



UNITED LABORATORIES, INC.,  
Opposer,

-versus-

JOEL C. NG,  
Respondent- Applicant.

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} IPC No. 14-2010-00073  
} Opposition to:  
} Appln. Serial No. 4-2009-007264  
} Filing Date: 22 July 2009  
} TM: "BIOGEL"  
}

**NOTICE OF DECISION**

**OCHAVE & ESCALONA**  
Counsel for the Opposer  
66 United Street  
Mandaluyong City

**JOEL C. NG**  
Respondent-Applicant  
No. 19 D. Munoz Avenue, Carmel V Subdivision  
Brgy. Tandang Sora, Quezon City

**GREETINGS:**

Please be informed that Decision No. 2013 - 96 dated May 31, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, May 31, 2013.

For the Director:

*Edwin O. Dating*  
**ATTY. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs

**CERTIFIED TRUE COPY**  
*Sharon S. Alcantara*  
**SHARON S. ALCANTARA**  
Records Officer II  
Bureau of Legal Affairs



**UNITED LABORATORIES, INC.,**  
*Opposer,*

**IPC No. 14-2010-00073**

Opposition to:

- versus -

Appln. Serial No. 4-2009-007264

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**TM: "BIOGEL"**

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Decision No. 2013- 96

## DECISION

**UNITED LABORATORIES, INC.** ("Opposer")<sup>1</sup> filed on 22 March 2010 an opposition to Trademark Application Serial No. 4-2009-007264. The application, filed by **JOEL C. NG** ("Respondent-Applicant")<sup>2</sup>, covers the mark "BIOGEL" for use on "*hand sanitizer gel*" under Class 5 of the International Classification of Goods or Services.<sup>3</sup>

The Opposer alleges, among other things, that the mark BIOGEL so resembles its registered marks "BIOGENIC" and "BIOGESIC". According to the Opposer, the registration of the mark BIOGEL in favor of the Respondent-Applicant will violate Sec. 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 BIOGEL will diminish the distinctiveness and dilute the goodwill of the marks BIOGENIC and BIOGESIC.

To support its opposition, the Opposer submitted as evidence a printout of page 2 of the "IPO E-Gazette" with releasing date of 21 December 2009, and other documents relating to the marks BIOGENIC and BIOGESIC (copies of Cert. of Reg. No. 4-2007-010604 and Certificate 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.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 17 June 2010. The Respondent-Applicant, however, did not file an Answer.

A perusal of the instant opposition shows that it is anchored on Sec. 123.1, par. (d), of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark

<sup>1</sup> A corporation duly organized and existing under the laws of Philippines with principal office address at No. 66 United Street, Mandaluyong City.

<sup>2</sup> With address at 19 D. Munoz Avenue, Carmel V Subd., Brgy. Tandang Sora, Quezon City.

<sup>3</sup> 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.

<sup>4</sup> Marked as Annexes "A" to "J".

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 22 July 2009, the Opposer has already existing trademark registrations for the marks BIOGENIC (Reg. No. 4-2007-010604, issued on 06 September 2008) and BIOGESIC (Reg. No. 12196, issued on 24 March 1966 and renewed on 24 March 2006). The registration of BIOGENIC covers *"hygienic and general care and well-being items namely: hand sanitizer, alcohol, liniment, medicated soaps and rubs, antiseptics and disinfectants"*, while that of the mark BIOGESIC indicates *"medicinal preparation composed of paracetamol and ascorbic acid"* under Class 5.

A scrutiny of the Respondent-Applicant's mark shows that it is similar to the Opposer's marks with respect to the first five (5) letters comprising each mark – the prefix "BIO" and the letters "G" and "E". This Bureau notices that "BIO" is a common prefix for names, brands or marks of goods and/or services that utilize biological sources. In the Trademark Registry, the contents of which this Bureau may take cognizance of via judicial notice, there are marks that are registered or applied for registration that have the prefix "BIO".

Obviously, the prefix "BIO" is derived from the word *"biology"* which is defined as *"a natural science concerned with the study of life and living organisms, including their structure, function, growth, evolution, distribution, and taxonomy"*<sup>5</sup>, and/or from the word *"biological"* which is *"of relating to, caused by, or affecting life or living organisms; biological processes such as growth and digestion"* or *"a preparation, such as drug, vaccine, or an antitoxin, that is synthesized from living organisms or their products and used medically as a diagnostic, preventive or therapeutic agent."*<sup>6</sup> The prefix "BIO" therefore, connotes connection *"with life and living things"*.<sup>7</sup> Hence, a trademark that has the prefix "BIO" in this regard is considered a suggestive mark. The degree of its distinctiveness therefore would depend on the letters or syllables that follow the prefix, and the other features or devices, if any.

In this instant, it is unlikely that the co-existence of the mark BIOGEL on one hand, with BIOGENIC and BIOGESIC on the other will cause confusion, much less deception. The letters or syllable that follows the prefix "BIO" in the Respondent-Applicant's mark ("GEL") can easily be distinguished from that of in the Opposer's marks ("GENIC" and "GESIC"). Like in the Opposer's marks, the letters immediately succeeding the prefix "BIO" in the Respondent-Applicant's mark are the letters "G" and "E". But because only the letter "L" is added to the letters "G" and "E", what follows the prefix "BIO" is a single syllable which has visual and aural properties that are distinct from the two syllables "GENIC" and "GESIC" in the Opposer's marks. The eyes cannot be confused or deceived that "L" looks like "NIC" or "SIC", while the ears would certainly differentiate the sound "jel" from "je-nik" and "je-sik".

Moreover, confusion, much less deception, is almost impossible in respect of the mark BIOGEL co-existing with the Opposer's mark BIOGESIC. The pharmaceutical product covered by

<sup>5</sup> ref. [www.en.wikipedia.org/wiki/Biology](http://www.en.wikipedia.org/wiki/Biology)

<sup>6</sup> ref. [www.thefreedictionary.com](http://www.thefreedictionary.com) citing The American Heritage Dictionary of the English Language, Fourth Edition copyright ©2000 by Houghton Mifflin Company (Updated in 2009).

<sup>7</sup> Ref. Cambridge Dictionaries Online ([www.dictionary.cambridge.org/dictionary/british/bio](http://www.dictionary.cambridge.org/dictionary/british/bio))

BIOGESIC is very different from the Respondent-Applicant's hand sanitizer as to ingredients, indication, use or application and purpose.

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.<sup>8</sup> This Bureau finds the Respondent-Applicant's mark consistent with this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-007264 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 31 May 2013.

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

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<sup>8</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.