



UNITED LABORATORIES, INC.,
Opposer,

-versus-

BIOLINK PHARMA,
Respondent- Applicant.

} IPC No. 14-2012-00129
}
} Opposition to:
} Appln. Serial No. 4-2011-750034
} Date filed: 07 July 2011
} TM: "BIOFEN"
}
}
}
}
}
}

X-----X

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for Opposer
66 United Street
Mandaluyong City

BIOLINK PHARMA

Respondent-Applicant
2nd Floor, Biolink Pharma Building
#35 Scout Lozano Street
Brgy. Laging Handa, Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 155 dated July 31, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 31, 2013.

For the Director:


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



UNITED LABORATORIES, INC. ,	}	IPC NO. 14-2012-00129
Opposer,	}	Opposition to:
	}	
versus-	}	Appln. Ser. No. 4-2011-750034
	}	Date Filed: 7 July 2011
BIOLINK PHARMA,	}	Class: 5
Respondent-Applicant.	}	Trademark: BIOFEN
	}	
x-----x		Decision No. 2013 - <u>155</u>

DECISION

UNITED LABORATORIES, INC. ("Opposer")¹, filed on 15 March 2012 a Verified Opposition to Trademark Application No. 4-2011-750034. The application, filed by BIOLINK PHARMA ("Respondent-Applicant")² covers the mark BIOFEN for use as "*analgesic drug*" under Class 05 of the International Classification of goods³.

The Opposer alleges that the trademark BIOFEN resembles that of BIOFLU which is owned by the Opposer and which was registered with the Intellectual Property Office ("IPO") prior to the publication for opposition of the mark BIOFEN. Opposer also alleges that BIOFEN will likely cause confusion, mistake and deception on the part of the purchasing public. Both marks cover goods falling under Class 05. Opposer's mark covers "pharmaceutical preparations which include analgesics and antipyretics, antirheumatic, anti-inflammatory analgesics, cough and cold remedies, decongestants and other nasal preparations", while Respondent-Applicant's mark covers "analgesic drug". Opposer argues that the registration of BIOFEN will violate Sec. 123.1 (d) of the Intellectual Property Code of the Philippines ("IP Code") as BIOFEN is confusingly similar to the Opposer's mark, BIOFLU and used for the same kind of goods under Class 05.

The Opposer's evidence consists of print-out of a certified true copy of

¹ A domestic corporation organized and existing under the laws of the Philippines, with office address at 66 United Street, Mandaluyong City

² A domestic corporation, with address at 2nd Floor, Biolink Pharma Bld., #35 Scout Lozano St., Barangay Laging Handa, Quezon City

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

the Trademark Application of Respondent-Applicant, certified true copy of Certificate of Registration No. 4-2004-001719 dated 6 January 2006, certified true copy of Assignment of Registered Trademark dated 24 October 2004 between of Opposer and Unam Brands (BVI), Ltd., sample package of BIOFLU and certified true copy of BFAD certificate of product registration.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" dated 27 March 2012 which was received on 3 April 2012. The Respondent-Applicant however did not file an Answer.

Should the Respondent-Applicant be allowed to register the mark BIOFEN? The marks are reproduced below for perusal.

Opposer's mark

Respondent-Applicant's mark

Bioflu

BIOFEN

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.⁵ Thus, Sec. 123.1 (d) of R. A. 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.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 7 July 2011, the Opposer already has an existing registration for the trademark BIOFLU.

⁴ Exhibits "A"- "E"

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, BIOFLU and BIOFEN have the same prefix "BIO". The suffixes are different in spelling and pronunciation, "FLU" and "FEN". The English prefix "BIO" means "life" or "bios". There are a number of derivations in English language such as biopsy, biogen, biography, bionic etc.⁶ The Supreme Court in *Philippine Refining Co. v. Ng Sam and Director of Patents*⁷ held:

It has been held that if a mark is so commonplace that it cannot be readily distinguished from others, then it is apparent that it cannot identify a particular business; and he who first adopted it cannot be injured by any subsequent appropriation or imitation by others, and the public will not be deceived."

As stated in *Bristol Myers Company v. Director of Patents and United American Pharmaceuticals, Inc.*⁸

Appellant contends that confusing similarity will obtain because both products are primarily used for the relief of pains such as headaches and colds; and because *words* "BIOFERIN and "BUFFERIN" are practically the same in spelling and pronunciation. xxx

In determining whether two trademarks are confusingly similar, the test is not *simply* to take their *words* and compare the spelling and pronunciation of said words. Rather, it is to consider the *two marks in their entirety, as they appear in the respective labels, in relation to the goods to which they are attached.*

Accordingly, there would be no likelihood of confusion considering that the Opposer's mark as it appears in its label has elements such as a picture of a man, the words body aches, severe colds and fever flu in orange, green and blue designs. Moreover, the competing marks are phonetically different.

⁶ en.wikitionary.org/wiki.bio

⁷ *Philippine Refining Company, Inc. v. Ng Sam* citing *Maniton Springs Mineral Water Co. vs. Schueler*, 239 Fed. 593, 597, C. C. A. 8th, 1917 G.R. No. L-26676 July 30, 1982

⁸ G.R. No. L-21587 May 19, 1966

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-750034, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 July 2013.


Atty. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs