OFFICE OF THE DIRECTOR GENERAL

THERAPHARMA, INC.,
Appellant,

-versus-

BIOGEN IDEC MA INC.,
Appellee.
x----------x

APPEAL NO. 14-2013-0056
IPC No. 14-2010-00101
Opposition to:

Application No. 4-2009-009431
Date Filed: 18 September 2009
Trademark: AVONEX

NOTICE

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Documentation, Information and
Technology Transfer Bureau
Taguig City

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DATE: 9-29-2014
BY:

GREETINGS:

Please be informed that on 18 September 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 18 September 2014.

Very truly yours,

ROBERT NEREO B. SAMSON
Attorney V

OFFICE OF THE DIRECTOR GENERAL

THERAPHARMA, INC.,
Opposer-Appellant,

-versus-

BIOGEN IDEC MA INC.,
Respondent-Appellee.
x----------x

Appeal No. 14-2013-0056

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DECISION

THERAPHARMA, INC. ("Appellant") appeals the decision of the Director of Bureau of Legal Affairs ("Director") dismissing the Appellant's opposition to the registration of the mark "AVONEX".

Records show that BIOGEN IDEC MA INC. ("Appellee") filed on 18 September 2009 Trademark Application No. 4-2009-009431 for AVONEX for use on pharmaceutical preparations for use in the treatment of neurologic disorders. On 22 March 2010, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks. Subsequently, the Appellant filed on 21 May 2010 a "VERIFIED OPPOSITION" alleging that it will be extremely damaged and prejudiced by the registration of AVONEX.

The Appellant maintained that AVONEX so resembles its mark "AVAMAX" and will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that AVONEX is applied for the same class of goods as AVAMAX. The Appellant claimed that the registration of AVONEX will violate the Intellectual Property Code of the Philippines ("IP Code") which provides that any mark which is similar to a mark with an earlier filing date 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 Appellant asserted that the registration of AVONEX will diminish the distinctiveness of AVAMAX.

The Bureau of Legal Affairs ("BLA") issued a "NOTICE TO ANSWER" dated 08 June 2010 directing the Appellee to file a verified answer to the opposition within thirty (30) days from notice. The Appellee did not file an answer and the case was deemed submitted for decision.

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In dismissing the Appellant's opposition, the Director held that it is unlikely that the co-existence of AVAMAX and AVONEX will cause confusion and deception to the public. According to the Director, the visual and aural properties of the Appellee's mark are sufficient to distinguish it from the Appellant's mark, thus, diffusing the likelihood of confusion and deception.

On 09 December 2013, the Appellant filed an "APPEAL MEMORANDUM [Re: Decision No. 2013-211 dated 30 October 2013] contending that AVONEX is confusingly similar to AVAMAX. The Appellant argues that AVAMAX and AVONEX are practically identical marks in sound and appearance that they leave the same commercial impression upon the public and that these marks can easily be confused for one over the other, especially that AVONEX is applied for the same class and goods as AVAMAX.

This Office issued on 12 December 2013 an Order giving the Appellee thirty (30) days from receipt of the Order to submit comment on the appeal. The Appellee did not file its answer and the appeal was deemed submitted for decision.

While this Office is drafting the decision on this appeal, it noticed in the records that there is no Declaration of Actual Use ("DAU") for AVONEX. Accordingly, this Office requested information from the Bureau of Trademarks on whether the required DAU for AVONEX was filed by the Appellee.[1] On 17 June 2014, the Bureau of Trademarks issued a certification that no DAU had been filed for AVONEX.

The Appellee filed the application to register the mark AVONEX ON 18 September 2009. Hence, the Appellee has until 18 September 2012 to file the required DAU. In this regard, the Appellee's application to register the mark AVONEX is considered refused for her 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 AVONEX 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:

[1] Memorandum dated 13 June 2014.

> 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.[2]

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.[3]

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.

18 SEP 2014 Taguig City.

RICARDO R. BLANCAFLOR
Director General

[2] Dean Jose Joya, v. Presidential Commission on Good Government, G. R. No. 96541, 24 August 1993.
[3] Gerardo O. Lanuza, Jr. v. Ma. Vivian Yuchengco, G.R. No. 157033, 28 March 2005.