



BIOMEDIS INC.,  
Opposer,

-versus-

MUNDIPHARMA AG,  
Respondent -Applicant.

}  
} IPC No. 14-2012-00520  
} Opposition to:  
} Appln. Serial No. 4-2012-008759  
} Date Filed: 18 July 2012  
} TM: "EXELGESIC"  
}

x-----x

### NOTICE OF DECISION

**OCHAVE & ESCALONA**  
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Mandaluyong City

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Bonifacio Global City  
Taguig City

#### GREETINGS:

Please be informed that Decision No. 2014 - 74 dated March 18, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 18, 2014.

For the Director:

**Atty. PAUSI U. SAPAK**  
Bureau of Legal Affairs



BIOMEDIS INC.,	}	IPC No. 14-2012-00520
<i>Opposer,</i>	}	Opposition to:
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-versus-	}	Appln. Serial No. 4-2012-008759
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<i>Respondent-Applicant.</i>	}	
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## DECISION

BIOMEDIS INC. ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-008759. The application, filed by MUNDIPHARMA AG ("Respondent-Applicant")<sup>2</sup>, covers the mark "EXELGESIC" for use on analgesic preparations under Class 5 of the International Classification of Goods and Services.<sup>3</sup>

A perusal of the instant opposition shows that it is anchored on Section 123.1 (d) of Rep. Act No. 8293, also known as Intellectual Property Code of the Philippines ("IP Code") which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

To support its opposition, the Opposer submitted as evidence the following:

1. Exhibits "A" to "A-1" – copies of the pertinent pages of the IPO E-Gazette;
2. Exhibit "B" – certified true copies of the Certificate of Reg. No. 12196 for the mark "BIOGESIC";
3. Exhibit "C" – certified true copies of the Certificate of Renewal of Reg. No. 12196 for the mark "BIOGESIC";
4. Exhibits "D", "E", "F" and "G" – certified true copies of the Affidavit of Use;
5. Exhibit "H" – sample product label bearing the trademark "BIOGESIC";
6. Exhibit "I" – copy of the certification and sales performance; and
7. Exhibit "J" – certified true copies of the Certificate of Product Registration issued by the Bureau of Food and Drugs (BFAD).

<sup>1</sup> A domestic corporation duly organized and existing under the laws of the Philippines, with office address at Dynavision, 108 Rada Street, Legaspi Village, Makati City, Philippines.

<sup>2</sup> A foreign corporation with office address at St. Alban-Rheinweg 74, Ch-4020 Basel, Switzerland.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 18 January 2013. However, the Respondent-Applicant did not file an answer. Thus the Hearing Officer issued Order No. 2013-1124 on 12 August 2013 declaring the Respondent-Applicant in default and the instant opposition deemed submitted for decision.

Should the Respondent-Applicant's trademark application be allowed?

Records show that at the time the Respondent-Applicant filed its trademark application on 18 July 2012, the Opposer already has an existing trademark registration for the mark "BIOGESIC" bearing Reg. No. 12196 issued on 24 March 1966 and renewed on 24 March 2006.

But are the competing marks depicted below, confusingly similar?

**BIOGESIC**

**EXELGESIC**

*Opposer's Mark*

*Respondent-Applicant's Mark*

Both marks end with the suffix "GESIC" which is derived from the word "analgesic" or pain reliever. The pharmaceutical products covered by the Opposer's trademark registration and the Respondent-Applicant's trademark application are "analgesic" or pain relievers.<sup>4</sup> A trademark that ends with the suffix "GESIC" and is used on "analgesic" is therefore suggestive mark, which is a weak mark. The mark or brand name itself gives away or tells the consumers the goods or services, and/or the kind, nature, use or purpose thereof. The opposition therefore cannot be sustained solely on account of the marks having the same suffix ("GESIC") because to do so would have the unintended effect of giving the Opposer practically the exclusive right to use "GESIC" which obviously refer to "analgesic". The focus of comparison must be on the letters and/or syllables that precede "GESIC".<sup>5</sup>

In the instant opposition, the Opposer's mark the suffix "GESIC" is combined with the prefix "BIO". On the other hand, "GESIC" in the Respondent-Applicant's mark follows the letters or syllables "EXEL". "BIO" is practically and entirely distinct and different from "EXEL", both in composition, spelling, and sound as well as in meaning.

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his products.<sup>6</sup> This Bureau finds that the Respondent-Applicant's mark satisfies this function.

<sup>4</sup> Exhibit "J" for the Opposer and content of the filewrapper of Trademark Application Serial No. 4-2012-008759.

<sup>5</sup> This has been thoroughly discussed in the Decision of the Bureau of Legal Affairs, Decision No. 2013-53 dated 25 March 2013 in IPC No. 14-2011-00248 Biomedis Inc. v. Littman Drug Corp.

<sup>6</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

**WHEREFORE**, premises considered the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-008759 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 18 March 2014.

  
**Atty. NATHANIEL S. AREVALO**  
*Director IV, Bureau of Legal Affairs*

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