



BIOMEDIS, INC.,
Opposer,

-versus-

SEL-J PHARMA CORPORATION,
Respondent- Applicant.

}
}
}
}
}
}
}
}
}
}

IPC No. 14-2012-00021
Opposition to:
Appln. Serial No. 4-2011-010579
Date Filed: 6 September 2011
TM: "SELEGESIC"

x-----x

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
66 United Street
Mandaluyong City

SEL-J PHARMA CORPORATION
Respondent-Applicant
2nd Floor Villanueva Compound
CAA Road cor. J. Aguilar Drive
Pamplona, Las Pinas City

GREETINGS:

Please be informed that Decision No. 2014 - 274 dated October 31, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 31, 2014.

For the Director:


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



BIOMEDIS, INC., } **IPC NO. 14-2012-00021**
Opposer, } Opposition to:
 }
-versus- } Appln. Ser. No. 4-2011-010579
 } Date Filed: 6 September 2011
 }
SEL-J PHARMA CORPORATION, } **Trademark: SELEGESIC**
Respondent-Applicant. }
x-----x } Decision No. 2014- *27A*

DECISION

BIOMEDIS, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-010579. The application, filed by **SEL-J PHARMA CORPORATION** (Respondent-Applicant)², covers the mark “SELEGESIC”, for use on “Pharmaceutical products with paracetamol as the active ingredient” under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“1. The mark ‘SELEGESIC’ owned by Respondent-Applicant so resembles the trademark ‘BIOGESIC’ owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark ‘SELEGESIC’.

“2. The mark ‘SELEGESIC’ will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark ‘SELEGESIC’ is applied for the same Class 05 of the International Classification of Goods as Pharmaceutical Product with Paracetamol as active ingredient.

“3. The registration of the mark ‘SELEGESIC’ in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

¹ A domestic corporation with address at Dynavision Building, 108 Rada Street, Legaspi Village, Makati City

² A domestic corporation with address at 2nd Floor Villanueva Compound, CAA Road cor J. Aguilar Drive, Pamplona, Las Piñas City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

(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;

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.”

The Opposer also alleges, among others, the following facts:

“10. Opposer is the registered owner of the trademark ‘BIOGESIC’.

“10.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark ‘BIOGESIC’ was filed with the Philippine Patent Office on 24 March 1966 by Opposer and was approved for registration on 24 March 1966 to be valid for a period of twenty (20) years, or until 24 March 1986.

“10.2. Before the expiration of the registration, Opposer filed a petition for renewal of registration, which was accordingly granted and valid for another period of twenty (20) years, or until 24 March 2006.

“10.3. On 24 November 2005, Opposer filed another petition for renewal of registration of the trademark ‘BIOGESIC’ with the IPO, which was accordingly granted and valid for another period of ten (10) years from 24 March 2006, or until 24 March 2016. Thus, the registration of the trademark ‘BIOGESIC’ subsists and remains valid to date.

“11. The trademark ‘BIOGESIC’ has been extensively used in commerce in the Philippines.

“11.1. Opposer has dutifully filed *Affidavits of Use* pursuant to the requirement of the law.

“11.2. A sample product label bearing the trademark ‘BIOGESIC’ actually used in commerce is hereto attached and made an integral part hereof as Exhibit ‘I’.

“11.3. No less than the Intercontinental Marketing Services (‘IMS’) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical or healthcare industries with operations in more than 100 countries, acknowledged and listed the brand

'BIOGESIC' as the leading brand in the Philippines in the category of 'NO2B- non-Narcotic Analgesics Market' in terms of market share and sales performance.

"11.4. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, Opposer registered the product with the Bureau of Food and Drugs ('BFAD').

"11.4. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark 'BIOGESIC' to the exclusion of all others. xxx"

"12. The registration of Respondent-Applicant's mark 'SELEGESIC' will be contrary to Section 123.1 (d) of the IP Code. 'SELEGESIC' is confusingly similar to Opposer's trademark 'BIOGESIC'."

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application published for opposition;
2. Copy of Certificate of Registration No. 12196 for the trademark "BIOGESIC" dated 24 March 1996 ;
3. Copy of Renewal of Registration No. 12196 for the trademark "BIOGESIC" dated 26 October 2006;
4. Affidavits of Use filed by Biomedis, Inc.;
5. Sample product label of "BIOGESIC";
6. Copy of Certification from Intercontinental Marketing Services ('IMS') dated 18 February 2011; and
7. Copy of Certificate of Product Registration issued by the Bureau of Food and Drugs dated 23 February 2011⁴

This Bureau issued a "Notice to Answer" on 31 January 2012. The Respondent-Applicant, however, did not file an Answer.

Records show that at the time Respondent-Applicant applied for registration of the mark "SELEGESIC" the Opposer already registered the mark "BIOGESIC" under Certificate of Registration No. 12196. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "medicinal preparation composed of paracetamol and ascorbic acid", same as indicated in the Respondent-Applicant's trademark application.

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

The competing marks are reproduced below:

⁴ Exhibits "A"; "C" to "K"

Opposer's mark

Respondent-Applicant's mark

BIOGESIC


SELEGESIC

The marks are similar with respect to the suffix ("GESIC"). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. The records show that the product description⁵ of the pharmaceutical product being sold is a non-narcotic "analgesic". The Opposer's packaging/label⁶ also indicate that BIOGESIC is an analgesic-anti-pyretic. It appears that the Opposer coined its mark from a portion of the word analgesic, the product for which its mark stands for. When the prefixes "BIO" and "SELE" are appended to the letters GESIC, the resultant words are visually and aurally different. The literal elements, "BIO" and "SELE" are phonetically dissimilar because they consist of different vowels and consonants. Given such dissimilarity, confusion and mistake is unlikely among the purchasing public.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-010579 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 October 2014.


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

⁵ Exhibit "J"

⁶ Exhibit "I"