



OFFICE OF THE DIRECTOR GENERAL

BIOMEDIS, INC.,
Opposer-Appellant,

Appeal No. 14-2013-0010

-versus-

IPC No. 14-2010-00320

Opposition to:

ASTRAZENECA AB,
Respondent-Appellee.

Application No. 4-2010-501033

Date Filed: 21 July 2010

Trademark: ASACLAV

X-----X

DECISION

BIOMEDIS, INC. (“Appellant”) appeals the decision¹ of the Director of the Bureau of Legal Affairs (“Director”) dismissing the Appellant’s opposition to the registration of the mark “ASACLAV” filed by ASTRAZENECA AB (“Appellee”).

Records show that the Appellee filed on 21 July 2010 Trademark Application No. 4-2010-501033 for ASACLAV for use on pharmaceutical preparations and substances. On 02 November 2010, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks. Subsequently, the Appellant filed a “VERIFIED OPPOSITION” dated 20 December 2010 claiming that it will be extremely damaged and prejudiced by the registration of ASACLAV.

The Appellant maintained that it owned and registered the mark “AMOCLAV”, and that ASACLAV so resembles this mark. The Appellant claimed that ASACLAV will likely cause confusion, mistake, and deception on the purchasing public considering that this mark is applied for the same class of goods as those of AMOCLAV. The Appellant asserted that it has extensively used AMOCLAV in commerce in the Philippines and has dutifully filed declaration of actual use and affidavit of use. The Appellant contended that the registration of ASACLAV will violate Sec. 123 of the Intellectual Property Code of the Philippines (“IP Code”) which provides in part that 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;

¹ Decision No. 2013-40 dated 25 February 2013.

The Appellee filed a "VERIFIED ANSWER" dated 03 June 2011 denying the material allegations by the Appellant in the opposition and maintained that ASACLAV and AMOCLAV are not confusingly similar and that these marks have striking differences that preclude the possibility of the purchasing public confusing the Appellant's products with those of the Appellee's. The Appellee claimed that its goods and those of the Appellant's are not identical and their respective purposes and intended uses are different. The Appellee asserted that since the goods of the Appellant and those of the Appellee are medicinal products, the margin of error in the acquisition of one product for the other product is remote because purchasers are more wary of the nature of the goods they are buying so that confusion or deception on the products is unlikely. Moreover, the Appellee averred that the word component "CLAV" is a generic term over which the Appellant cannot claim exclusive rights. The Appellee also argued that its use of ASACLAV will neither dilute nor indicate a connection between the Appellant's and its products and that it is in fact a global biopharmaceutical company with commercial presence in Europe, Africa, Asia and the Pacific, the Americas, and the Middle East and North Africa.

After the appropriate proceedings, the Director rendered the decision dismissing the opposition. The Director held that it is unlikely that the co-existence of the Appellant's and Appellee's marks will cause confusion much less deception, among the public. The Director ruled that the only similarities between the marks are the first letter "A" and the suffix "CLAV" which is not an accurate indicator of the existence of confusing similarity between the marks because the suffix is common in drugs or medicine over which the Appellant cannot claim exclusive rights.

Not satisfied with the ruling of the Director, the Appellant filed on 04 April 2013 an "APPEAL MEMORANDUM [Re: Decision No. 2013-40 dated 25 February 2013]" maintaining that the ruling of the Bureau of Legal Affairs that there is no confusing similarity between AMOCLAV and ASACLAV is contrary to law and settled jurisprudence.

This Office issued on 23 April 2013 an Order giving the Appellee thirty (30) days from receipt of the Order to submit comment on the appeal. The Appellee did not file its comment on the appeal and this case was deemed submitted for decision.

While this Office is drafting the decision on this appeal, it noticed in the records that there is no Declaration of Actual Use ("DAU") for ASACLAV. Accordingly, this Office clarified with the Bureau of Trademarks (BOT) the status of the trademark application for ASACLAV.² On 14 January 2014, the Bureau of Trademarks issued a certification that no DAU has been filed for ASACLAV.

In this regard, the Appellee's application to register the mark ASACLAV is considered refused for its failure to file the required DAU. Sec. 124.2 of the IP Code states that:

² Memorandum dated 09 January 2014.

124.2. The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director.

Consequently, this appeal is now deemed moot and academic and the Office need not decide this case on the merits. The Appellant in filing the opposition to the registration of ASACLAV seeks to prevent the registration of this mark in favor of the Appellee. However, in view of the certification issued by the BOT showing the Appellee's failure to file the DAU, the Appellant's plea for the refusal of the Appellee's trademark application was practically granted.

In one case, the Supreme Court of the Philippines has ruled that:

For a court to exercise its power of adjudication, there must be an actual case or controversy - one which involves a conflict of legal rights, an assertion of opposite legal claims susceptible of judicial resolution; the case must not be moot or academic or based on extra-legal or other similar considerations not cognizable by a court of justice. A case becomes moot and academic when its purpose has become stale, such as the case before us.³

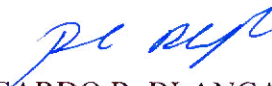
In this instance, no practical or useful purpose would be served by resolving the issues and merits in this case when the Appellant's trademark application is now considered refused. It is unnecessary to indulge in academic discussion of a case presenting a moot question as a judgment thereon cannot have any practical legal effect or, in the nature of things, cannot be enforced.⁴

Wherefore, premises considered, the appeal is hereby dismissed for the reasons discussed above.

Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs and the Bureau of Trademarks for their appropriate action and consideration of the Appellee's failure to file the required DAU. Further, let also the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this decision for information, guidance, and records purposes.

SO ORDERED.

11 FEB 2014 Taguig City.


RICARDO R. BLANCAFLOR
Director General

³ Dean Jose Joya, v. Presidential Commission on Good Government, G. R. No. 96541, 24 August 1993.

⁴ Gerardo O. Lanuza, Jr. v. Ma. Vivian Yuchengco, G.R. No. 157033, 28 March 2005.