



OFFICE OF THE DIRECTOR GENERAL

THERAPHARMA, INC.,
Opposer-Appellant,

-versus-

DKSH INTERNATIONAL, AG,
Respondent-Appellee.

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Appeal No. 14-2012-0020

IPC No. 14-2010-00322

Opposition to:

Application No. 4-2010-001429

Date Filed: 09 February 2010

Trademark: COMBIZYM

DECISION

THERAPHARMA, INC. (“Appellant”) appeals the decision of the Director of the Bureau of Legal Affairs (“Director”) denying the Appellant’s opposition to the registration of the mark “COMBIZYM”.

Records show that DKSH International, AG (“Appellee”) filed on 09 February 2010 Trademark Application No. 4-2010-001429 for the registration of the mark COMBIZYM for use on pharmaceutical preparations for the treatment of digestive disorders. On 26 October 2010, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks.

On 20 December 2010, the Appellant filed a “VERIFIED OPPOSITION” stating that it is engaged in the marketing and sale of a wide range of pharmaceutical products and that it will be damaged by the registration of COMBIZYM which is confusingly similar to “COMBIZAR”. The Appellant claimed that it filed on 09 December 2004 an application to register COMBIZAR and that COMBIZYM adopted the dominant features of this mark. According to the Appellant, the two marks can easily be confused for one over the other, most especially considering that COMBIZYM is applied for the same class of goods as that of COMBIZAR.

The Appellant submitted the following evidence to support the opposition:

1. Printout of the publication in the Electronics Gazette for Trademarks;¹
2. Acknowledgment of the receipt of the Appellant’s trademark application for COMBIZAR;²
3. Notice of Allowance and Payment of Publication Fee;³
4. Declaration of Actual Use;⁴

¹Exhibits “A” to “A-1”.

²Exhibit “B”.

³Exhibit “C”.

⁴Exhibit “D”.

5. Sample packaging material for COMBIZAR;⁵
6. Certification dated 04 November 2010;⁶ and
7. Certificate of Product Registration.⁷

The Bureau of Legal Affairs issued a notice to the Appellee directing it to answer the petition. The Appellee did not file an answer and the case was deemed submitted for decision.

On 30 March 2012, the Director issued the decision denying the Appellant's opposition to the registration of COMBIZYM in the name of the Appellee. The Director held that confusion or deception is unlikely to occur in this case. According to the Director, the only similarity between the competing marks is the prefix "COMBI" and that there are several trademarks registered containing this prefix. The Director ruled that for pharmaceutical products or drugs, the prefix "COMBI" is utilized as part of the brand or trademark to indicate that the product is a combination of drugs or medications. The Director found COMBIZYM as serving the purpose of registering a trademark.

On 11 May 2012, the Appellant filed an "APPEAL MEMORANDUM [Re: Decision No. 2012-60 dated 30 March 2012]" contending that the ruling of the Bureau of Legal Affairs that there is no confusing similarity between COMBIZAR and COMBIZYM is contrary to law and settled jurisprudence. The Appellant asserts that COMBIZYM is confusingly similar with COMBIZAR. The Appellant maintains that COMBIZYM so resembles COMBIZAR which will likely cause confusion, mistake, and deception on the part of the purchasing public. The Appellant claims that even if the goods covered by the marks are different, the Appellee's use of COMBIZYM would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the Appellee's products originate from or is being manufactured by the Appellant, or at the very least, is connected or associated with the products of the Appellant.

This Office issued on 22 May 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 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 COMBIZYM. Accordingly, this Office clarified with the Bureau of Trademarks the status of the trademark application. On 17 October 2013, the Bureau of Trademarks issued a certification that no DAU has been filed for COMBIZYM.

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

⁵ Exhibit "E".

⁶ Exhibit "F".

⁷ Exhibit "G".

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 COMBIZYM 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.⁸


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.⁹

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.

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RICARDO R. BLANCAFLOR
Director General

⁸ Dean Jose Joya, v. Presidential Commission on Good Government, G. R. No. 96541, 24 August 1993.

⁹ Gerardo O. Lanuza, Jr. v. Ma. Vivian Yuchengco, G.R. No. 157033, 28 March 2005.