



OFFICE OF THE DIRECTOR GENERAL

MEDICHEM PHARMACEUTICALS, INC.,  
Appellant,

APPEAL NO. 14-2014-0018  
IPC No. 14-2010-00063  
Opposition to:

-versus-

Application No. 4-2009-009539  
Date Filed: 18 September 2009  
Trademark: TISDERAN

PFIZER A.G.,

Appellee.

x-----x

NOTICE

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**IPOPHL LIBRARY**  
Documentation, Information and  
Technology Transfer Bureau  
Intellectual Property Office  
Taguig City



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DATE: 9/26/2014  
BY: [Signature]

**NATHANIEL S. AREVALO**  
Director, Bureau of Legal Affairs  
Intellectual Property Office  
Taguig City

**GREETINGS:**

Please be informed that on 22 September 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 22 September 2014.

Very truly yours,

*[Signature]*

**ROBERT NEREO B. SAMSON**  
Attorney V

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*[Signature]*  
ROBERT NEREO B. SAMSON  
Attorney V  
Office of the Director General



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MEDICHEM PHARMACEUTICALS, INC.,  
Opposer-Appellant,

Appeal No. 14-2014-0018

-versus-

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PFIZER A. G.,

Opposition to:

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Date Filed: 18 September 2009

Respondent-Appellee.

Trademark: TISDERAN

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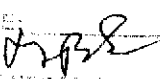
DECISION

MEDICHEM PHARMACEUTICALS, INC. ("Appellant") appeals the decision<sup>1</sup> of the Director of Bureau of Legal Affairs dismissing the Appellant's opposition to the registration of the mark "TISDERAN".

On 18 September 2009, PFIZER A. G. ("Appellee") filed Trademark Application No. 4-2009-009539 for TISDERAN for use on *pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides*. On 01 February 2010, the trademark application was published for opposition in the Intellectual Property Office Electronics Gazette for Trademarks.

On 03 March 2010, the Appellant filed a "VERIFIED OPPOSITION" claiming that it will be extremely damaged and prejudiced by the registration of TISDERAN. The Appellant alleged that TISDERAN so resembles its mark "TUSERAN" which was registered prior to the publication of TISDERAN. The Appellant claimed that TISDERAN will likely cause confusion, mistake and deception on the part of the purchasing public, especially considering that this mark is applied for the same class of goods as TUSERAN. The Appellant asserted that the registration of TISDERAN will violate Sec. 123 of the Intellectual Property Code of the Philippines ("IP Code") which provides that 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 result. The Appellant stated that the Appellee's use and registration of TISDERAN will diminish the distinctiveness and dilute the goodwill of TUSERAN.

<sup>1</sup> Decision No. 2014-73 dated 17 March 2014.

IPPHL  
CERTIFIED TRUE COPY  
DATE:   
ROBERT NEREC S. SAMSON  
ATTORNEY AT LAW  
Office of the Director General

Tisderan

The Bureau of Legal Affairs issued on 26 March 2010 a notice to the Appellee requiring it to answer the opposition. The Appellee did not file an answer and this case was submitted for decision.<sup>2</sup>

In dismissing the opposition, the Director held that the presence of the letter "U" in TUSERAN as against the letters "I" and "D" in TISDERAN confer upon the mark visual and aural properties that enable one to easily distinguish one mark from the other. The Director ruled that the Appellee's trademark application shows that the coverage of TISDERAN is not the same with that of TUSERAN. According to the Director, TUSERAN is more particular in covering non-narcotic cough while the goods covered by TISDERAN are baby food, medical supplies, and the like.

Not satisfied with the decision of the Director, the Appellant filed on 21 April 2014 an "APPEAL MEMORANDUM [Re: Decision No. 2014-73 dated 17 March 2014]" arguing among other things that the application for the registration of TISDERAN should be denied or deemed abandoned for failure of the Appellee to file the required Declaration of Actual Use ("DAU"). The Appellant attached to its appeal a certification issued by the Bureau of Trademarks that no DAU has been filed for TISDERAN.

In this regard, the Appellee's trademark application to register TISDERAN is considered refused because of the failure to file the required DAU. Sec. 124.2 of the IP Code states that:

124.2. The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director.

Consequently, this appeal is now deemed moot and academic and the Office need not decide this case on the merits. The Appellant in filing the opposition to the registration of TISDERAN seeks to prevent the registration of this mark in favor of the Appellee. However, in view of the certification issued by the Bureau of Trademarks showing the Appellee's failure to file the DAU, the Appellant's plea for the refusal of the Appellee's trademark application was practically granted.

In one case, the Supreme Court of the Philippines has ruled that:

For a court to exercise its power of adjudication, there must be an actual case or controversy - one which involves a conflict of legal rights, an assertion of opposite legal claims susceptible of judicial resolution; the case must not be moot or academic or based on extra-legal or other similar considerations not cognizable by a court of justice. A case becomes moot and academic when its purpose has become stale, such as the case before us.<sup>3</sup>

<sup>2</sup> Order No. 2012-1070 dated 24 July 2012.

<sup>3</sup> Dean Jose Joya, v. Presidential Commission on Good Government, G. R. No. 96541, 24 August 1993.


In this instance, no practical or useful purpose would be served by resolving the issues and merits in this case when the Appellee's trademark application is now considered refused. It is unnecessary to indulge in academic discussion of a case presenting a moot question as a judgment thereon cannot have any practical legal effect or, in the nature of things, cannot be enforced.<sup>4</sup>

Wherefore, premises considered, the appeal is hereby dismissed for the reasons discussed above.

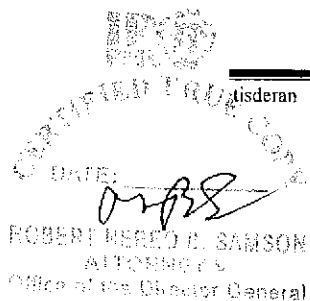
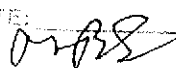
Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs and the Bureau of Trademarks for their appropriate action and consideration of the Appellee's failure to file the required DAU. Further, let also the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this decision for information, guidance, and records purposes.

SO ORDERED.

22 SEP 2014 Taguig City.

  
RICARDO R. BLANCAFLOR  
Director General

<sup>4</sup> Gerardo O. Lanuza, Jr. v. Ma. Vivian Yuchengco, G.R. No. 157033, 28 March 2005.

  
DATE:   
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