



WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

PLATINUM PHARMACEUTICALS (PVT) LTD.,
Respondent- Applicant.

}
} IPC No. 14-2011-00153
} Opposition to:
} Appln. Serial No. 4-2010-501738
} Date Filed: 26 November 2010
} TM: "OMEZOLE"
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NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
66 United Street, Mandaluyong City

A.Q. ANCHETA AND PARTNERS
Counsel for Respondent-Applicant
Suite 1008-1010 Paragon Plaza
EDSA corner Reliance Street
Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2014 - 233 dated September 22, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 22, 2014.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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IPC No. 14-2011-00153
 Opposition to:
 Appln. Serial No. 4-2010-501738
 Date Filed : 26 November 2010
 Trademark: "OMEZOLE"
 Decision No. 2014 - 233

DECISION

WESTMONT PHARMACEUTICALS, INC., ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2010-501738. The application, filed by PLATINUM PHARMACEUTICALS (PVT) LTD., (Respondent-Applicant)², covers the mark "OMEZOLE" for use on "pharmaceutical preparations for the treatment of duodenal ulcer, gastric ulcer, gastro-esophageal reflux disease (gerd) and management of zollinger-ellisonsyndrome" under class 05 of the International Classification of Goods and Services³.

The Opposer alleged:

"7. The mark 'OMEZOLE' owned by Respondent-Applicant so resembles the trademark 'OMEPRON' owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark 'OMEZOLE'.

"8. The mark 'OMEZOLE' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'OMEZOLE' is applied for the same class and goods as that of Opposer's trademark 'OMEPRON', i.e. Class 05 of the International Classification of Goods as pharmaceutical preparation used for the treatment of ulcer and gastritis.

"9. The registration of the mark 'OMEZOLE' in the name of the Respondent-will violate Sec. 123 of the IP Code, x x x

"10. 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.

"11. Also, the registration of the mark 'OMEZOLE' in the name of the Respondent-Applicant will violate Sec. 123.1 (h) and (j) of the IP Code, x x x

¹ A domestic corporation duly organized and existing under the laws of the Philippines with office address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.
² A foreign corporation with office address at A-20, North Western Industrial Zone, Bin Qasim, Karachi-75020, Pakistan.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a Multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"12. As provided 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 'OMEZOLE' owned by Respondent-Applicant so resembles the generic name 'OMEPRAZOLE', a pharmaceutical drug used as proton pump inhibitor, Respondent-Applicant's application for the registration of the mark 'OMEZOLE' should also be denied on this basis.

The Opposer submitted the following evidence marked as Exhibits "A" to "G" inclusive of submarkings:

1. Pertinent pages of the IPO E-Gazette;
2. Certificate of Registration No. 4-2004-010748 for the trademark OMEPRON;
3. Declaration of Actual Use and Affidavit of Use;
4. Sample product label bearing the trademark OMEPRON;
5. Certification and sales performance;
6. Certificate of Product Registration issued by BFAD for the trademark OMEPRON;
and,
7. Supplement to the WHO Chronicle 1982 (Vol. 36, No. 6, December) List 22.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 24 May 2011. Respondent-Applicant however, did not file an answer. Thus, this instant case is submitted for decision.

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

Section 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, or 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 "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 exercise powers of perception or imagination.⁴

⁴ Des Produits Nestle, S.A. v. Court of Appeals (356 SCRA 207, 222-223) 2001.

In this regard, records show that OMEPRAZOLE is a generic name listed in the Supplement to the World Health Organization (WHO) Chronicle 1982 (Vol. 36, No. 6, December) List 22 as one of the International Nonproprietary Names (INN) for Pharmaceutical Substances.⁵

It appears that the Respondent-Applicant's applied mark OMEZOLE is confusingly similar to and is a virtual replication of the generic mark OMEPRAZOLE. The marks are significantly similar in the beginning letters "O, M, and E" and in the ending letters "Z, O, L, and E". The middle letters "P, R, and A" of the generic name "OMEPRAZOLE" was merely removed in arriving at the subject mark "OMEZOLE". Moreover, both products are used as pharmaceutical products for the treatment of gastrointestinal diseases.

The similarities are very obvious that to allow the registration of OMEZOLE is like allowing the registration of a generic term OMEPRAZOLE. Their similarities easily catches one's attention that the purchasing public may be misled to believe that OMEZOLE and OMEPRAZOLE are one and the same product. To allow its registration would give the Respondent-Applicant the exclusive right to use this mark and prevent others from using similar marks including the generic name and INN OMEPRAZOLE.⁶ This cannot be countenanced for it is to the interest of the public that a registered mark should clearly distinguish the goods of an enterprise and that generic names and those confusingly similar to them be taken outside the realm of registered trademarks.

Finally, the main characteristic of a registrable trademark is its distinctiveness. A trademark must be a visible sign capable of distinguishing the goods or services of an enterprise.⁷ From the foregoing, OMEZOLE cannot be considered a distinctive mark that would merit trademark registration. OMEZOLE is substantially similar to the generic name OMEPRAZOLE that the use of the former can only be construed as an abbreviation of the latter. In one case,⁸ the Supreme Court held that:

"...known 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 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."

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-501738 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 September 2014.


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

⁵ Exhibit "G" of Opposer.

⁶ Sec. 138, IP Code.

⁷ Sec. 121.1, IP Code.

⁸ East Pacific Merchandising Corp. v. Director of Patents, G.R. No. L-14377, 29 Dec, 1960.