OFFICE OF THE DIRECTOR GENERAL

UNITED LABORATORIES, INC.,
Opposer-Appellant,

-versus-

JOEL C. NG,
Respondent-Appellee.
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Appeal No. 14-2013-0026

IPC No. 14-2010-00073
Opposition to:
Application No. 4-2009-007264
Date Filed: 22 July 2009
Trademark: BIOGEL

DECISION

UNITED LABORATORIES, INC. ("Appellant") appeals the decision[1] of the Director of Bureau of Legal Affairs ("Director") dismissing the Appellant's opposition to the registration of the mark "BIOGEL".

Records show that JOEL C. NG ("Appellee") filed on 22 July 2009 an application to register BIOGEL for use on hand sanitizer gel. The trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks on 21 December 2009. On 22 March 2010, the Appellant filed a "VERIFIED OPPOSITION" claiming that it will be extremely damaged and prejudiced by the registration of BIOGEL.

The Appellant maintained that BIOGEL resembles the marks "BIOGENIC" and "BIOGESIC" which it has registered prior to the publication of BIOGEL. The Appellant alleged that BIOGEL will likely cause confusion, mistake and deception on the part of the purchasing public, most especially as this mark is applied for the same class and goods as BIOGENIC and BIOGESIC. The Appellant averred that the registration of BIOGEL will violate Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code') which provides that a 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 asserted that the Appellee's use and registration of BIOGEL will diminish the distinctiveness and dilute the goodwill of BIOGENIC and BIOGESIC.

On 14 April 2010, the Bureau of Legal Affairs ("BLA") issued a notice to the Appellee directing him to file a verified answer to the Appellant's opposition. The Appellee, however, did not file an answer. Subsequently, the Director issued the decision dismissing the opposition. The Director held that it is unlikely that the co-

[1] Decision No. 2013-96 dated 31 May 2013.

existence of the mark BIOGEL with BIOGENIC and BIOGESIC will cause confusion, much less deception. According to the Director, the letters or syllable that follows the prefix "BIO" in the Appellee's mark can easily be distinguished from the Appellant's marks. The Director held that the last syllable in the Appellee's mark, which is "GEL" has visual and aural properties that are distinct from the syllables "GENIC" and "GESIC".

Not satisfied, the Appellant filed on 03 July 2013 an "APPEAL MEMORANDUM [Re: Decision No. 2013-96 dated 31 May 2013]" contending that BIOGEL is confusingly similar with BIOGENIC and BIOGESIC. The Appellant argues that the BLA cannot isolate the suffix "BIO" and solely use it as reference in determining whether or not the marks are confusingly similar. The Appellant maintains that BIOGENIC and BIOGESIC are coined marks and the BLA should have compared these marks in their entirety as against BIOGEL. The Appellant claims that BIOGEL 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 BIOGENIC and BIOGESIC and that BIOGEL and BIOGENIC are both used for hand sanitizer. The Appellant further argues that the Appellee failed to file its answer to the opposition and, thus, the Appellee should have been considered to have abandoned its application to register BIOGEL.

This Office issued on 08 July 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 his 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 BIOGEL. Accordingly, this Office requested information from the Bureau of Trademarks (BOT) on whether the Appellee filed a DAU for BIOGEL.[2] On 12 February 2014, the BOT issued a certification that no DAU has been filed for BIOGEL.

In this regard, the Appellee's application to register the mark BIOGEL 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 BIOGEL 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.

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[2] Memorandum dated 12 February 2014.

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 2 4 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.