WESTMONT PHARMACEUTICALS, INC., Opposer, **-versus-** **SUHITAS PHARMACEUTICALS, INC.,** Respondent- Applicant.	}	**IPC No. 14-2013-00240** Opposition to: Appln. Serial No. 4-2012-0015057 Date Filed: 14 December 2012 **TM: "ESOPRA"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 249 dated July 14, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 14, 2016.

For the Director:

Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

SUHITAS PHARMACEUTICALS, INC.,
Respondent-Applicant.
x ---------- x

IPC No. 14-2013-00240
Opposition to Trademark
Application No. 4-2012-0015057
Date Filed: 14 December 2012
Trademark: **"ESOPRA"**

Decision No. 2016- 249

DECISION

Westmont Pharmaceuticals, Inc.[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-0015057. The contested application, filed by Suhitas Pharmaceuticals, Inc.[2] ("Respondent-Applicant"), covers the mark "ESOPRA" for use on *"pharmaceutical (antacid)"* under Class 05 of the International Classification of Goods[3].

The Opposer anchors its opposition on Section 123.1 (d) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "ESOPRA" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially that the said mark is applied for the same class and goods as that of its own registered mark "ESOPRON". In support of its opposition, the Opposer submitted a copy of the Respondent-Applicant's trademark application as published in the IPO E-Gazette and a certified true copy of Certificate of Registration No. 4-2010-008689 for the mark "ESOPRON".[4]

A Notice to Answer was issued and served upon the Respondent-Applicant on 15 July 2013. The latter, however, did not file an Answer. Thus, on 30 October 2013, the Hearing Officer issued Order No. 2013-1553 declaring the Respondent-Applicant in default and submitting the case for decision.

Records reveal that at the time the Respondent-Applicant filed the contested application on 14 December 2012, the Opposer already registered its mark "ESOPRON" under Certificate of Registration No. 4-2010-008689 issued on 09 August 2010. However, the Trademark Registry, which this Bureau may take judicial notice, reveals that the Opposer's Certificate of Registration No. 4-2010-008689 was

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[1] A domestic corporation, duly organized and existing under and by virtue of the laws of the Philippines, with office address at 4th Floor Bonaventure Plaza, Bldg., Ortigas Avenue, Greenhills, San Juan.
[2] With address at 3rd Floor Cebtrepoint Bldg., Pasong Tamo cor. Export Bank Drive, Makati City.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.
[4] Marked as Exhibits "A" and "B".

"removed from register for non-use". The Opposer filed another application for the same mark "ESOPRON" on 14 August 2013, which is eight months after the filing of the contested application.

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

> ***"Section 123.1. A mark cannot be registered if it:***
>
> ***(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; x x x"***

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:

ESOPRON	ESOPRA
Opposer's mark	*Respondent-Applicant's mark*

The marks are apparently similar with respect to the beginning letters "ESOPR". Since the Opposer's registration specifically indicates that "ESOPRON" is used for *"pharmaceutical preparation for the treatment of gerd, gastric ulcer, duodenal ulcer",* it can be inferred that these letters stemmed from *esomeprazole,* a medicine used to treat gastroesophageal reflux disease (GERD), a condition in which backward flow of acid from the stomach causes heartburn and possible injury of the esophagus (the tube between the throat and stomach). Esomeprazole is in a class of medications called proton pump inhibitors. It works by decreasing the amount of acid made in the stomach.[5]

A mark or brand name itself gives away or tells the consumers the goods or service and/or the kind, nature, use or purpose thereof. Succinctly, what easily comes to the mind one when one sees or hears a mark or brand name of antacid or

[5] https://www.nlm.nih.gov/medlineplus/druginfo/meds/a699054.html.

treatment for GERD wherein "ESOPR" is a part of is the very concept or idea of the goods. As such, the Opposer cannot claim exclusive use or protection on the mere fact that another trademark appropriates "ESOPR". The Supreme Court explained in Societe des Produits Nestle vs. Court of Appeals[6] that:

> ***"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 characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination."***

What will set apart or distinguish such mark from another which also includes the term "ESOPR" is the letters, syllable or words that come before or after the generic name. In this case, however, it appears that the Respondent-Applicant merely replaced the last letters "ON" in the Opposer's mark for "A". Overall, the competing marks bear resembling visual appearance, pronunciation and impression. 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 purchased as to cause him to purchase the one supposing it to be the other.[7]

Succinctly, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."[8] Thus, the consumers may have the notion that Opposer expanded business and manufactured

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[6] G.R. No. 112012, April 4, 2001.
[7] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, April 4, 2001.
[8] Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

a new product by the name "ESOPRA", which could be mistakenly assumed a derivative or variation of "ESOPRON".

Finally, it is emphasized that 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 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.[9] The Respondent-Applicant's trademark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-0015057 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 JUL 2016.

ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

[9] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.