

WESTMONT PHARMACEUTICALS,  
INC.,  
*Opposer,*

IPC NO. 14-2015-00440

versus-

Appln. Ser. No. 4-2015-502204  
Filing Date: 24 April 2015  
Trademark: ESSOPRIN

JAN VINCENT N. SOLLESTA,  
*Respondent-Applicant.*

X-----X

**NOTICE OF DECISION**


**OCHAVE & ESCALONA**  
Counsel for Opposer  
No. 66 United Street  
Mandaluyong City

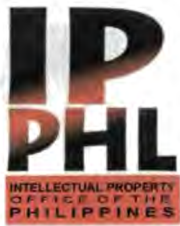
**JAN VINCENT N. SOLLESTA**  
Respondent- Applicant  
Zone 7, Diversion Road  
Sambag, Jaro  
Iloilo City

**GREETINGS:**

Please be informed that Decision No. 2016 - 331 dated 28 September 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 28 September 2016.

  
**Atty. MARLITA V. DAGSA**  
Adjudication Hearing Officer  
Bureau of Legal Affairs



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INC.,

*Opposer,*

versus-

JAN VINCENT N. SOLLESTA,

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Decision No. 2016 - 331

### DECISION

WESTMONT PHARMACEUTICALS, INC.,<sup>1</sup> ("Opposer") filed on 16 September 2015 an Opposition to Trademark Application No. 4-2015-502204. The application, filed by JAN VINCENT N. SOLLESTA<sup>2</sup> ("Respondent-Applicant") covers the mark ESSOPRIN for use on "pharmaceutical preparations" under Class 05 of the International Classification of goods<sup>3</sup>.

The Opposer alleges that the mark ESSOPRIN applied for by Respondent-Applicant so resembles the trademark ESOPRON owned by Opposer and registered with the Intellectual Property Office. According to Opposer, the registration of the mark ESSOPRIN will likely cause confusion, mistake and deception on the part of the purchasing public since the mark ESSOPRIN is applied for the same class of goods as that of Opposer's mark, in violation of Section 123.1 (d) of the IP Code. Opposer also argues that the use and registration of the mark ESSOPRIN will diminish the distinctiveness of the Opposer's ESOPRON mark.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Printout of pertinent page of IPO E-Gazette which was officially released on 24 August 2015; and
2. Exhibit "B" - Copy of Certificate of Reg. No. 4-2013-009711 for the trademark "ESOPRON".

This Bureau issued on 05 October 2015 a Notice to Answer and served a copy thereof thru registered mail to the Respondent-Applicant on 09 February 2016. The Respondent-Applicant, however, despite receipt of the Notice did not file an answer. On 18 July 2016, this Bureau declared Respondent-Applicant in default. 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 Opposer.

Should the Respondent-Applicant be allowed to register the mark ESSOPRIN?

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

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

<sup>2</sup> A Filipino with address at Zone 7, Diversion Road, Sambag, Jaro, Iloilo City.

<sup>3</sup> 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

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,  
Taguig City 1634 Philippines • [www.ipophil.gov.ph](http://www.ipophil.gov.ph)

T: +632-2386300 • F: +632-5539480 • [mail@ipophil.gov.ph](mailto:mail@ipophil.gov.ph)

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.<sup>4</sup> 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 records show that at the time the Respondent-Applicant filed its application for the mark ESSOPRIN on 24 April 2015, the Opposer already has an existing registration for the trademark ESOPRON issued on 01 May 2014, covering goods falling under Class 05, namely, "pharmaceutical preparations for GERD, dyspepsia, gastritis, peptic ulcer disease, duodenal ulcer". On the other hand, the Respondent-Applicant's trademark application is used on "pharmaceutical preparations" also under Class 05. This broad coverage would include therefore, pharmaceutical products covered by the Opposer's trademark registration.

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

**ESOPRON**

*Opposer's Mark*

**Essoprin**

*Respondent-Applicant's Mark*

A perusal of the composition of the competing trademarks involved in this case show that both marks contain three syllables "E-SO-PRON" for Opposer's mark and "ES-SO-PRIN" for Respondent-Applicant's. Both marks start with letter "E" and end with letter "N" and have similar second syllable "SO". Respondent-Applicant added another letter "S" and change the letter "O" to "I" before the letter "N" in Opposer's mark to form the ESSOPRIN mark. Although the marks are not entirely the same because the ESOPRON mark is written in capital letters while in Respondent-Applicant's, only the first letter is capitalized, there are no other appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other.

Confusion cannot be avoided by merely adding, removing or changing some 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<sup>5</sup>. 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 trade name with that of the other mark or trade name in their over-all 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<sup>6</sup>.

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

<sup>5</sup>See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

<sup>6</sup>See *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R. No. 100098, 29 Dec. 1995.

Furthermore, when Respondent-Applicant's ESSOPRIN mark is pronounced, it produces the same sound as that of Opposer's ESOPRON mark such that to the ears they are indistinguishable from one other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark. Similarity of sound is sufficient ground to rule that two marks are confusingly similar when applied to merchandise of same descriptive properties. In fact, the Supreme Court has in many cases took into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity. In *Marvex Commercial Co., Inc. v Petra Hawpia & Co., et al.*<sup>7</sup>, the Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same." (*Emphasis supplied*)

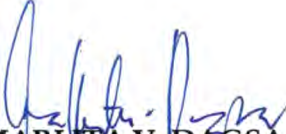
Thus, the use by the Respondent-Applicant of the trademark ESSOPRIN is likely to give rise to confusion or wrong belief that its products bearing the mark originated from, manufactured or sponsored by the Opposer or vice-versa.

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. 4-2015-502204, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **28 SEP 2016**

  
**MARLITA V. DAGOSA**  
Adjudication Officer  
Bureau of Legal Affairs

<sup>7</sup> G.R. No. L-19297. December 22, 1966 cited in *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993. August 18, 2004.