



OFFICE OF THE DIRECTOR GENERAL

PEDIATRICA, INC.,

Opposer-Appellant,

-versus-

EASTMED PHARMACEUTICAL, INC.,

Respondent-Appellee.

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Appeal No. 14-2012-0021

Inter Partes Case No. 14-2010-00227

Opposition to:

Application No. 4-2010-002609

Date Filed: 09 March 2010

Trademark: GROWMAX

DECISION

PEDIATRICA, 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 “GROWMAX”.

Records show that on 09 March 2010, EASTMED PHARMACEUTICAL, INC. (“Appellee”) filed Trademark Application No. 4-2010-002609 seeking to register GROWMAX for use on food supplement. On 06 September 2010, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks. On 06 October 2010, the Appellant filed a “VERIFIED OPPOSITION” claiming that it will be extremely damaged and prejudiced by the registration of GROWMAX. The Appellant cited the following grounds for opposition:

1. GROWMAX resembles the trademark “GROWEE” owned by the Appellant;
2. GROWMAX will likely cause confusion, mistake, and deception on the part of the purchasing public, most especially considering that GROWMAX is applied for the same class of goods as GROWEE;
3. The registration of GROWMAX will violate Sec. 123 of Republic Act 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; and

¹ Decision No. 2012-70 dated 18 April 2012.

4. The Appellee's use and registration of GROWMAX will diminish the distinctiveness and dilute the goodwill of the Appellant's GROWEE.

The Appellant maintained that it is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of GROWEE. It has extensively used GROWEE in commerce and in the Philippines and has secured a Certificate of Product Registration for GROWEE from the Bureau of Food and Drugs. The Appellant contended that GROWMAX so resembles GROWEE that it will likely cause confusion, mistake and deception on the part of the purchasing public. The Appellant argued that to allow the Appellee to market products bearing GROWMAX undermines its rights, and as the owner of GROWEE, it is entitled to prevent the Appellant from using a confusingly similar mark in the course of trade which would likely mislead the public.

The Appellant submitted a printout of the trademarks published for opposition in the Electronics Gazette on 06 September 2010,² copies of the certificates of registration for GROWEE³, declaration of actual use⁴ and product label for GROWEE.⁵

On 01 December 2010, the Appellee filed an "ANSWER TO VERIFIED OPPOSITION" denying the material allegations in the opposition and maintained that GROWMAX is not confusingly similar with GROWEE.

The Appellee's evidence consists of the printout of the trademarks published in the Electronics Gazette on 06 September 2010,⁶ product and packaging labels for GROWMAX⁷ and certificate of product registration issued by the Bureau of Food and Drugs for GROWMAX.⁸

After the appropriate proceedings, the Director dismissed the opposition and held that there is a fine distinction between the competing marks as to sound and appearance such that confusion or deception is unlikely to occur. The Director ruled that GROWMAX satisfies the function of a trademark.

Not satisfied with the decision of the Director, the Appellant filed on 28 May 2012 an "APPEAL MEMORANDUM" citing the following assignment of errors:

² Annex "A".

³ Annexes "B" and "E".

⁴ Annex "C".

⁵ Annex "D".

⁶ Annex "1".

⁷ Annexes "2" and "3".

⁸ Annex "4".

A.

THE HONORABLE DIRECTOR OF BUREAU OF LEGAL AFFAIRS
GRAVELY ERRED IN RULING THAT THERE IS NO CONFUSING
SIMILARITY BETWEEN THE APPELLEE'S MARK "GROWMAX"
AND APPELLANT'S MARK "GROWEE"

B.

THE HONORABLE DIRECTOR OF BUREAU OF LEGAL AFFAIRS
GRAVELY ERRED IN GIVING DUE COURSE TO APPELLEE'S
TRADEMARK APPLICATION FOR THE MARK "GROWMAX".

The Appellant maintains that GROWMAX is confusingly similar to GROWEE visually and aurally. The Appellant claims that the Appellee adopted the dominant features of its mark removing only the suffix "EE" and substituting it with the word "MAX". The Appellant avers that in this case, the goods involve are both medicines under the same class and for the same purpose of providing vitamins for children. The Appellant also argues that the confusion is not only as to the goods but there is also confusion of business that warrants the denial of the registration of GROWMAX in favor of the Appellee.

According to the Appellant, being the owner of GROWEE, it has the exclusive right to use and/or appropriate this mark and prevent all third parties not having its consent from using in the course of trade, identical or similar marks, where such use would result in a likelihood of confusion. The Appellant asserts that as between the Appellee, a newcomer, and the Appellant, the first user and actual owner of GROWEE, any doubt should be resolved against the Appellee. The Appellant contends that the Appellee as the latter entrant in the market loses nothing and gains patronage unjustly by the association of its products bearing GROWMAX with GROWEE, which is well-known. Moreover, the Appellant maintains that because of its substantial investment of time and resources and by honest dealing, it has already achieved favor with the public and already possesses goodwill. The Appellant claims that the Appellee had a vast range of marks to choose from which would sufficiently distinguish its products from those existing in the market.

This Office issued on 29 June 2012 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 GROWMAX. Accordingly, this Office clarified with the Bureau of Trademarks the status of the trademark application.

On 18 October 2013, the Bureau of Trademarks issued a certification that no DAU has been filed for GROWMAX.

In this regard, the Appellee's application to register the mark GROWMAX is considered refused for its 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 GROWMAX seeks to prevent the registration of this mark in favor of 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.⁹

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.¹⁰

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

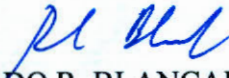
Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs and the Bureau of Trademarks for their appropriate action and consideration of the Appellee's failure to file the required DAU. Further, let also the library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

⁹ Dean Jose Joya, v. Presidential Commission on Good Government, G. R. No. 96541, 24 August 1993.

¹⁰ Gerardo O. Lanuza, Jr. v. Ma. Vivian Yuchengco, G.R. No. 157033, 28 March 2005.

SO ORDERED.

NOV 18 2013 Taguig City.



RICARDO R. BLANCAFLOR
Director General