

WESTMONT PHARMACEUTICALS INC.,
Opposer,

-versus-

AMBICA INTERNATIONAL TRADING
CORPORATION,
Respondent- Applicant.

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IPC No. 14-2014-00411
Opposition to:
Appln. Serial No. 4-2014-00005458
Date Filed: 06 May 2014
TM: PROMEPRAZOLE

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NOTICE OF DECISION

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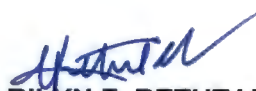
GENER CABOTAJE SANSAET
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West Tower 2005-A, PSE Centre
Exchange Road, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2017 - 107 dated April 10, 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, April 17, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

WESTMONT PHARMACEUTICALS INC.,	} IPC NO. 14-2014-00411
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2014-00005458
	} Date Filed: 6 May 2014
	}
AMBICA INTERNATIONAL TRADING	} Trademark: "PROMEPRAZOLE"
CORPORATION,	}
Respondent-Applicant.	}
x-----x	} Decision No. 2017- 107

DECISION

WESTMONT PHARMACEUTICALS INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-0005458. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION (Respondent-Applicant)², covers the mark "PROMEPRAZOLE", for use on "pharmaceutical preparations namely proton pump inhibitor" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The registration of the mark 'PROMEPRAZOLE' in the name of the Respondent-Applicant will violate Sec. 123.1 (h) and (j) of the IP Code, which provides in part, that a mark cannot be registered if it:

(h) Consists exclusively of sign that are generic for the goods or services that they seek to identify; xxx

(j) Consists 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 characteristic of the goods or services xxx"

"8. 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 applied for by Respondent-Applicant 'PROMEPRAZOLE' so resembles the generic name 'OMEPRAZOLE',

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

² A domestic corporation with address at #9 Amsterdam Extension, Merville Park Subdivision, paranaque 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.

proton pump inhibitor, Respondent-Applicant's application for the mark 'PROMEPRAZOLE' should be denied.

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

"9. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. Opposer is the owner of the product 'OMEPRON'. The generic name and/or active ingredient of the pharmaceutical product 'OMEPRON' owned by Opposer is 'OMEPRAZOLE'.

"9.2. 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 registration of the mark 'OMEPRON' subsists and remains valid to date.

"10. The trademark 'OMEPRON' has been extensively used in commerce in the Philippines.

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

"10.2 Opposer has dutifully filed Declaration of Actual Use and Affidavit of Use pursuant to the requirement of the law.

"10.3 A sample of product label bearing the trademark 'OMEPRON' actually used in commerce is hereto attached.

"10.4. 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' as one of the leading brands in the Philippines in the category of 'A02B- Anti-ulcerants' in terms of market share and sales performance.

"11. By virtue of the foregoing, there is submitted that not only the Opposer, but all users of the generic component 'OMEPRAZOLE' in their products, as well, will be damaged by the appropriation and registration of the mark 'PROMEPRAZOLE' by Respondent-Applicant as this is closely and confusingly similar to the generic name 'OMEPRAZOLE', which gives Respondent-Applicant undue advantage due to the affinity of its mark 'PROMEPRAZOLE' to the generic name 'OMEPRAZOLE'.

"12. Moreover, the registration of the mark 'PROMEPRAZOLE' clearly violates the IP Code's prohibition on the registration of a generic and/or descriptive term in such that all users, including Opposer, of the generic component 'OMEPRAZOLE' in their products have a right to oppose Respondent-Applicant's application for registration of the mark 'PROMEPRAZOLE', otherwise, such prohibition may be rendered nugatory.

"13. As enunciated earlier, the registration of Respondent-Applicant's mark 'PROMEPRAZOLE' will be contrary to Section 123.1 (h) and (j) of the IP Code. The mark 'PROMEPRAZOLE' applied for registration with the IPO by Respondent-Applicant so resembles the generic name 'OMEPRAZOLE', a proton pump inhibitor, which is incapable of being appropriated.xxx

"15. Further, the generic name 'OMEPRAZOLE' is listed in the World Health Organization (WHO) Chronicle (Vol. 36, No. 6, December 1982, p.5) List 22 as one of the International Nonproprietary Names for Pharmaceutical Substances (INN).

"16. The INN' x x x is the official non-proprietary or generic name given to a pharmaceutical substance, as designated by the World Health Organization (WHO). The plethora of named proprietary preparations containing a given substance can lead to confusion about the identity of the active ingredient. INNs facilitate communication by providing a standard name for each substance, they are designed to be unique and distinct so as to avoid confusion in prescribing.

"17. Under the WHO Guidelines and Mission of the INN, INN drugs such as 'OMEPRAZOLE', is referred to as generic and thus, cannot be appropriated as trademark for any pharmaceutical product, to wit:

'Guidance

International Nonproprietary Names (INN) facilitate the identification of pharmaceutical substances or active pharmaceutical ingredients. Each INN is a unique name that is globally recognized and is public property. A nonproprietary name is also a generic name.

Mandate

WHO has a constitutional mandate to 'develop, establish and promote international standards with respect to biological, pharmaceutical and similar products.'

The World Health Organization collaborates closely with INN experts and national nomenclature committees to select a single name of worldwide acceptability for each active substance that is to be marketed as a pharmaceutical. To avoid confusion, which could jeopardize the safety of patients, trade-marks should neither be derived from INNs nor

contain common stems used in INNs. The selection and publication of INNs falls under the responsibility of the HSS/EMP/QSM team of the INN Programme.

"18. Clearly, to allow the registration of Respondent-Applicant's mark 'PROMEPRAZOLE' will violate Section 123.1 (h) and (j) of the IP Code on the ground that such mark is closely and confusingly similar to the generic name (an INN) 'OMEPRAZOLE', which is generic and/or descriptive term of the active ingredient of the kind, quality and intended purpose of goods covered by Respondent-Applicant's mark; hence, cannot be exclusively appropriated and registered as a trademark.

"19. Respondent-Applicant's mark 'PROMEPRAZOLE' is confusingly similar to the generic name and/or descriptive term 'OMEPRAZOLE'.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 4-2004-010748 dated 28 August 2005 for the mark "OMEPRON";
3. Certificate of Listing of Identical Drug Product Issued by the Bureau of Food and Drug dated 2 April 2012;
4. Declaration of Actual Use dated 13 February 2006;
5. Affidavit of Use dated 25 November 2010;
6. Sample product label of "OMEPRON";
7. Certification issued by IMS Health Philippines, Inc. dated 3 September 2014; and
8. Selected pages of Supplement to WHO Chronicle 1982, Vol. 36, No. 6 December.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 9 October 2014. The Respondent-Applicant, however, did not submit its original Secretary's Certificate from receipt of an order from the Bureau. Thus, the Hearing Officer issued on 10 September 2015 Order No. 2015-1401 declaring the Respondent-Applicant in default for failure to complete the requirements on time.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "PROMEPRAZOLE" the Opposer already registered the mark "OMEPRON" under of Registration No. 4-2004-010748 on 28 August 2005. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "proton pump inhibitor

⁴ Exhibits "A" to "H"

medicinal preparation for the treatment of ulcers, gastritis and other gastrointestinal disease”, while the Respondent-Applicant’s trademark application indicates use as “pharmaceutical preparations namely proton pump inhibitor.”

Should the Respondent-Applicant be allowed to register the mark “PROMEPRAZOLE”?

The competing marks are reproduced below:



Opposer’s mark



Respondent-Applicant’s mark

The marks are similar with respect to six letters "O"- "M"- "E"- "P"- "R" and "O" in the suffix. Such similarities however, are not sufficient to conclude that confusion among the consumers is likely to occur. The Opposer argues that the mark PROMERAZOLE cannot be registered because it is a generic and/or descriptive term for the pharmaceutical product OMEPRAZOLE. OMEPRAZOLE is a generic name and is listed in the WHO Chronicle as International Nonproprietary Names (INN) for Pharmaceutical Products⁵. The Respondent-Applicant added two letters "P" and "R" to form the prefix and added the generic name of its product. It is not uncommon, that registered owners of pharmaceutical products add, substitute letters, play on the syllables of the INN or generic names of drugs to create their unique brand name. Because the Respondent-Applicant appropriated all the ten (10) letters of the generic name or four (4) syllables and merely added the letters "P" and "R", the resultant word, "PROMEPRAZOLE" is still substantially identical or similar to the INN or generic name of the drug OMEPRAZOLE, and therefore, unregistrable.

This Bureau takes judicial notice of Inter Partes Case No. 14-2009-000249 entitled *Sanofi-Aventis v. Ranbaxy Laboratories Limited*. This Bureau decided the cited case by sustaining the opposition to the application for the registration of the mark "IRBESAR" on the ground that it is confusingly similar to and is a virtual replication of "IRBESARTAN", which is the generic term for a drug mainly used for treating hypertension. The decision of the Bureau was upheld by the Office of the Director General in Appeal No. 14-2010-0042⁶, where it held, that:

“Accordingly, the similarities in IRBESAR and IRBESARTAN are very obvious that to allow the registration of IRBESAR is like allowing the registration of a generic term like IRBESARTAN. The similarities easily catches one's attention that the purchasing public may be misled to believe that IRBESAR and IRBESARTAN are the same and one product.

⁵ Exhibit "H"

⁶ 17 December 2012

“A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto as specified in the certificate.⁷ Significantly, the registration of IRBESAR 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 IRBESARTAN. 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 to be taken outside the realm of registered trademarks.

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

“...known words and phrases indicative of quality are the common property of all mankind and they are not appropriated by one to a mark as 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.”⁹

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-00005458 is hereby **SUSTAINED**. 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, TO APR 2017



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

⁷ Sec. 138, IP Code

⁸ Sec. 121.1, IP Code

⁹ *East Pacific Merchandising Corp. v. Director of Patents*, G.R. No. L- 14377, 29 December 1960.