



BIOMEDIS, INC.,
Opposer,

-versus-

ASTRAZENECA AB,
Respondent-Applicant.

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} **IPC No. 14-2010-00320**
} Opposition to:
} Appln. Serial No. 4-2009-501033
} Date filed: 21 July 2010
} TM: "ASACLAV"
}
}
}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 40 dated February 25, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 25, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



BIOMEDIS INC.,

Opposer,

- Versus -

ASTRAZENECA AB,

Respondent-Applicant.

x-----x

IPC No. 14-2010-00320

Opposition to:

Appln. Serial No. 4-2010-501033

(Filing Date: 21 July 2010)

TM: "ASACLAV"

Decision No. 2013- 40

DECISION

BIOMEDIS INC. ("Opposer")¹ filed on 20 December 2010 an opposition to Trademark Application Serial No. 4-2010-501033. The application, filed by ASTRAZENECA AB ("Respondent-Applicant")², covers the mark "ASACLAV" for use on "*pharmaceutical preparation and substances*" under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges, among other things, that the mark ASACLAV so resembles its registered mark "AMOCLAV". According to the Opposer, registration of the mark ASACLAV in favor of the Respondent-Applicant will violate Section 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer also contends that the Respondent-Applicant's use and registration of ASACLAV will take advantage of, dilute and diminish the distinctive character or reputation of AMOCLAV.

To support its opposition, the Opposer submitted as evidence a printout of page 4 of the "IPO E-Gazette" with releasing date of 02 November 2010 and other documents relating to the mark AMOCLAV, particularly, copies of Cert. of Reg. No. 4-1999-003627 (issued on 01 July 2005), affidavit of use/copies of affidavit of use, sample product label, and copy of the certificate of product registration issued by the Bureau of Food and Drugs.⁴

On 03 June 2011, the Respondent-Applicant filed its Answer, alleging among other things, that ASACLAV is not confusingly similar to AMOCLAV. It also argues that the suffix "CLAV" is not an accurate indicator of the existence of confusing similarity between the marks because the suffix is common in drugs, a generic term over which the Opposer cannot claim exclusive rights. The Respondent-Applicant submitted as evidence a copy of Cert. of Reg. No. 4-1999-003627 and printouts of pages of various websites featuring drugs available in the market which utilizes the suffix "CLAV"⁵.

The case was referred to mediation pursuant to Office Order No. 154, s. 2010. The

¹ A corporation duly organized and existing under the laws of Philippines with principal office address at 108 Rada St., Legaspi Village, Makati City.

² With address at SE-151 85 Sodertalje, Sweden.

³ 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.

⁴ Marked as Exhibits "A" to "G", inclusive.

⁵ Marked as Annexes "1" to "5".

parties, however, failed to reach an amicable settlement. Accordingly, the Hearing Officer conducted the preliminary conference. Then after, the Respondent-Applicant filed its Position Paper on 26 October 2011, while the Opposer did so the next day.

Should the Respondent-Applicant trademark application be allowed?

A perusal of the instant opposition shows that it is anchored on Sec. 123.1, paragraph (d), of the 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.

The records and evidence shows that at the time the Respondent-Applicant filed its trademark application on 21 July 2010, the Opposer has already an existing trademark registration for AMOCLAV bearing Reg. No. 4-1999-003627 issued on 01 July 2005. This registration covers "*medicinal preparation for use as antibacterial*" under Class 5. Significantly, this Bureau noticed that the Respondent-Applicant's trademark application indicates that ASACLAV is or will be used on "*pharmaceutical preparations and substances*". ASACLAV usage therefore, covers pharmaceutical products that are similar or closely related to those bearing the mark AMOCLAV.

Nevertheless, it is unlikely that the co-existence of the marks will cause confusion, much less deception, among the public. The only similarities between the marks, as shown below,

AmoClav

ASACLAV

Opposer's mark

Respondent-Applicant's mark

are the first letter "A" and the suffix "CLAV".

In this regard, this Bureau finds merit in the Respondent-Applicant's assertion that the suffix "CLAV" is not an accurate indicator of the existence of confusing similarity between the marks because the suffix is common in drugs or medicine, over which the Opposer cannot claim exclusive rights⁶. The suffix "CLAV" is obviously derived from the substance "*clavulanic acid*". In fact, the Opposer's sample product packaging shows that AMOCLAV's generic name is "CO-AMOXICLAV, its formulation consisting of "*amoxicillin*" and "*clavulanic acid*"⁷. It is a fair inference that AMOCLAV is just a contraction of "AMOXICLAV" and/or combination of "AMO" (from "*amoxicillin*") and "Clav" (from "*clavulanic acid*").

AMOXICLAV thus, is not highly distinctive as a trademark. At most, it is considered a suggestive mark, which is a weak mark. What will set apart or distinguish such mark from another mark which also includes the same suffix, are the letters and/or syllables that precede "CLAV". In this instant, it is very unlikely that a consumer will be misled or confused into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's. The Respondent-Applicant's mark start with the letters or syllables "ASA" which are so much different, visually and aurally, from "AMO" in the

⁶ See Verified Answer, par. 13 (pp. 6-7).

⁷ Exhibit "E".

Opposer's mark.

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 product.⁸ This Bureau finds the Respondent-Applicant's mark consistent with this function.

Moreover, taking into account that the similarity between the competing marks is the suffix "CLAV", sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive right to use "CLAV".

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-501033 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 February 2013.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs



⁸ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.