



BIOMEDIS, INC.,
Opposer,

-versus-

RECKITT BENSICKER HEALTHCARE
(UK) LIMITED,
Respondent-Applicant.

}
} IPC No. 14-2011-00158
} Opposition to:
} Appln. Serial No. 4-2010-501802
} Date filed: 08 December 2010
} TM: "TEMGESIC"
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NOTICE OF DECISION

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**ORTEGA DEL CASTILLO BACORRO
ODULIO CALMA & CARBONELL**
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Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 126 dated July 11, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 11, 2013.

For the Director:

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



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Opposer,

IPC No. 14-2011-00158

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(UK) LIMITED,
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TM: "TEMGESIC"

x-----x

Decision No. 2013- 126

DECISION

BIOMEDIS, INC. ("Opposer")¹ filed an opposition on 15 April 2011 to Trademark Application No. 4-2010-501802. The application, filed by RECKITT BENSICKER HEALTHCARE (UK) LIMITED, ("Respondent-Applicant")² covers the mark "TEMGESIC" for use on "pharmaceutical preparations and substances" under Class 05 of the International Classification of Goods and Services³.

The Opposer alleges, among other things the following:

1. The mark "TEMGESIC" owned by Respondent-Applicant so resembles the trademark "BIOGESIC" owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark "TEMGESIC".
2. The mark "TEMGESIC" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark "TEMGESIC" is applied for the same class and goods as that of Opposer's trademark "BIOGESIC", *i.e.* Class 05 of the International Classification of Goods as Pharmaceutical Preparation.
3. The registration of the mark "TEMGESIC" in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

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

² Appears to be a foreign corporation with office address at Dansom Lane, Hull England, HU8 7DS.

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.

- (i) the same goods or services, or
- (ii) closely related goods or services, or
- (iii) if it likely resembles such a mark as to be likely to deceive or cause confusion;
(Emphasis supplied)

In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibits "A" to "A-1" – Copies of the pertinent pages of the IPO E-Gazette;
2. Exhibit "B" – Copy of the Notice of Opposition with Motion for Extension of Time to File Verified Opposition;
3. Exhibit "C" – Certified true copy of the Certificate of Registration No. 12196 for the trademark "BIOGESIC";
4. Exhibit "D" – Certified true copy of the Certificate of Renewal of Registration No. 12196 for the mark "BIOGESIC";
5. Exhibits "E", "F", "G" and "H" – Affidavit of Use, Certified true copies;
6. Exhibit "I" – Sample product label bearing the trademark "BIOGESIC" actually used in Commerce;
7. Exhibit "J" – Certified true copy of the Certification and Sales Performance; and
8. Exhibit "K" – Certified true copy of the Certificate of Product Registration issued by the BFAD for the trademark "BIOGESIC".

The Respondent-Applicant filed a Verified Answer beyond the reglementary period. Accordingly, the Hearing Officer issued on 24 May 2013 Order No. 2013-786 declaring the Respondent-Applicant in default. Consequently, this opposition proceeding is considered submitted for Decision based on the evidence and opposition filed by the Opposer.

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

Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 08 December 2010, the Opposer has already an existing Trademark Registration No. 12196 issued on 24 March 1966 and which registration was renewed on 24 March 2006 for medicinal preparation composed of paracetamol and ascorbic acid under Class 05 of the International Classification of Goods and Services.

However, it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public. The only similarity between BIOGESIC and TEMGESIC 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 *paracetamol* 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 "TEM" 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.⁴ 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*. The Trademark Registry shows that there are registered trademarks containing the suffix GESIC, for use or used on goods under Class 05, examples of which are the following:

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| 1. | Dolgesic | Reg. No. 4200400653 |
| 2. | Actigesic | Reg. No. 41996114801 |
| 3. | Durogesic | Reg. No. 50596 |
| 4. | Meforagesic | Reg. No. 42006013557 |
| 5. | Stangesic | Reg. No. 42005007729 |
| 6. | Paugesic | Reg. No. 42008006560 |
| 7. | Rectogesic | Reg. No. 42000007649 |
| 8. | Geogesic | Reg. No. 42008710025 |

WHEREFORE, premises considered the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-501802 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 July 2013.


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

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.