



BIOMEDIS INC.,

Opposer,

IPC No. 14-2011-00056

Opposition to:

- Versus -

Appln. Serial No. 4-2010-010118
(Filing Date: 16 September 2010)
TM: "MILGESIC"

LUMAR PHARMACEUTICAL
LABORATORY,

Respondent-Applicant.

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Decision No. 2013- 51

DECISION

BIOMEDIS INC. ("Opposer")¹ filed on 18 February 2011 an opposition to Trademark Application Serial No. 4-2010-010118. The application, filed by LUMAR PHARMACEUTICAL LABORATORY ("Respondent-Applicant")², covers the mark "MILGESIC" for use on "*analgesic; antipyretic; paracetamol preparations*" under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges, among other things, that the mark MILGESIC so resembles its registered mark "BIOGESIC". According to the Opposer, registration of the mark MILGESIC 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 MILGESIC 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 20 December 2010 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

The Respondent-Applicant filed its Verified Answer on 26 May 2011 via registered mail. In its Answer, the Respondent-Applicant alleges among other things that by comparison, MILGESIC is not confusingly similar to BIOGESIC.⁵

The Hearing Officer issued on 16 June 2011 Order No. 2011-202 referring the instant case to mediation pursuant to Office Order No. 154, s. 2010⁶. The parties, however, failed to

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 No. 5 First Bulacan Industrial City, Tikay, Malolos 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 "J".
5 On 11 August 2011, the Respondent-Applicant filed a Motion to Admit Answer with Annexes, submitting sample product labels bearing the mark MILGESIC.
6 The rules on mediation.

come into an amicable settlement. Accordingly, the Hearing Officer conducted the preliminary conference and then after, the Respondent-Applicant filed on 14 November 2011 its position paper.

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 its trademark application on 16 September 2010, 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. This registration covers "*medicinal preparation composed of paracetamol and ascorbic acid*" under Class 5. Significantly, "*paracetamol*" is a kind of "*analgesic*" (pain relievers) and "*antipyretic drugs*" (fever reducers).⁷ Hence, the competing marks are used on similar or closely goods.

Nevertheless, it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public. The only similarity between BIOGESIC and MILGESIC is the suffix "GESIC". In this regard, there is sufficient reason to infer and conclude that "GESIC" is derived from the word "*analgesic*" which is, as mentioned above, the kind of pharmaceutical product covered by the Opposer's trademark registration and the Respondent-Applicant's trademark application. A trademark that ends with the suffix "GESIC" and is used on *analgesics* 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.

Succinctly, what easily comes to the mind when one sees or hears a mark or brand name for *paracetamol* or *analgesics* of which the suffix "GESIC" is a part of the very concept or idea of the goods. What will set apart or distinguish such mark from another mark which also includes the same suffix and used on *paracetamols* and *analgesics*, are letters and/or syllables that precede "GESIC". 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 syllable "MIL" which is so much different, visually and aurally, from "BIO" in the 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 only similarity between the competing marks is the suffix "GESIC", sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive right to use "GESIC", which evidently and sufficiently describes the pharmaceutical goods involved, i.e. *analgesics*.

⁷ Ref: en.wikipedia.org/wiki/Paracetamol; www.virtualmedicalcentre.com; www.pharmweb.net/.../paracetamol/pharmweb; www.patient.co.uk › Medicines & Drugs ;

⁸ *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. 4-2010-010118 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 March 2013.



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