of Time to File Answer on 27 February 2013, two days after the lapse of the period within which to file the Answer. Accordingly, the instant opposition was deemed submitted for decision.

Should the Respondent-Applicant's trademark application be allowed?

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, Section 123.1 (d) of R. A. No. 8293, also known as the Intellectual Property Code of the Philippines ("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.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 20 July 2012, the Opposer has an existing registration for

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

the trademark OMEPRON under Registration No. 4-2004-010748 issued on 28 August 2005. The Respondent-Applicant's trademark application indicates that the mark is for use on goods "pharmaceutical preparations" under Class 5 which is similar or closely related to the goods covered by the Opposer's registration also under Class 05.

But do the marks resemble each other that confusion, or even deception, is likely to occur?

The marks are depicted below:

Omepron

OMEPRIM

Opposer's Mark

Respondent-Applicant's Mark

The similarity between the contending marks exists in the first three (3) letters compromising the syllables /O/ and /ME/. Obviously, "OME" is derived from the generic name of the product OMEPRAZOLE. "OME", therefore, is not unique as a mark or as a component of a mark and cannot acquire distinctiveness unless accompanied by another term or phrase. Stated otherwise, what would make the trademark distinctive are the suffixes or appendages to the prefix "OME" and/or the devices, if any.

In the instant case, the last syllable comprising the Opposer's and Respondent-Applicant's marks differ only on the last two letters "ON" and "IM", respectively. This slight difference in the spellings, however, is inconsequential to the effect on the eyes and ears, and memory. When presented, they gave the same visual appearance. There is the likelihood that prescription for OMEPRON could be misread as OMEPRIM or vice-versa. Also, since both marks are word marks in plain letterings without any unique device or design, the possibility of confusion is even compounded. Confusion cannot be avoided by merely dropping, adding or changing some of the letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.⁵ Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their overall presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.⁶

Succinctly, because the Respondent-Applicant will use or uses the mark on "*pharmaceutical preparation*", this could include goods or products that are covered by the

⁵ *Societe Des Produits Nestle, S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.

⁶ *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G. R. No. 100098, December 29, 1995.

Opposer's registered trademark. The changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁷

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

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-008882 together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 October 2013.


Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs


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⁷ *American Wire and Cable Co. v. Director of Patents, et. al.*, G. R. No. L-26557, February 18, 1970.