



BIOMEDIS, INC.,
Opposer,

-versus-

BIOLINK PHARMA,
Respondent- Applicant.

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}
} IPC No. 14-2011-00136
} Opposition to:
} Appln. Serial No. 4-2010-012005
} (Filing Date: 5 November 2010)
} TM: "BIOCLAV"
}
}
}
}

NOTICE OF DECISION

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

Please be informed that Decision No. 2014 - 215 dated August 19, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 19, 2014.

For the Director:

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



BIOMEDIS, INC.,
Opposer,

IPC No. 14-2011-00136
Opposition to:

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x-----x

Decision No. 2014- 215

DECISION

BIOMEDIS, INC., ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2010-012005. The application, filed by BIOLINK PHARMA, ("Respondent-Applicant")², covers the mark "BIOCLAV" for "antibiotic drug" under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges among other things, the following:

"1. The trademark BIOCLAV so resembles AMOCLAV trademark owned by Opposer and registered with this Honorable Office prior to the publication for opposition of the mark BIOCLAV. The trademark BIOCLAV, 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 BIOCLAV is applied for the same class and goods as that of trademark AMOCLAV, i.e. Class (5); an anti-biotic/anti-bacterial.

1.1. Significantly, the Opposer's name, which is likewise registered with the IPO prior to the application of BIOCLAV, is BIOMEDIS, INC. Clearly, the likelihood of confusion is imminent especially considering that Respondent's mark appears to be a combination of Opposer's name BIOMEDIS, INC., ('BIOMEDIS') and its trademark AMOCLAV.

"2. The registration of the trademark BIOCLAV 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', which provides, in part, that a mark cannot be registered if it:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services, or
- (ii) closely related goods or services or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion; (Emphasis supplied)

1 A corporation duly organized and existing under the laws of the Philippines with principal office address at 108 Rada St., Legaspi Village, Makati City

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

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.

“3. Respondent's use and registration of the trademark BIOCLAV will diminish the distinctiveness and dilute the goodwill of Opposer's trademark AMOCLAV”.

In support of its opposition, the Opposer submitted in evidence print-out of page 3 of the IPO E-Gazette showing trademark applications allowed and published for opposition, certified true copies of the certificates of registration for the mark AMOCLAV and BIOMEDIS, Declaration of Actual Use and Affiant Use for AMOCLAV and BIOMEDIS, sample product label bearing the mark AMOCLAV actually used in commerce; and Certificate of Product Registration issued by the Bureau of Food and Drugs for the mark AMOCLAV⁴.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 14 June 2011. The Respondent-Applicant, however, did not file an answer, hence, the case was deemed submitted for decision.

Records show that at the time the Respondent-Applicant filed its trademark application on 05 November 2010, the Opposer already has existing trademark registrations for the marks BIOMEDIS, INC. (Reg. No. 36815 issued on 05 March 1987) covering the “*service, manufacture and sale of drugs and medicines*” under class 35, and AMOCLAV (Reg. No. 4-1999-003627 issued on 01 July 2005) for use on “*medical preparation for use as antibacterial*” under class 5. The goods or services covered by these trademark registrations are similar and/or closely to those indicated in the Respondent-Applicant’s trademark application. Nevertheless, this Bureau finds that the Respondent-Applicant should be allowed to register the mark BIOCLAV in its favor.

The similarity between the marks BIOCLAV and AMOCLAV is with respect to the syllable “CLAV”. In this regard, there is sufficient reason to infer or even to conclude that the suffix “CLAV” is derived from the substance “*clavulanic acid*”. The Opposer’s evidence in fact, specifically, the sample product packaging, shows that AMOCLAV’s generic name is “CO-AMOXICLAV, its formulation consisting of “*amoxicillin*” and “*clavulanic acid*”⁵. Obviously, AMOCLAV is just a contraction of “AMOXICLAV” and/or combination of “AMO” (from “*amoxicillin*”) and “Clav” (from “*clavulanic acid*”). AMOCLAV thus, is not highly distinctive as a trademark. At most, it is considered a suggestive mark, which is a weak mark. What will set apart or distinguish such mark from another mark which also includes the same suffix, are the letters and/or syllables that precede “CLAV”. Succinctly, what precedes “CLAV” in the Respondent-Applicant’s mark is the prefix “BIO”. “BIO” is starkly different from “AMO” in sight and sound.

The Opposer, however, argues that BIOCLAV is confusingly similar to BIOMEDIS, INC. because of the prefix “BIO”. “BIO”, however, 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*”⁶, 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*

⁴ Marked as Annexes “A” to “K”.

⁵ Exhibit “E”.

⁶ ref. www.en.wikipedia.org/wiki/Biology

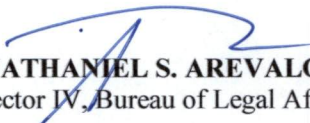
*synthesized from living organisms or their products and used medically as a diagnostic, preventive or therapeutic agent.*⁷ The prefix “BIO therefore, connotes connection “with life and living things”.⁸ Hence, a trademark that has the prefix “BIO” in this regard is considered a suggestive mark. The issue of confusing similarity is determined by looking at the other features of the competing marks. In the Respondent-Applicant’s mark, what follows “BIO” is the syllable “CLAV”, which is visually and aurally different from “MEDIS, INC.”

In conclusion, this Bureau finds that the Respondent-Applicant's trademark application is not proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-012005, together with a copy of this Decision be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 August 2014.


NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

⁷ ref. www.thefreedictionary.com citing The American Heritage Dictionary of the English Language, Fourth Edition copyright @2000 by Houghton Mifflin Company (Updated in 2009).

⁸ Ref. Cambridge Dictionaries Online (www.dictionary.cambridge.org/dictionary/british/bio)