

**WESTMONT PHARMACEUTICALS, INC.,**  
*Opposer,*

**-versus-**

**AMBICA INTERNATIONAL TRADING, CORP.,**  
*Respondent-Applicant.*

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**IPC No. 14-2013-00474**

Opposition to:

Appln. Serial No. 4-2013-005710

Date Filed: 20 May 2013

**TM: OMIPIN**

**NOTICE OF DECISION**

**OCHAVE & ESCALONA**

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Mandaluyong City

**GENER C. SANSAET**


*Counsel for Respondent- Applicant*  
West Tower, 2005-A, PSE Center  
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Pasig City

**GREETINGS:**

Please be informed that Decision No. 2017 - 123 dated 18 April 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, 19 April 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

<p><b>WESTMONT PHARMACEUTICALS, INC.,</b> Opposer,</p> <p>-versus-</p> <p><b>AMBICA INTERNATIONAL TRADING, CORPORATION,</b> Respondent-Applicant.</p> <p>X-----X</p>	<p>} <b>IPC NO. 14-2013-00474</b></p> <p>} Opposition to:</p> <p>}</p> <p>} Appln. Ser. No. 4-2013-005710</p> <p>} Date Filed: 20 May 2013</p> <p>}</p> <p>} Trademark: "OMIPIN"</p> <p>}</p> <p>} Decision No. 2017- <i>123</i></p>
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**DECISION**

WESTMONT PHARMACEUTICALS, INC., (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2013-005710. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION (Respondent-Applicant)<sup>2</sup>, covers the mark "OMIPIN", for use on "pharmaceutical preparations namely proton pump inhibitor" under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the following grounds:

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

"2. The trademark 'OMIPIN', will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'OMIPIN', is applied for the same class of goods as that of Opposer's trademark 'OMEPRON', i.e. Class (5).

"3. The registration of the mark 'OMIPIN' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code otherwise known as the Intellectual Property Code of the Philippines, which provides, in part, that a mark cannot be registered if it:

<sup>1</sup> A domestic corporation duly organized and existing under Philippine laws with principal address at Bonaventure Plaza, Ortigas Avenue, San Juan City, Philippines

<sup>2</sup> A domestic corporation with address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque City

<sup>3</sup> 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.

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(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
- (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.

“10. Respondent’s use and registration of the mark ‘OMIPIN’ will diminish the distinctiveness of Opposer’s trademark ‘OMEPRON’.

The Opposer also alleges, among others, the following:

“11. Opposer the registered owner of the trademark ‘OMEPRON’. It is engaged in the marketing and sale of a wide range of pharmaceutical products.

The Trademark Application for the trademark ‘OMEPRON’ was filed with the IPO on 12 November 2004 by Opposer and was approved for registration on 28 August 2005 to be valid for a period of ten (10) years or until 28 August 2015. Thus, the trademark ‘OMEPRON’ subsists and remains valid to date.

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

“12.1. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, the product has been registered with the Bureau of Food and Drugs (now Food and Drugs Administration).

“12.2. Opposer dutifully filed a Declaration of Actual Use and Affidavit of Use pursuant to the requirement of the law.

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

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

1. Print-out of page IPO e-Gazette showing the Respondent-Applicant’s trademark application;
2. Copy of Certificate of Registration No. 4-2004-010748 dated 28 August 2008 for the mark “OMEPRON”;

3. Copy of Certificate of Listing of Identical Drug Product issued by Bureau of Food and Drugs dated 2 April 2012;
4. Copy of Declaration of Actual Use dated 13 February 2006;
5. Copy of Affidavit of use dated 25 November 2010;
6. Sample packaging of "OMEPRON"; and
7. Certification from IMS Health Intelligence dated 11 November 2013.<sup>4</sup>

The Respondent-Applicant filed its Answer on 14 April 2014, alleging among other things, the following affirmative defenses:

"8. OMIPIN' is not identical to 'OMEPRON' as these marks are clearly different in spelling and have distinctive pronunciations, fonts, colors and designs, nor do they resemble or are confusingly similar to each other as to be likely to deceive or to cause confusion. OMEPRON is in bold face, regular case and is italicized while OMIPIN is regular face, all caps and is in regular font. xxx

"11. Besides, Opposer could not have acquired any right over the first three letters of its mark OMEPRON, i.e. OME, considering that the same is derived from OMEPRAZOLE, the generic name of the product. In Sanofi-Aventis v. Ver Hellen Pharmaceuticals, Appeal No. 14-08-04, December 19, 2008, citing IP Code, Section 121.1, the Director General of the Hon. Office, cancelled the registration of the marks 'XARTAN' and 'XARTAN+' for being directly derived from the generic and International Non-Proprietary Name 'Losartan' xxx"

The Respondent-Applicant submitted as evidence, the following:

1. Copy of Notice of Allowance and trademark application of "OMIPIN"; and
2. Certificate of Product Registration DRP-4149 from the Food and Drug Administration dated 18 December 2012.

The Preliminary Conference was held on 29 September 2014. The Opposer and the Respondent-Applicant submitted their position papers on 29 October 2014 and 7 October 2014, respectively.

Records show that at the time Respondent-Applicant applied for registration of the mark "OMIPIN" the Opposer already registered the mark "OMEPRON" under of Registration No. 4-2004-010748 dated 28 August 2008. 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", while the Respondent-Applicant's trademark application indicates use as "pharmaceutical preparations namely proton pump inhibitor".

Are the competing marks, depicted below, identical or closely resembling each other such that confusion, even deception, is likely to occur?

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<sup>4</sup> Exhibit "A" to "G"

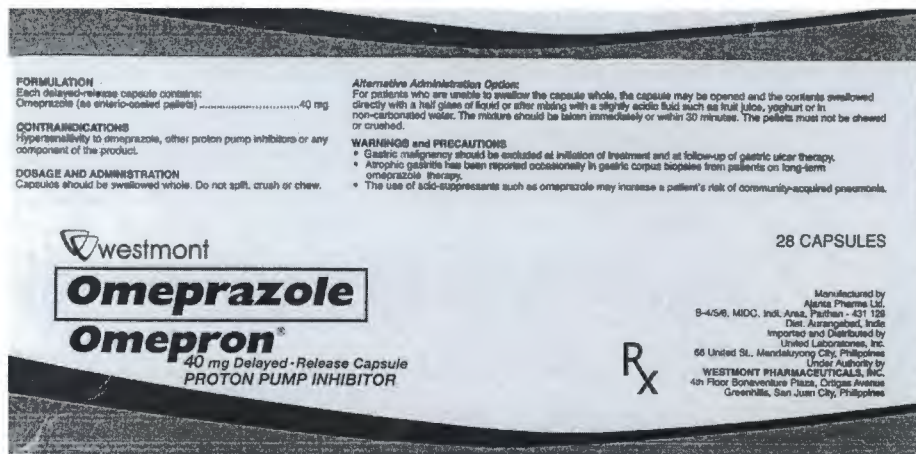
Opposer's mark

Respondent-Applicant's mark

**Omepron**

**OMIPIN**

The marks have the same prefix ("OM"). The rest of the letters are different in spelling and pronunciation, "IPIN" and "EPRON", even if both utilize the letters "P" and "N". These similarities however, are not sufficient to conclude that confusion among the consumers is likely to occur. Visually and aurally, the marks are dissimilar. It is noteworthy that the generic or non-proprietary name of the Opposer's drug the is OMEPRAZOLE as seen from a reproduction of the packaging<sup>5</sup> below:



Predictably, the Opposer copied the first five letters, "OMEPR" of the generic name of the product it is identifying, and merely added letters "ON". The Opposer appropriated the first five letters of the generic name. On the other hand, it appears that the Respondent-Applicant who also secured its license from the Food and Drugs Authority to be able to sell its products,<sup>6</sup> have created a more unique trademark, quite different from that of the Opposers.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2013-005710 is hereby **DISMISSED**. Let the filewrapper of the

<sup>5</sup> Exhibit 'F'


<sup>6</sup> Exhibit "2"

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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, 18 APR 2017

  
Atty. ADORACION U. ZARE, LL.M.  
Adjudication Officer  
Bureau of Legal Affairs