



OFFICE OF THE DIRECTOR GENERAL

BIOMEDIS, INC.,  
Opposer-Appellant,

-versus-

SHEILA MAE VELILLA,  
Respondent-Appellee.

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Appeal No. 14-2013-0004

IPC No. 14-2011-00313

Opposition to:

Application No. 4-2011-000903

Date Filed: 27 January 2011

Trademark: PARAGESIC

DECISION

BIOMEDIS, INC. (“Appellant”) appeals the decision<sup>1</sup> of the Director of the Bureau of Legal Affairs (“Director”) dismissing the Appellant’s opposition to the registration of the mark “PARAGESIC” in favor of SHEILA MAE VELILLA (“Appellee”).

Records show that the Appellee filed on 27 January 2011 Trademark Application No. 4-2011-000903 seeking to register PARAGESIC for use on *pharmaceutical preparation analgesic and antipyretic drugs*. The trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks on 30 May 2011.

On 27 July 2011, the Appellant filed a “VERIFIED OPPOSITION” claiming that it will be extremely damaged and prejudiced by the registration of this mark which resembles the mark “BIOGESIC”. The Appellant alleged that it owned and registered BIOGESIC prior to the publication of PARAGESIC. The Appellant maintained that PARAGESIC which is owned by the Appellee will likely cause confusion, mistake and deception on the part of the purchasing public especially considering that this mark is applied for the same class of goods as that of BIOGESIC.

The Appellant maintained that the registration of PARAGESIC in the name of the Appellee will violate Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (“IP Code”) which provides that 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. The Appellant averred that the Appellee’s use and registration of PARAGESIC will diminish the distinctiveness and dilute the goodwill of BIOGESIC.

<sup>1</sup> Decision No. 2013-16 dated 28 January 2013

The Bureau of Legal Affairs (“BLA”) issued on 15 August 2011 a notice to the Appellee to answer the opposition. The Appellee, however, did not file an answer and after the appropriate proceedings, the Director issued the decision dismissing the Appellant’s opposition. The Director held that the Appellee’s mark start with the letters or syllables “PARA” which are different, visually and aurally, from “BIO” in the Appellant’s mark. The Director ruled that it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public.

Not satisfied with the decision, the Appellant filed on 28 February 2013 an “APPEAL MEMORANDUM [Re: Decision No. 2013-16 dated 28 January 2013]” maintaining that the ruling of the Director is contrary to law and settled jurisprudence. The Appellant maintains that PARAGESIC adopted the dominant features of its mark and that this mark is confusingly similar with BIOGESIC which will likely cause confusion, mistake, and deception to the purchasing public. The Appellant argues that as the lawful owner of BIOGESIC, it has the exclusive right to use and/or appropriate this mark, and that it is entitled to prevent the Appellee from using a confusingly similar mark in the course of trade where such would likely mislead the public.

This Office issued on 14 March 2013 an Order giving the Appellee thirty (30) days from receipt of the Order to submit her comment on the appeal. The Appellee did not file her comment and the case was deemed submitted for decision.

The relevant question in this case is whether the Director was correct in dismissing the Appellant’s opposition to the registration of PARAGESIC in favor of the Appellee.

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 PARAGESIC. Accordingly, this Office requested information from the Bureau of Trademarks on whether the required DAU for PARAGESIC was filed by the Appellee.<sup>2</sup> On 12 February 2014, the Bureau of Trademarks issued a certification that no DAU had been filed for PARAGESIC.

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

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 PARAGESIC seeks to prevent the registration of this mark in favor of

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<sup>2</sup> Memorandum dated 03 February 2014.

the Appellee. However, in view of the certification issued by the Bureau of Trademarks 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.<sup>3</sup>

In this instance, no practical or useful purpose would be served by resolving the issues and merits in this case when the Appellee'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.<sup>4</sup>

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.

MAR 11 2014 Taguig City.

  
RICARDO R. BLANCAFLOR  
Director General

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

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