

WESTMONT PHARMACEUTICALS, INC.,

Opposer,

-versus-

AMBICA INTERNATIONAL CORPORATION,

Respondent-Applicant.

X-----X

IPC No. 14-2016-00222

Opposition to:

Appln. Serial No. 4-2015-008394

Date Filed: 28 July 2015

TM: PERIDOM

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 201 dated 07 June 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, 07 June 2017.

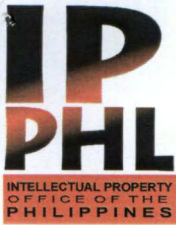
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IPRS IV

Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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WESTMONT PHARMACEUTICALS, INC.,	} IPC NO. 14-2016-00222
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2015-008394
	} Date Filed: 28 July 2015
	} Trademark: "PERIDOM"
AMBICA INTERNATIONAL CORPORATION,	}
Respondent-Applicant.	}
x-----x	} Decision No. 2017- 201

DECISION

WESTMONT PHARMACEUTICALS, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2015-008394. The application, filed by AMBICA INTERNATIONAL CORPORATION (Respondent-Applicant)², covers the mark "PERIDOM", for use on "pharmaceutical preparations namely anti-emetic" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The registration of the mark 'PERIDOM' 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 signs that are generic for the goods or services that they seek to identify; xxx

(j) Consists exclusively of signs or of 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 'PERIDOM' applied by Respondent-Applicant so resembles the generic name 'DOMPERIDONE', which is used to relieve nausea and vomiting, Respondent-

¹ A corporation duly organized and existing under the laws of the Philippines with address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City

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.

Applicant's application for registration of the mark 'PERIDOM' should be denied.

According to the Opposer:

"9. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. Opposer is the owner of the trademark 'GI NORM'. The generic name and/or the active ingredient of the pharmaceutical product 'GI NORM' is 'DOMPERIDONE'. xxx

"10. The trademark 'GI NORM' has been extensively used in commerce in the Philippines. xxx

"10.1. A sample of product label bearing the trademark 'GI NORM' which shows the generic name 'DOMPERIDONE' actually used in commerce is hereto attached and made an integral part hereof xxx

"10.2. 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 'GI NORM' as one the leading brands in the Philippines in the category of 'A034- Gastroprokinetics' in the Philippines in terms of market share and sales performance. xxx

"10.3. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, Opposer registered the product with the 'GI NORM' with the Food and Drug Administration (formerly the Bureau of Food and Drugs).

"11. By virtue of the foregoing, it is submitted that Opposer will be damaged by the unfair use of the mark 'PERIDOM' by Respondent – Applicant as this is closely and confusingly similar to the generic name 'DOMPERIDONE', which gives the Respondent-Applicant an undue advantage due to the affinity of its mark 'PERIDOM' to the generic name 'DOMPERIDONE'. xxx

"13. As enunciated earlier, the registration of Respondent-Applicant's mark 'PERIDOM' will be contrary to Section 123.1 (h) and (j) of the IP Code. The mark 'PERIDOM' owned by Respondent-Applicant so resembles the generic name and/or descriptive term 'DOMPERIDONE', which is incapable of being appropriated.xxx

"15. Further, the generic name 'DOMPERIDONE' is listed in the World Health Organization (WHO) Chronicle (Vol. 31, No. 10) List 17 as one of the International Nonproprietary Names for Pharmaceutical Substances (INN). xxx

“16. The INN is the official non-proprietary or generic name given to a pharmaceutical substance, as designated by the 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 Guidance and Mission of the INN, INN drugs such as 'DOMPERIDONE', 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 known as 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 'PERIDOM' 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) 'DOMPERIDONE', 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. The generic name 'DOMPERIDONE' and Respondent-Applicant's mark 'PERIDOM' are practically identical marks in sound and appearance that they leave the same impression upon the public. 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. Print-out of pages of IPO website showing details of Opposer's trademark GI NORM;
3. Sample product label of "GI NORM";
4. Certification issued by IMS Health Philippines, Inc. dated 26 April 2016;
5. Certificate of Product Registration of the brand name "GI NORM" issued by the Bureau of Food and Drugs dated 8 August 2011; and
6. Selected pages of Supplement to WHO Chronicle 1977, Vol 31, No. 10⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 30 May 2016. The Respondent-Applicant, however, did not file an answer. Thus, the Adjudication Officer issued on 31 August 2016 Order No. 1422 declaring the Respondent-Applicant in default.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "PERIDOM" the Opposer already registered the mark "GI FORM" under Certificate of Registration No. 8126 dated 4 August 2011⁵. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

The Respondent-Applicant's mark is reproduced below:

PERIDOM

Respondent-Applicant's mark

The Opposer asserts that Respondent-Applicant's mark is confusingly similar to its generic name DOMPERIDONE. It is noted that DOMPERIDONE is a generic name and is listed in the WHO Chronicle as International Nonproprietary Names (INN) for Pharmaceutical Products⁶.

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 characteristics*", or "*refer to the basic nature of the wares or the services provided rather*

⁴ Exhibits "A" to "F"

⁵ Exhibit "B"

⁶ Exhibit "F"


than to the more idiosyncratic characteristics of a particular product”, and are not legally protectable.⁷

In this regard, while the Respondent-Applicant appropriates seven letters from the generic name of its product, still, the mark PERIDOM, is not substantially similar nor confusing to the generic name DOMPERIDONE. While the Bureau is fully aware of the reason for not allowing the registration of marks that are an obvious replication of its generic names/or International Nonproprietary Names (INN), and to avoid confusion in prescribing medications, that assertion is not applicable to the instant case, because the mark PERIDOM is not identical or confusing with the DOMPERIDONE. The prefix DOM and the suffix DONE are different. Over-all, the PERIDOM and the generic mark are not visually or aurally confusing. Furthermore, the Bureau cannot ignore the common practice of coining and creating trademarks that play upon or stem from letters of the generic names of pharmaceutical products on which the marks are applied. As long as the coined terms are unique and distinct marks, not identical or confusingly similar to the generic names, these words are valid and registrable trademarks.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2015-008394 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, 07 JUN 2017


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

⁷ *Des Produits Nestle, S.A. v. Court of Appeals* (356 SCRA 207, 222-223) 2001.