



BIOMEDIS, INC.,
Opposer,

-versus-

SEL- J PHARMA CORPORATION,
Respondent- Applicant.

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}
} IPC No. 14-2012-00111
} Opposition to:
} Appln. Serial No. 4-2011-010569
} Date Filed: 06 September 2011
} TM: "GESIC"

NOTICE OF DECISION

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Counsel for the Opposer
66 United Street
Mandaluyong City

SEL-J PHARMA CORPORATION
Respondent-Applicant
2nd Floor, Villanueva Compound
CAA Road corner J. Aguilar Drive
Pamplona, Las Pinas City

GREETINGS:

Please be informed that Decision No. 2013 - 61 dated April 11, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 11, 2013.

For the Director:


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



BIOMEDIS, INC.,
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-versus-

SEL-J PHARMA CORPORATION,
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IPC No. 14-2012-00111

Opposition to Trademark
Application No. 4-2011-010569
Date Filed: 06 September 2011

Trademark: **"GESIC"**
Decision No. 2013- 61

DECISION

Biomedis Inc.¹ ("Opposer") filed, on 7 March 2012, an opposition to Trademark Application No. 4-2011-010569. The contested application, filed by Sel-J Pharma Corporation² ("Respondent-Appellant"), covers the mark "GESIC" for use on "*pharmaceutical products with Ibuprofen as the active ingredient*" under Class 05 of the International Classification of Goods³.

Opposer anchors its claim on the provision of Section 123 (d) of the Intellectual Property Code (IP Code) stating that as early as 20 September 1965, it already filed a trademark application for "BIOGESIC" with the Bureau of Patent Office. The mark was approved for registration on 24 March 1996 to be valid for twenty (20) years. Before the registration expired, it petitioned for renewal of registration, which was granted for another twenty years, or until 24 March 2006. Again, in 24 November 2005, Opposer filed another petition for renewal, which was granted for a period of ten (10) years, or until March 24, 2016. Opposer furthers that aside from its registration, the company extensively uses the trademark "BIOGESIC" in commerce in the Philippines.

Opposer maintains that the registration of Respondent-Applicant's mark, "GESIC", will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the said mark is applied for the same class and goods as that of its own trademark "BIOGESIC". To support the Opposition, the following documents are attached:

1. Copies of the pertinent pages of the IPO E-Gazette whereby the trademark "GESIC" was published for opposition;

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.

² Appears to be a domestic corporation, with office address at 2nd Floor Villanueva Compound, CAA Road cor. J. Aguilar rive, Pamplona

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.

2. Certified True Copy of Certificate of Registration No. 12196 for the trademark "BIOGESIC" issued by the Philippines Patent Office;
3. Certified True Copy of Certificate of Registration No. 12196 for the trademark "BIOGESIC" issued by the Intellectual Property Office (IPO);
4. Certified true copies of the Affidavits of Use;
5. Sample product label bearing the trademark "BIOGESIC";
6. Photocopy of the certification by the IMS Health Philippines, Inc. with attached sales data for NO2B – Non-narcotic Analgesics Market; and,
7. Certified true copy of the Certificate of Product Registration issued by the Bureau of Food & Drugs (BFAD).

Despite due notice, Respondent-Applicant did not file its Answer. As a result, a default order was issued and the case was submitted for decision.

Now, the issue to be resolved is whether the trademark application of Respondent-Applicant should be granted.

A trademark is any distinctive word, name, symbol, emblem, sign, or device, or any combination thereof, adopted and used by a manufacturer or merchant on his goods to identify and distinguish them from those manufactured, sold, or dealt by others. Inarguably, it is an intellectual property deserving protection by law.⁴

As stated in the above definition, a trademark must, first and foremost, be capable of distinguishing one's goods apart from the other. In this regard, both parties aim to use "GESIC" in their trademarks. This Bureau notes that the term is coined from the common term "analgesic", which connotes drugs that provide relief from pain. While Opposer managed to give its trademark a distinct characteristic by adding the prefix "BIO", Respondent-Claimant failed to do so. "GESIC", by itself, is descriptive for drugs containing ibuprofen like the products sought by Respondent-Claimant to be registered. Ibuprofen is defined as "a nonsteroidal anti-inflammatory medication used especially in the treatment of arthritis and commonly taken for its *analgesic* and antipyretic properties."⁵

In this connection, Section 123.1 of the IPC provides that:

"xxx

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;

⁴ Dermaline Inc. vs. Myra Pharmaceuticals Inc., G.R. No. 190065, August 16, 2010.

⁵ <http://medical-dictionary.thefreedictionary.com/ibuprofen>.

(i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;

xxx"

The Supreme Court further explained in *Societe des Produits Nestle vs. Court of Appeals*⁶ that:

"Generic terms are those which constitute 'the common descriptive name of an article or substance,' or comprise the 'genus of which the particular product is a species'" or are 'commonly used as the name or description of a kind of goods,' or 'imply reference to every member of a genus and the exclusion of individuating characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination." (Emphasis supplied.)

To allow Respondent-Claimant to register "GESIC" is tantamount to giving the said company an undue advantage over its competitors and cause confusion among the consumers who would be easily deceived that what they are buying is a generic drug. In this view, the Bureau does not agree to Opposer's position that it has the exclusive right to use the suffix "gesic". Based on the cited provision of law and jurisprudence, no person or entity can claim exclusive right where the trademark is descriptive. However, for the

⁶ G.R. No. 112012, April 4, 2001.

same reason, the registration of Respondent-Claimant's trademark should not be allowed.

The so-called descriptive terms, which may be used to describe the product adequately, can not be monopolized by a single user and are available to all. It is only natural that the trade will prefer those marks which bear some reference to the article itself.⁷

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of 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 product.⁸ Respondent-Applicant's trademark fell short in meeting this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2011-010569 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 April 2013.


ATTY. NATHANIEL S. AREVALO
Director IV, BLA

⁷ G.R. No. L-6235, March 28, 1955.

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19, 1999.