



OFFICE OF THE DIRECTOR GENERAL

THERAPHARMA, INC.,
Opposer-Appellant,

-versus-

D. B. MANIX INTERNATIONAL
CORPORATION,
Respondent-Appellee.

X-----X

Appeal No. 14-2012-0006

IPC No. 14-2010-00318

Opposition to:

Application No. 4-2010-007777

Date Filed: 16 July 2010

Trademark: CHOLEFEN

DECISION

THERAPHARMA, 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 “CHOLEFEN”.

Records show that D. B. MANIX INTERNATIONAL CORPORATION (“Appellee”) filed on 16 July 2010 Trademark Application No. 4-2010-007777 for CHOLEFEN for use on *pharmaceutical product, namely, dyslipidaemic agent for treatment of very high elevations of serum triglyceride levels*. On 18 October 2010, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks.

On 17 December 2010, the Appellant filed a “VERIFIED OPPOSITION” claiming that it will be extremely damaged and prejudiced by the registration of CHOLEFEN. The Appellant maintained that CHOLEFEN resembles “CHOLINERV” which it owned and duly registered prior to the publication of CHOLEFEN. According to the Appellant, CHOLEFEN will likely cause confusion, mistake, and deception on the part of the purchasing public, most especially considering that this mark is applied for the same class and goods as that of CHOLINERV. The Appellant contended that the registration of CHOLEFEN will violate Sec. 123 of the Intellectual Property Code of the Philippines (“IP Code”) which provides that a mark that 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.

On 07 April 2011, the Bureau of Legal Affairs issued Order No. 2011-457 giving the Appellee until 15 April 2011 to file its answer to the Appellant’s opposition. The Appellee did not file an answer and the case was deemed submitted for decision. Subsequently, the Director issued the decision dismissing the opposition

¹ Decision No. 2012-20 dated 09 February 2012.

and holding that CHOLINERV and CHOLEFEN are not identical marks and that the resemblance between these marks is not sufficient to cause a likelihood of confusion or deception. The Director held that the goods covered by CHOLINERV are different from those covered by CHOLEFEN and that CHOLEFEN satisfied the function of a trademark.

Not satisfied, the Appellant filed an “APPEAL MEMORANDUM [Re: Decision No. 2012-20 dated 9 February 2012]” assigning the following error:

“V. ASSIGNMENT OF ERROR

THE RULING OF THE HONORABLE BUREAU OF LEGAL AFFAIRS IN THE QUESTIONED DECISION THAT THERE IS NO CONFUSING SIMILARITY BETWEEN THE OPPOSER-APPELLANT’S TRADEMARK “CHOLINERV” AND RESPONDENT-APPELLEE’S MARK “CHOLEFEN” IS CONTRARY TO LAW AND SETTLED JURISPRUDENCE.”

The Appellant argues that CHOLEFEN is confusingly similar with CHOLINERV and reiterates its position that CHOLEFEN will likely cause confusion, mistake, and deception on the part of the purchasing public. The Appellant claims that CHOLEFEN adopted the dominant features of CHOLINERV and that these marks are practically identical marks in sound and appearance that they leave the same commercial impression upon the public. The Appellant claims that as the lawful owner of the mark CHOLINERV, 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 that would result in a likelihood of confusion.

The Appellant further argues that even if the goods covered by both marks are different, there is still likelihood of confusion as to the business reputation or goodwill between the Appellant and the Appellee. According to the Appellant, by virtue of its prior and continued use of CHOLINERV, this mark has become well-known and has established valuable goodwill to the consumers and the general public as well. The Appellant asserts that the registration of CHOLEFEN will enable the Appellee to obtain benefit from the Appellant’s reputation and goodwill and will tend to deceive and/or confuse the public into believing that the Appellee is in any way connected with the Appellant.

This Office issued on 13 April 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 and the 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 CHOLEFEN. Accordingly, this Office clarified with the Bureau of Trademarks the status of the trademark application including the filing, if any, of the DAU.²

² Memorandum dated 21 January 2014.

On 23 January 2014, the Bureau of Trademarks issued a certification that no DAU has been filed for CHOLEFEN. In this regard, the Appellee's application to register the mark CHOLEFEN 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 CHOLEFEN 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.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.

MAR 24 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.