



UNITED LABORATORIES, INC.,
Opposer,

-versus-

BIO LINK PHARMA,
Respondent- Applicant.

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}
} IPC No. 14-2010-00243
} Opposition to:
} Appln. Serial No. 4-2010-002141
} Date Filed: 26 February 2010
} TM: "BIOCOF"

NOTICE OF DECISION

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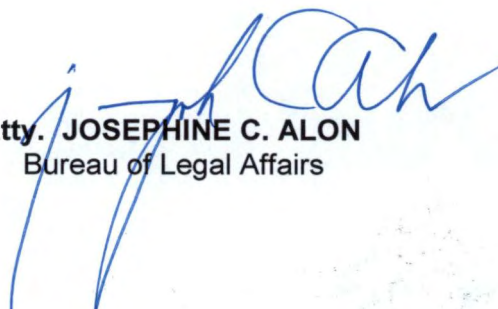
HAIDEE MANALO
For Respondent-Applicant
c/o BIOLINK PHARMA
35 Scout Lozano Street, Brgy. Laging Handa
Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 160 dated June 23, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 23, 2014.

For the Director:


Atty. JOSEPHINE C. ALON
Bureau of Legal Affairs



UNITED LABORATORIES, INC.,
Opposer,

-versus -

BIO LINK PHARMA,
Respondent-Applicant.

X ----- X

IPC No. 14-2010-00243
Opposition to:

Appln. Serial No. 4-2010-002141
Date Filed : 26 February 2010
Trademark : "BIOCOF"

Decision No. 2014 - 140

DECISION

UNITED LABORATORIES, INC.,¹ (Opposer") filed an opposition to Trademark Application No. 4-2010-002141. The application, filed by **BIO LINK PHARMA** (Respondent-Applicant")², covers the mark "**BIOCOF**" for use on pharmaceutical preparations for the relief of cough due to common colds and flu under class 05³.

The Opposer interposes the following grounds for opposition:

"1. The trademark 'BIOCOF' so resembles 'BIOFLU' trademarks owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'BIOCOF'. The trademark 'BIOCOF', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'BIOCOF' is applied for the same class and goods as that of trademarks 'BIOFLU', i.e. Class (5);

"2. The registration of the trademark 'BIOCOF' in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines'. x x x

Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"3. Respondent's use and registration of the trademark 'BIOCOF' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'BIOFLU'.

"4. Opposer, the owner of the trademark 'BIOFLU', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'BIOFLU' was filed with the Intellectual Property Office by UNAM BRANDS (BVI) LTD. ('Unam'), an affiliate of herein Opposer, on 24 February 2004 and was approved for registration on 6 January 2006, valid for a period of ten (10) years or until 6 January 2016. On 24 October 2007, Unam assigned the ownership of the trademark 'BIOFLU' to herein Opposer.

¹ A domestic corporation with principal office address at No. 66 United Street, Mandaluyong City.

² A domestic corporation with principal office address at No. 35 Sct. Lozano St., Brgy. Laging Handa, Quezon City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"5. The trademark 'BIOFLU' has been extensively used in commerce in the Philippines.
x x x

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'BIOFLU', and the fact that they are well known among consumers, as well as to internationally known pharmaceutical information provider, the Opposer has acquired an exclusive ownership over the 'BIOFLU' marks to the exclusion of all others.

"7. 'BIOCOF' is confusingly similar to 'BIOFLU'.
x x x

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code ('IP Code').

"9. To allow Respondent to continue to market its products bearing the 'BIOCOF' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'BIOFLU', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.
x x x

"10. By virtue of Opposer's prior and continued use of the trademark 'BIOFLU', the same have become well-known and established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent's confusingly similar trademark on its goods will enable the latter to obtain benefit from Opposer's reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent is in any way connected with the Opposer.

"11. Likewise, the fact that Respondent seeks to have its mark 'BIOCOF' registered in the same class (Nice Classification 5) as the trademark 'BIOFLU' of Opposer will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

The Opposer's evidence consists of the following:

- | | | |
|----------------|---|---|
| 1. Exhibit "A" | - | List of Trademarks Published for Opposition; |
| 2. Exhibit "B" | - | Certificate of Registration for the trademark BIOFLU; |
| 3. Exhibit "C" | - | Assignment of Registered Trademark BIOFLU; |
| 4. Exhibit "D" | - | Declaration of Actual Use; |
| 5. Exhibit "E" | - | Actual Packaging of BIOFLU; and, |
| 6. Exhibit "F" | - | Certificate of Product Registration. |

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 08 December 2010. Respondent-Applicant however, did not file an answer. Thus, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark BIOCOF?

The instant opposition 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 show that at the time the Respondent-Applicant filed its trademark application on 26 February 2010, the Opposer was issued Registration Certificate No. 4-2004-001719 for BIOFLU on 06 January 2006.⁴ This registration covers 'pharmaceutical preparations which include analgesics and antipyretics, antirheumatic, anti-inflammatory analgesics, cough and cold remedies, decongestants and other nasal preparations under class 5. Hence, the competing marks are used on similar and related goods.

Nevertheless, it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public. The competing marks are reproduced as follows:

Bioflu

Opposer's mark

Biocof

Respondent-Applicant's mark

Both marks start with the prefix or term "BIO". "BIO" is defined as indicating or involving life or living organisms: biogenesis; biolysis.⁵ It appears that the word BIO, taken singly or in combining form is a suggestive mark, and is therefore a weak mark. It gives away or tells the consumers the goods or services, and/or the kind, nature, use of purpose thereof, has relation to biology or life.

This Bureau takes cognizance via judicial notice of the Trademark Registry which shows that BIO is commonly used as a prefix or component of trademarks used on pharmaceutical products. These marks include BIOGESIC LOGO (Registration No. 42009006731); BIOGESIC FASTFIZZ (Registration No. 42012009745); BIOGEN (Registration No. 41995101957); BIOGEN IDEC (Registration No. 412010011270); BIO HERB (Registration No. 42002007386); BIOBITA (Registration No. 42010009751); BIO-FITRUM (Registration No. 42008000510); BLACKMORES BIO C (Registration No. 42004011697); and BIO-FIT (Registration No. 42004006234)⁶.

Succinctly, what will set apart or distinguish two trademarks that both contain BIO and used on similar goods are letters and/or syllables that follow or accompany the said affix trademarks. In this instant case, Respondent-Applicant's mark ends with the letters or syllables "COF" which are different, visually and aurally, from "FLU" in the Opposer's mark.

Moreover, taking into account that the only similarity between the competing marks is the prefix BIO, sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive right to use BIO, which evidently and sufficiently describes the pharmaceutical goods involved.

⁴ Exhibit "B" of Opposer.

⁵ The Free Dictionary by Farlex, available at <http://www.thefreedictionary.com/bio-> (last accessed 20 June 2014).

⁶ IPOPHEL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 20 June 2014).

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-002141 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 June 2014.


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