

**WESTMONT PHARMACEUTICALS, INC.,**

Opposer,

**-versus-**

**AMBICA INTERNATIONAL TRADING  
CORPORATION,**

Respondent- Applicant.

X-----X

**IPC No. 14-2014-00413**

Opposition to:

Appln. Serial No. 4-2014-005462

Date Filed: 06 May 2014

**TM: "OMIPRA"**

**NOTICE OF DECISION**

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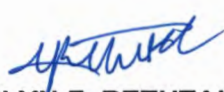
Pasig City

**GREETINGS:**

Please be informed that Decision No. 2016 - 208 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

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

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

- versus -

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**IPC No. 14-2014-00413**  
Opposition to:

Appln. No. 4-2014-005462  
Date Filed: 06 May 2014  
Trademark: "**OMIPRA**"

Decision No. 2016 - 208

### DECISION

WESTMONT PHARMACEUTICALS, INC. ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2014-005462. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION ("Respondent-Applicant")<sup>2</sup>, covers the mark "OMIPRA" for use on *pharmaceutical preparations namely proton pump inhibitor* under class<sup>3</sup> 05 of the International Classification of Goods and Services.

The Opposer alleges the following grounds for opposition:

"7. The mark 'OMIPRA' applied for by Respondent-Applicant so resembles the trademark "OMEPRON" owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark 'OMIPRA'.

"8. The mark 'OMIPRA' will likely cause confusion, mistake, and deception on the part of the purchasing public, most especially considering that the opposed mark 'OMIPRA' is applied for the same class and goods as that of Opposer's trademark 'OMEPRON', *i.e.*, Class 05 of the International Classification of Goods for pharmaceutical preparation namely proton pump inhibitor.

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

"xxx

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**

<sup>1</sup> A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at 4<sup>th</sup> Floor, Bonaventure Plaza, Ortigas Avenue, San Juan, Metro Manila, Philippines.

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

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.



- (iii) **if it nearly resembles such a mark as to be likely to deceive or cause confusion;**

xxx (Emphasis supplied)

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-Applicant's use and registration of the mark 'OMIPRA' will diminish the distinctiveness of Opposer's trademark 'OMEPRON'."

The Opposer's evidence consists of the following:

1. Copy of the pertinent page of the IPO E-Gazette released on 11 August 2014;
2. Copy of Certificate of Registration No. 4-2004-010748 for the trademark OMEPRON with filing date on 12 November 2004;
3. Copy of the certificate of listing of identical drug product No. DRP-3071-01;
4. Declarations of actual use and affidavit of actual use;
5. Sample product label bearing the trademark OMEPRON; and,
6. Certification and sales performance issued by the Intercontinental Marketing Services ("IMS").

On 08 December 2014, Respondent-Applicant filed its Answer, alleging among other things, the following:

"11. The trademark 'OMIPRA' is not identical to, nor does so resemble, the generic name 'Omepron' so as to cause confusion, mistake or deception on the part of the purchasing public.

"12. 'OMIPRA' is not identical to, nor does so resemble, the mark "Omepron" as these marks are clearly different in spelling and have distinctive pronunciations, fonts, colors, and designs, nor do they nearly resemble or are confusingly similar to each other as to be likely to deceive or cause confusion.

x x x

"13. Importantly, there is no indication at all that the use of the mark 'OMIPRA' would likely cause confusion or mistake in the mind of or deceive the ordinary purchaser, or one who is accustomed to buy, and therefore to some extent familiar with, the mark 'Omepron'.

"14. Even assuming for argument that somehow 'OMIPRA' is confusingly similar to 'Omepron' (although as discussed above it is not), Opposer has no right to be protected and cannot bar respondent-applicant from using the mark "OMIPRA" as it cannot possibly acquire an exclusive ownership of the mark "Omepron" to the exclusion of others it being a direct derivative of the generic term "OMEPRAZOLE".

x x x

"15. If there is confusing similarity, trademark dilution and intent to ride on the popularity of another mark, Opposer is the guilty party, 'Omepron' being a what can be considered a 'lame variation' of 'OMEPRAZOLE'. Significantly, almost all the letters in 'Omepron' are also in 'OMEPRAZOLE'. Truth to tell, it is not farfetched to state that 'Omepron' has the 'general impression, or a central figure or a dominant



characteristic' of 'OMEPRAZOLE' an international non-proprietary name incapable of being exclusively appropriated.

"16. At the least, 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.

"17. The fact that OME is derived from the generic name of the product is even noted in the Omperon's Certificate of Registration. This heavily implies that Opposer could not have acquired any right to the exclusive use of the prefix OME.

"18. Without any exclusive right over the first three letters of its mark 'Omepron', only the remainder of the letters of the marks should now be compared, i.e. PRA vis a vis PRON. The striking dissimilarities are at once evident. The differences in pronunciation and the number of letters stand out at once negating any charge of confusion.

"19. The Generics Act of 1988 (RA No. 6675) requires that 'the generic name shall appear prominently and immediately above the brand name in all product labels as well as in advertising and other promotional materials' obviating any risk of confusion. In fact, "All medical, dental, and veterinary practitioners, including private practitioners, shall write prescriptions using the generic name. The brand name may be included if so desired."

"20. Moreover, Republic Act No. 5921, also known as Act Regulation the Practice of Pharmacy also requires that "No medicine, pharmaceutical, or drug of whatever nature and kind or device shall be compounded, dispensed, sold or resold, or otherwise be made available to the consuming public except through a prescription drugstore or hospital pharmacy, duly established in accordance with the provisions of this Act"<sup>4</sup> and that "Every pharmacy, drugstore or hospital pharmacy whether owned by the government or a private person or firm shall at all times when open for business be under the personal and immediate supervision of a registered pharmacist." These legal provisions further insure against possible confusion that Opposer claims to be guarding against.

"21. The mark 'OMIPRA' being distinct from or dissimilar to the generic name 'Omepron', the same cannot give rise to a cause of action in favor of Opposer much less to exclude Respondent-Applicant from the use of a separate and distinct mark 'OMIPRA'. Accordingly, Opposer cannot claim any damage by reason of Respondent-Applicant's continued use of the mark 'OMIPRA'.

"23. Lastly, comparison of packaging for 'OMIPRA' and 'Omepron' shows great variance further lessening any chance of confusion between said marks in actual commerce.

The Respondent-Applicant's evidence consists of a copy of its mark and a copy of a certificate of product registration in its favor issued by the Food and Drug Administration.

The Preliminary Conference was held and terminated on 22 February 2016. Only the Opposer filed its position paper on 03 March 2016. Thus, this case is deemed submitted for decision.

<sup>4</sup>

Section 25, R.A. No. 5921



Should the Respondent-Applicant be allowed to register the trademark "OMIPRA"?

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code which 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 if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 06 May 2014<sup>5</sup>, the Opposer has already an existing trademark registration for the mark OMEPRON bearing Registration No. 4-2004-010748 dated 28 August 2005<sup>6</sup> in the Philippines. It has also filed Declarations of Actual Use within 3 years from filing date<sup>7</sup>, and in the 5th year anniversary.<sup>8</sup>

Significantly, this Bureau noticed that the Respondent-Applicant's trademark application indicates that OMIPRA is or will be used as "proton pump inhibitor". Proton pump inhibitors (PPIs) are medicines that work by reducing the amount of stomach acid made by glands in the lining of your stomach. Proton pump inhibitors are used to: relieve symptoms of acid reflux, or gastroesophageal reflux disease (GERD), a condition in which food or liquid moves up from the stomach to the esophagus (the tube from the mouth to the stomach); treat a peptic or stomach ulcer; treat damage to the lower esophagus caused by acid reflux.<sup>9</sup> OMIPRA usage therefore, covers similar or closely related to those bearing the mark OMEPRON.

Nevertheless, it is unlikely that the co-existence of the marks will cause confusion, much less deception, among the public. The only similarities between the marks, as shown below,

The image shows the trademark "Omepron" in a bold, italicized, sans-serif font.

Opposer's trademark

The image shows the trademark "OMIPRA" in a bold, sans-serif font, enclosed within a light gray rectangular box.

Respondent-Applicant's trademark

are the first two letters "O" and "M"; and the letters contained in the suffixes "P" and "R".

In this regard, it appears that the "OMEPR" in Opposer's "OMEPRON" is not an accurate indicator of the existence of confusing similarity between the marks because the mentioned letters are common in drugs or medicine, over which the Opposer cannot claim exclusive rights. The "OMEPR" in "OMEPRON" is obviously derived from the substance "OMEPROZOLE". In fact, the Opposer's sample product packaging shows that "OMEPRON's" generic name is "OMEPRAZOLE".<sup>10</sup> It is a fair inference that "OMEPRON" is just a contraction of "OMEPRAZOLE".

<sup>5</sup> Filewrapper records.

<sup>6</sup> Exhibit "B" of Opposer.

<sup>7</sup> Exhibit "D" of Opposer.

<sup>8</sup> Exhibit "E" of Opposer.

<sup>9</sup> Proton Pump Inhibitors, Medline Plus. Available at <https://www.nlm.nih.gov/medlineplus/ency/patientinstructions/000381.htm> (last accessed 27 June 2016).

<sup>10</sup> Exhibit "F" of Opposer.

OMEPRON thus, is not highly distinctive as a trademark. At most, it is considered a suggestive mark, which is a weak mark. What will set apart or distinguish such mark from another mark which also includes the letters O, M, P and R, are the last two letters "ON" in Opposer's OMEPRON; and "RA" in Respondent-Applicant's OMEPRA. In this instant, it is very unlikely that a consumer will be misled or confused into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's.

The function of a trademark is to point out distinctly the origin or ownership of the goods to 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>11</sup> This Bureau finds the Respondent-Applicant's mark consistent with this function.

Moreover, taking into account that the similarity between the competing marks, sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive rights to use the "OMEPR" in Opposer's OMEPRON.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-00005462 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 30 JUN 2016

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

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<sup>11</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.