



BIOMEDIS, INC.,
Opposer,

-versus-

XL LABORATORIES PVT. LTD.,
Respondent- Applicant.

IPC No. 14-2009-00082
Opposition to:
Appln. Serial No. 4-2008-011802
Date Filed : 26 September 2008
TM: "MELCOM"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 259 dated October 21, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 21, 2014.

For the Director:


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



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XL LABORATORIES, PVT. LTD.,

Respondent-Applicant.

} **IPC NO. 14-2009-00082**

} Opposition to:

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} Application No. 4-2008-011802

} Date filed :26 September 2008

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} Trademark: **MELCOM**

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x-----x } Decision No. 2014- 259

DECISION

BIOMEDIS, INC. (Opposer)¹ filed on 3 January 2011 an opposition to Trademark Application Serial No. 4-2008-011802. The application, filed by **XL LABORATORIES, PVT. LTD.** (Respondent-Applicant)², covers the mark "MELCOM", for use on "pharmaceutical products, non-steroidal anti-inflammatory drugs" under Class 05 of the International Classification of Goods³.

The Opposer relies on the following grounds in support of its Opposition:

"1. The trademark 'MELCOM' so resembles 'MELOCAM' trademark owned by Opposer, which was applied for registration with this Honorable Office prior to the application of the mark 'MELCOM'. The trademark 'MELOCAM', 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 'MELCOM' is applied for the same class of goods as that of trademark 'MELOCAM', i.e. Class (5); anti inflammatory.

"2. The registration of the trademark 'MELCOM' 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:

¹ A corporation organized and existing under the laws of the Philippines with address at 750 Shaw Boulevard, Mandaluyong City

² A corporation organized in India, with address at 1-14, Shivlok House -1, Karamoura Commercial Complex, Shivaji Marj, New Delhi, India

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.

- (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 mark with an earlier filing 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.

“3. Respondent’s use and registration of the trademark ‘MELCOM’ will diminish the distinctiveness of Opposer’s trademark ‘MELOCAM’.

According to the Opposer:

“4. Opposer, the owner of the trademark ‘MELOCAM’, is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark ‘MELOCAM’ was originally filed with the Intellectual Property Office on 5 June 2006 by Opposer’s sister company, MEDICHEM PHARMACEUTICALS, INC. (‘Medichem’) and was approved for registration by this Honorable Office on 30 April 2007 and valid for a period of ten (10) years. On 15 December 2008 filed with the IPO an Assignment of registered Trademark transferring the ownership of the trademark ‘MELOCAM’ to herein Opposer, Biomedis, Inc. Hence, Opposer’s registration of the ‘MELOCAM’ trademark subsists and remains valid to date. xxx”

The Opposer submitted as evidence the following:

1. Copy of Certificate of Registration No. 4-2006-005904 dated 30 April 2007 for the mark “MELOCAM”;
2. Copy of Assignment of Registered Trademark dated 25 September 2008.⁴

The Respondent-Applicant filed its Answer on 20 August 2009, alleging among other things, the following:

“6. There is simply no confusing similarity between the applicant’s mark ‘MELCOM’ and opposer’s registered mark ‘MELOCAM’ for clear and obvious reasons:

“7. On the alphabetical level, the following differences are too distinct to be ignored:

“7.1 Applicant’s mark ‘MELCOM’ does not contain the additional letter ‘A’ which is dominant in Opposer’s trademark ‘MELOCAM’;

⁴ Annex “A” and “B”

"7.2 Applicant's mark 'MELCOM' is composed of only two (2) syllables: 'MEL' and 'COM', On the other hand, Opposer's trademark is composed of three (3) syllables: 'ME', 'LO' and 'CAM';

"7.3 Lastly, applicant's mark 'MELCOM' contains only six (6) letters to seven (7) for 'MELOCAM';

"7.4 The only similarity between 'MELCOM' and 'MELOCAM' are its first three letters, nothing more. This likeness is utterly insignificant as to cause confusion much less deception to the common eye.

"8. On the aural level, the obvious differences are:

"8.1 Once the Opposer's mark 'MELOCAM' is pronounced, a distinct the middle syllable comes into play. This intervening syllable is CLEARLY ABSENT in intoning the applicant's mark 'MELCOM'. In short, 'MELCOM' ends on its second syllable 'COM' as against 'MELOCAM's 'LO'. On the other hand, 'MELOCAM' ends with a third and a differently-vowelled syllable 'CAM', which cannot be confused with 'MELCOM's final syllable 'COM'. 'MELOCAM's second and third syllables 'LOCAM' clearly sets it apart from 'MELCOM's final syllable 'COM'.

"8.2 The vowels 'O' and 'A' are vastly different. When pronounced, these vowels literally are poles apart and unmistakable. Consequently, it is highly specious to claim that there is an aural similarity between 'MELCOM' and 'MELOCAM'.

"8.3 Finally, to hold that 'CAM' and 'COM' are aurally similar is tantamount to saying that the common names 'TIM' and 'TOM' sound the same causing confusion as to identity. Such incredulity is too farfetched and cannot, by any stretch of imagination, be justified.

"9. On a visual level, applicant's mark is spelled in ALL CAPITAL LETTERS, whereas Opposer's IPO Certificate of Registration of its mark 'MELOCAM' is spelled in entirely lower case letters with the exception of the first letter 'M'. In addition, according to applicant's label, the mark applied for, 'MELCOM', is even suffixed by '1.5'. Hence, the brand name 'MELCOM - 15'. The suffix is an additional safeguard ensures that Melcom cannot be confused with Melocam. xxx

"10. As a matter of fact, the brandname 'MELCOM-15' has already been registered as a product by herein applicant with the Bureau of Food and Drugs (BFAD). A certified true copy of Melcom -15's BFAD Certificate of product Registration is hereto attached and made an integral part hereof as 'Annex 2'.

"11. In addition, the Melcom trademark is registered in Vietnam. The original Certificate of Authentication with corresponding certified true documents issued

by Philippine Consulate at New Delhi, India attesting to the registration of the Melcom mark in Vietnam are hereto attached as 'Annexes 3, 3-1, 3-b, 3-c and 3-d' and made integral parts hereof;

"12. To show that Melcom has also been made available, recognized and accepted in the Philippine market, it is cited in page 11 of the 2009/2010 9th edition of the Philippine Pharmaceutical Directory Review (PPDR), a noted listing of pharmaceutical products published by Medicomm Pacific, Inc. xxx

"13. Strangely and in stark contrast, Opposer has not attached a label for its MELCOM product. Neither has Opposer produced a certificate of product registration or a citation in a medical or pharmaceutical journal accepted in the industry attesting to Melocam's availability;

"14. This puzzling lack of documentary evidence conspire to indicate that, at present, Melcom is just a hollow mark. It is a name without any actual product support. Without any product, there is consequently no chance that the public may be confused or likely to be misled by the availability MELCOM in the market. Bluntly, there is no product against which MELCOM can be compared to, much less likely to be confused, mislead, deceived or mistaken with, at all;

"15. To justify its Opposition to applicant's registration of MELCOM, Opposer cites the jurisprudence in the case of Societe Des Produits Nestle, S.A. v. Court of Appeals (356 SCRA 207) xxx

"16. The Nestle case focused on marks appended on inexpensive and common coffee products which are bought off-the-shelf. In this case, we are dealing with Class 5 items which are pharmaceutical products highly regulated by the Bureau of Food and Drug;

"17. MELCOM is a drug marked 'Rx' meaning to say that it cannot be dispensed without the order of a physician. Because of this, MELCOM cannot be considered as a common item analogous to the nature of coffee, as was the subject of the Nestle dispute;

"18. For this reason, only a pharmacist, an intervening factor in the purchase of class 5 products, can release MELCOM to the public and only after he has ascertained himself of the physician's express and specific prescription. The intervention of the pharmacist does away with the public's likelihood of being confused or misled by competing pharmaceutical products;

"19. With the above-discussed peculiar circumstances, applicant maintains that using either the Dominancy or Holistic Test, the mark 'MELCOM' cannot be confused with Oppositor's 'MELOCAM' trademark."

The Respondent-Applicant submitted as evidence the following:

1. Original carton/label of MELCOM-15 with Medical Literature insert and blister pack;
2. Certified true copy of Bureau of Food and Drug (BFAD) Certificate of Product Registration for "MELCOM-15";
3. Original and authenticated certified true copies of trademark registration of MELCOM in Vietnam;
4. 2009/2010 9th edition of the Philippine Pharmaceutical Directory Review (PPDR), page 11.⁵

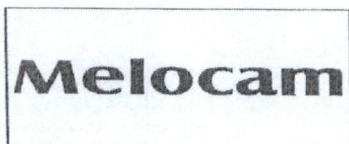
The Hearing Officer issued on 1 September 2009 a notice setting the Preliminary Conference on 20 October 2009. The Opposer failed to appear on 20 October 2009, thus, the Preliminary Conference was terminated, thereafter, the Hearing Officer issued on 13 November 2009 Order No. 2009-1638 directing the Respondent-Applicant to submit its position paper.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "MELCOM" the Opposer already registered the mark MELOCAM under Certificate of Registration No. 4-2006-005904. The goods covered by the Opposer's trademark registration are also under Class 05, 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:



Opposer's mark



Respondent-Applicant's mark

The marks are similar with respect to the prefix ("MEL") and utilize the letters "C" and "M" in the last syllables of their marks. Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur.

It is noteworthy that the generic or non-proprietary name of the drug is MELOXICAM. In coining its mark, the Opposer merely deleted one syllable, "XI" in the generic name of the drug, hence MELOCAM. The Opposer appropriated exactly three of the four syllables of the generic name of the pharmaceutical product, thus the Opposer's mark is almost identical to the generic name, MELOXICAM. On the other

⁵ Annex "1" to "4" inclusive of submarkings

hand, the Respondent-Applicant was more creative in copying the first syllable "MEL" and changing the last syllable by employing a different vowel to produce a different sound, thus, MELCOM. It would be highly unfair to disallow the application while allowing the Opposer exclusive right to a mark which is so similar to the generic name of the drug its stands for. Moreover, the suffixes COM and CAM are phonetically dissimilar. Thus, in combination with the prefix MELO or MEL, the resultant marks are visually and aurally different, confusion and deception is unlikely.


The Respondent-Applicant submitted an excerpt from a pharmaceutical dictionary⁶ to show the availability of its product under the mark, MELCOM -15. It also submitted its BFAD registration no. DRP-1277⁷ and its trademark registration from Vietnam.⁸ Finally, considering that the Respondent-applicant's drug is marked "Rx", it cannot be dispensed without order of a physician. The Supreme Court in Bristol Myers Company v. Director of Patents, held:

Accordingly, taken as they will appear to a prospective customer, the trademark in question are not apt to confuse. Furthermore, the product of the applicant is expressly stated as *dispensable only upon doctor's prescription*, while *that of oppositor does not require the same*. The chances of being confused into purchasing one for the other are therefore all the more rendered negligible. Although oppositor avers that some drugstores sell "BIOFERIN" without asking for a doctor's prescription, the same if true would be an irregularity not attributable to the applicant, who has already clearly stated the requirement of a doctor's prescription upon the face of the label of its product.⁹

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2008-011802 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, 21 October 2014.


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

⁶ Annex "4"

⁷ Annex "2"

⁸ Annex "3"

⁹ G.R. No. L-21587, 19 May 1966