



WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

MEDHAUS PHARMA, INC.,
Respondent- Applicant.

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} IPC No. 14-2010-00177
} Opposition to:
} Appln. Serial No. 4-2010-000604
} Date Filed: 18 January 2010
} TM: "BESYLON"

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
66 United Street
Mandaluyong City

ARLENE C. BALBERDE
For Respondent-Applicant
139 K 1st Street, Kamuning
Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 245 dated December 20, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 20, 2013.

For the Director:

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



WESTMONT PHARMACEUTICALS, INC.,
Opposer,

IPC No. 14-2010-00177
Opposition to:

-versus-

Appln. Serial No. 4-2010-000604
(Filing Date: 18 January 2010)
Trademark: "BESYLON"

MEDHAUS PHARMA, INC.,
Respondent-Applicant.

X -----X

Decision No. 2013 - 245

DECISION

WESTMONT PHARMACEUTICALS, INC. (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-000604. The application, filed by MEDHAUS PHARMA, INC. ("Respondent-Applicant")², covers the mark "BESYLON" for use "*pharmaceutical product –calcium channel blocker*" under class 5³.

The Opposer interposes the following grounds for opposition:

"1. The trademark 'BESYLON' so resembles 'DECILONE' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'BESYLON'. The trademark 'DECILONE', 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 'BESYLON' is applied for the same class of goods as that of trademark 'DECILONE', ie. Class (5).

"2. The registration of the trademark 'BESYLON' 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'.

The facts are provided as follows:

"4. Opposer, the registered owner of the trademark 'DECILONE', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'DECILONE-C' was originally filed with the Philippine Patent Office on 23 September 1967 by Opposer and was approved for registration by this Honorable Office on 2 September 1969 and valid for a period of twenty (20) years. Prior to the lapse of the twenty-year term, Opposer applied for the renewal of the registration which was approved for another period of twenty (20) years starting 2 September 1989. On 12 August 2009, Opposer filed a Petition for Renewal of Registration with a prayer to delete '-C'. The said Petition for Renewal was allowed by Intellectual Property Office in a Notice of Allowance dated 28 January 2010. Hence, Opposer's registration of the 'DECILONE' trademark subsists and remains valid to date. Attached are copies

¹ A corporation duly organized and existing under the laws of the Philippines, with principal office located at 4th Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A domestic corporation with principal office address at No. 139 K 1st St., Kamuning, 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.

of Certificate of Registration Number 15060 and the Notice of Allowance marked as Annex 'B' and 'C' respectively.

"5. The trademark 'DECILONE' 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 Registrations, the uninterrupted use of the trademark 'DECILONE', and the fact that they are well known among consumers, the Opposer has acquired an exclusive ownership over the 'DECILONE' mark to the exclusion of all others.

"7. 'BESYLON' is confusingly similar to 'DECILONE'.

x x x

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293. x x x

"9. To allow Respondent to continue to market its products bearing the 'BESYLON' mark undermines Opposer's right to its marks as the lawful owner of the mark 'DECILONE', 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 'DECILONE', 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 'BESYLON' registered in the same class (Nice Classification 5) as the trademark 'DECILONE' 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" - Downloaded copy of Trademarks Published for Opposition dated 19 July 2010;
2. Exhibit "B" - Trademark Registration Certificate of DECILONE-C;
3. Exhibit "C" - Notice of Allowance for the renewal application of DECILONE;
4. Exhibit "D" - Affidavit of Use for 15th Anniversary;
5. Exhibit "E" - Affidavit of Use for 10th Anniversary;
6. Exhibit "F", "G" & "H" - Affidavits of Use;
7. Exhibit "I" - Photocopy of actual packaging of DECILONE FORTE; and,
8. Exhibit "J" - Certificate of Product Registration for DECILONE.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 12 November 2010. The Respondent-Applicant, however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“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 18 January 2010, the Opposer has already an existing trademark registration for the mark DECILONE-C bearing Registration No. 15060 issued on 02 September 1969⁴; and was later on allowed by this Office to delete “-C”, to read as DECILONE on 28 January 2010⁵. Unquestionably, the Opposer’s application and registration preceded the Respondent-Applicant’s.

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:

DECILONE

Opposer’s mark

BESYLON

Respondent-Applicant’s mark

An examination of the contending marks shows that both contain the middle letters “L”, “O” and “N”. This similarity, however, is not sufficient to reach a conclusion that there is the likelihood of confusion. The prefix, as well as the last letters is visually and aurally different. This distinction makes the two marks different from each other. It is often, the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered. The first word, prefix or syllable in a mark is always the dominant part.

While the BESYLON may sound similar to DECILONE, the public confusing one mark with the other is not likely. The product covered by the mark BESYLON is entirely different from the DECILONE marked/branded product. The Opposer’s DECILONE product is a pharmaceutical preparation for effective management of various inflammatory and allergic conditions generally responsive to corticosteroid therapy, which include skin diseases, allergic reactions, acute inflammatory eye diseases, musculo-skeletal disorders, blood dyscrasias, certain neoplastic diseases, collagen diseases and adrenocortical insufficiency.⁶ On the other hand, the Respondent-Applicant’s BESYLON covers calcium channel blocker,⁷ an anti-hypertensive drug.

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 or 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

⁴ Exhibit “B” of Opposer.

⁵ Exhibit “C” of Opposer.

⁶ IPOPHI Trademark Search, available at <http://onlineservices.ipophil.gov.ph/ipophilsearch/>.

⁷ File wrapper records.

sale of an inferior and different article as his product.⁸ This Bureau finds that the mark BESYLON meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the file wrapper of Trademark Application Serial No. 4-2010-000604 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 December 2013.



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

⁸ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.