



WESTMONT PHARMACEUTICALS INC., } IPC NO. 14-2011-00114
Opposer, } Opposition to:
-versus- }
} Appln. Ser. No. 4-2010-09161
} Date Filed: 20 August 2010
} Trademark: "OMEGARD"
SUHITAS PHARMACEUTICALS, INC., }
Respondent-Applicant. }
x-----x } Decision No. 2014- 264

DECISION

WESTMONT PHARMACEUTICALS INC., (Opposer)¹ filed on 27 February 2013 an opposition to Trademark Application Serial No. 4-2010-09161. The application, filed by SUHITAS PHARMACEUTICALS, INC. (Respondent-Applicant)², covers the mark "OMEGARD", for use on "pharmaceuticals-(proton pump inhibitor)" under Class 5 and under class 35 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"1. The trademark 'OMEGARD' so resembles 'OMEPRON' trademark owned by Opposer, registered with the Honorable Office prior to the publication for opposition of the mark 'OMEGARD'. The trademark 'OMEGARD', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most specially considering that the opposed trademark 'OMEPRON', i.e. Class (5) and used on the same type of products i.e. proton pump inhibitor for treatment of ulcers, gastritis.

"2. The registration of the trademark 'OMEGARD' in the name of the Respondent 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 domestic corporation duly organized and existing under Philippine laws with principal address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines

² A domestic corporation with address at 3/F Centrepoint Bldg., Pasong Tamo cor. Export Bank Drive, Makati City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

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

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’s use and registration of the trademark ‘OMEGARD’ will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark ‘OMEPRON’.

The Opposer also alleges, among others, the following facts:

“4. Opposer is the registered owner of the trademark ‘OMEPRON’, is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark was filed with the Intellectual Property Office on 12 November 2004 by Opposer and was approved for registration by this Office on 28 August 2005 and valid for a period of ten (10) years. Hence, Opposer’s registration of the ‘OMEPRON’ trademark subsists and remains valid to date.

“5. The trademark ‘OMEPRON’ has been extensively used in commerce in the Philippines.

“5.1 Opposer dutifully filed Declaration of Actual Use (‘DAU’) and Affidavit of Use pursuant to the requirement of law, to maintain the registration of ‘OMEPRON’ in force and effect.

“5.2 A sample of product label bearing the trademark ‘OMEPRON’ actually used in commerce is hereto attached.

“5.3 In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, we registered the products with the Food and Drugs Administration (formerly BFAD).

“5.4 No less than the Intercontinental Marketing Services (IMS) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand ‘OMEPRON’ among the leading brands in the Philippines in the category of ‘Antiulcerants Market’ in terms of market share and sales performance.

“6. There is no doubt that by virtue of the above-mentioned Certificates of Registration, the uninterrupted use of the trademark ‘OMEPRON’, and the fact that they are well-known among consumers

and internationally known data provider, the Opposer has acquired an exclusive ownership over the 'OMEPRON' mark to the exclusion of all others.

"7. 'OMEGARD' is confusingly similar to 'OMEPRON'. xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application;
2. Copy of Certificate of Registration dated 28 August 2005 for the mark "OMEPRON";
3. Copy of Declaration of Actual Use and Affidavit of Use dated 13 February 2006 for the mark "OMEPRON";
4. Copy of Certificate of Product Registration issued by the Food and Drugs Authority dated 24 November 2009; and
5. Copy of certification and sales performance from International Marketing Services (IMS) dated 17 January 2011.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 2 May 2011. The Respondent-Applicant, however, did not file an Answer.

Records show that at the time Respondent-Applicant applied for registration of the mark "OMEGARD" the Opposer already registered the mark "OMEPRON" under Certificate of Registration No. 4-2004-010748. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "proton pump inhibitor, medicinal preparation for the treatment of ulcers, gastritis and other gastrointestinal diseases", same as indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

Omepron

OMEGARD

Opposer's mark

Respondent-Applicant's mark

The marks are similar with respect to the prefix ("OME"). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur.

⁴ Annexes "A" to "G"

It is noteworthy that the generic or non-proprietary name of the drug is OMEPRAZOLE, as seen from a reproduction of the packaging⁵ below:




In coining its mark, the Opposer appropriated most of the literal elements of the generic name of the drug OMEPRAZOLE. The Opposer copied the first two syllables “OMEPR” and added letters ON, thus, “OMEPRON”. On the other hand, the Respondent-Applicant merely copied three letters “OME” from the generic name of the drug and affixed “GARD” as the last syllable of its mark. As a result, the competing marks are phonetically dissimilar. The resultant marks which bear different suffixes are visually and aurally different thus, confusion and deception is unlikely.

It must be emphasized that the Opposer anchors its opposition on the ground that its mark and the Respondent-Applicant’s mark both start with the letters “OME”. But to sustain the opposition on this ground is in effect to give the Opposer exclusive right over the letters “OME” which is derived from the generic name “OMEPRAZOLE”. If this is so, then it results in the absurd consequence of the Opposer having the right to prevent the use of even the generic name or labels.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-09161 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 October 2014.


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

⁵ Annex “E”