



BIOMEDIS, INC.,
Opposer,

-versus-

LITTMAN DRUG CORPORATION,
Respondent-Applicant.

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} IPC No. 14-2011-00248
} Opposition to:
} Appln. Serial No. 4-2010-013251
} Date Filed: 07 December 2010
} TM: "BEGESIC"

NOTICE OF DECISION

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Mandaluyong City


LITTMAN DRUG CORPORATION
Respondent-Applicant
Unit 810 West Tower, Philippine Stock Exchange Centre
Exchange Road, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2013 - 53 dated March 25, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 25, 2013.

For the Director:


ATTY. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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- Versus -

IPC No. 14-2011-00248

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TM: "BEGESIC"

LITTMAN DRUG CORPORATION,

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Decision No. 2013- 53

DECISION

BIOMEDIS INC. ("Opposer")¹ filed on 27 July 2011 an opposition to Trademark Application Serial No. 4-2010-013251. The application, filed by LITTMAN DRUG CORPORATION ("Respondent-Applicant")², covers the mark "BEGESIC" for use on "*pharmaceutical preparations, namely, a topically-applied pain relieving cream that are made up of methyl salicylate and menthol, that is greaseless, non-staining and with pleasant smell*" under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges, among other things, that the mark BEGESIC so resembles its registered mark "BIOGESIC". According to the Opposer, registration of the mark BEGESIC 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 BEGESIC will diminish the distinctiveness and dilute the goodwill of BIOGESIC.

To support its opposition, the Opposer submitted as evidence a printout of page 4 of the "IPO E-Gazette" with releasing date of 30 May 2011 and other documents relating to the mark BIOGESIC, particularly, copies of Cert. of Reg. No. 12196 and the certificate of renewal registration, affidavit of use/copies of affidavit of use, sample product label, sales data, and copy of the certificate of product registration issued by the Bureau of Food and Drugs.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 18 July 2011. The Respondent-Applicant was required to file its Answer thirty (30) days from receipt of the notice, that is, until 17 August 2011. On 18 August 2011, the Respondent-Applicant filed a letter, which was in advertently dated as "18 August 2010", requesting an extension of the period to file the answer. This Bureau noticed that the request for extension was filed out of time. Moreover, the Respondent-Applicant did not also file the answer.

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 Unit 810 West Tower, Phil. Stock Exchange Centre, Exchange Road, Ortigas Center, Pasig City.

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 Annexes "A" to "K".

A perusal of the instant opposition shows that it is anchored on Section 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 her trademark application on 27 January 2011, the Opposer has already an existing trademark Registration for the mark BIOGESIC bearing Reg. No. 12196 issued on 24 March 1966 and renewed on 24 March 2006. Nevertheless, this Bureau finds that it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public.

The marks both start with the letter "B" and end with the suffix "GESIC". In this regard, there is sufficient reason to infer and conclude that "GESIC" 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.⁵ A trademark that ends with the suffix "GESIC" and is used on "*analgesic*" is therefore a suggestive mark, which is a weak mark. The mark or brand name itself gives away or tells the consumers the goods or service, 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".

In 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 syllable "BE". "BIO" is visually different from "BE". The straight vertical line and the sphere representing the letters "I" and "O", contrast with the vertical and horizontal lines comprising the letter "E". "BIO" also sounds different from "BE". "BIO" is pronounced as "*bay-o*", while "BE" simply sounds "*beh*".

That confusion, much less deception, is unlikely in this instant is highlighted by the fact that while the parties' respective products are both "*analgesic*", these goods differ in composition and in the nature of use or application. BIOGESIC represents a drug or medicine which is taken orally while the mark BEGESIC is used on a pharmaceutical product which is a topical application, hence, for external use. The consumers can easily see the difference between the products considering that BIOGESIC is not only an "*analgesic*" but also "*antipyretic drugs*" (fever reducers).

Succinctly, 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.⁶ This Bureau finds the Respondent-Applicant's mark consistent with this function.

⁵ See Exhibit "I" for the Opposer and the contents of the filewrapper of Trademark Application Serial No. 4-2010-013251.

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-013251 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 March 2013.



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