



OFFICE OF THE DIRECTOR GENERAL

BIOMEDIS, INC.,

Appellant,

-versus-

LITTMAN DRUG CORPORATION,  
Appellee.

X-----X

APPEAL NO. 14-2013-0016

IPC No. 14-2011-00248

Opposition to:

Application No. 4-2010-013251

Date Filed: 7 December 2010

Trademark: BEGESIC

NOTICE

OCHAVE & ESCALONA

Counsel for Appellant  
No. 66 United Street  
Mandaluyong City

PADLAN SALVADOR COLOMA  
& ASSOCIATES

Counsel for Appellee  
Suite 307, 3<sup>rd</sup> Flr, ITC Building  
337 Sen. Gil Puyat Avenue  
Makati City

NATHANIEL S. AREVALO

Director, Bureau of Legal Affairs  
Intellectual Property Office  
Taguig City

LENY B. RAZ

Director, Bureau of Trademarks  
Intellectual Property Office  
Taguig City

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DATE: DEC 18 2014

BY: *[Signature]*

GREETINGS:

Please be informed that on 15 December 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 15 December 2014.

Very truly yours,

ROBERT NEREO B. SAMSON

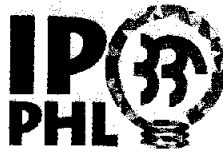
Attorney V



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ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE  
Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center  
Fort Bonifacio, Taguig City 1634 Philippines  
T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph



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**OCHAVE & ESCALONA**

Counsel for Appellant  
No. 66 United Street  
Mandaluyong City

**LENY B. RAZ**

Director, Bureau of Trademarks  
Intellectual Property Office  
Taguig City

**LITTMAN DRUG CORPORATION**

Appellee  
Unit 810 West Tower  
Philippine Stock Exchange Center,  
Exchange Road, Ortigas Center  
Pasig City

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**NATHANIEL S. AREVALO**

Director, Bureau of Legal Affairs  
Intellectual Property Office  
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Attorney V



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DATE:

**ROBERT NEREO B. SAMSON**  
ATTORNEY V  
Office of the Director General

Republic of the Philippines  
**INTELLECTUAL PROPERTY OFFICE**  
Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center  
Fort Bonifacio, Taguig City 1634 Philippines  
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## OFFICE OF THE DIRECTOR GENERAL

BIOMEDIS, INC.,

*Appellant,*

- versus -

LITTMAN DRUG CORPORATION,

*Appellee.*

X-----X

Appeal No. 14-2013-0016

IPC No. 14-2011-00248

Opposition to:

Application No. 4-2010-013251

Date Filed: 07 October 2010

Trademark: **BEGESIC**

## DECISION

BIOMEDIS, INC. ("Appellant") appeals Decision No. 2013-53, dated 25 March 2013, of the Director of the Bureau of Legal Affairs ("Director") dismissing its opposition to Trademark Application No. 4-2010-013251 for the mark "BEGESIC" for use on goods under Class 5<sup>1</sup>, namely "pharmaceutical preparations, namely, a topically-applied pain relieving cream that are made up of methyl salicylate and menthol, that is greaseless, non-staining and with pleasant smell", filed on 07 October 2010 by LITTMAN DRUG CORPORATION ("Appellee").

Upon publication of the subject trademark application on 30 May 2011, the Appellant filed on 27 July 2011 an Opposition, essentially alleging that it will be damaged by the registration of the Appellee's mark on account of its prior registered mark, "BIOGESIC". Citing Section 123.1, paragraph (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), the Appellant sought the denial of the subject trademark application on the ground that the Appellee's mark "BEGESIC" is confusingly similar to its registered mark. The Appellant based its opposition on its prior registration for "BIOGESIC" for "medicinal preparations composed of paracetamol and ascorbic acid" under Class 05, which was filed on 20 September 1965 and registered on 24 March 1966.

The Bureau of Legal Affairs issued a Notice to Answer and served a copy of the same upon the Appellee on 18 July 2011. Despite filing a letter requesting for an extension of the period to file the Answer, the Appellee filed such request out of time and failed to file the Answer thereafter. Thus, the case was deemed submitted for decision.

After the appropriate proceedings, the Director rendered the subject Decision, dismissing the Appellant's Opposition. The Director noted that at the time the Appellee filed its trademark application on 27 January 2011, the Appellant already



The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service 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 Registration of Marks, and was concluded in 1957.

DATE: *Jul*

**ROBERT NEREO B. SAMSON**  
ATTORNEY V  
Office of the Director General

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center  
Fort Bonifacio, Taguig City 1634 Philippines  
T: +632-2386300 • F: +632-7980114 • www.ipphil.gov.ph

had an existing trademark registration for the mark BIOGESIC under Certificate of Registration No. 12196 issued on 24 March 1966, and which was renewed on 24 March 2006. However, the Director found that it is unlikely that the co-existence of the two marks would cause confusion, much less deception, among the public.

Dissatisfied, the Appellant filed the subject appeal, seeking the reversal of the Director's Decision and praying that the Appellee's trademark application be denied. In its appeal, the Appellant argued that in determining confusing similarity between the subject marks, one cannot isolate the suffix "GESIC" and solely use the same as reference in determining whether or not the marks are confusingly similar. It maintained that its BIOGESIC is a coined mark; hence, the Director should have compared the trademark BIOGESIC in its entirety as against the Appellee's BEGESIC mark. The Appellant maintained that BEGESIC sounds almost the same as BIOGESIC; that the first and last five letters of the marks are exactly the same; and that the Appellee merely changed the letters "IO" in the Appellant's mark to "E" in arriving at its mark.

The issue to be resolved in this appeal is whether the Director was correct in dismissing the opposition on the ground that the competing marks do not resemble each other, such that confusion and deception is likely to occur.

In this regard, Sec. 123.1 paragraph (d) of the IP Code, states 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;

There is no dispute that the Appellant had registered in the Philippines the mark "BIOGESIC" prior to the filing of the Appellee's trademark application. Such trademark was registered for goods under Class 05, specifically "medicinal preparations composed of paracetamol and ascorbic acid". But the question to be resolved herein is whether the Appellee's mark being applied for is confusingly similar to the Appellant's registered mark, so as to present a likelihood that confusion and deception will occur.

Below are the marks subject of the trademark application of the Appellee and the trademark registration of the Appellant:

B e g e s i c

*Appellee's Trademark Application*

BIOGESIC

*Appellant's Registered Mark*



In trademark cases, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each

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ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General

case is decided on its own merits.<sup>2</sup> As the likelihood of confusion of goods is a relative concept, to be determined only according to the particular, and sometimes peculiar, circumstances of each case,<sup>3</sup> the complexities attendant to an accurate assessment of likelihood of confusion requires that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.<sup>4</sup>

In this regard, we find no cogent reason to disturb the findings of the Director. We agree that the the only commonality between the subject marks are the first letter "B" and the root word "GESIC". As the Director has pointed out, such root word was adopted from the word "analgesic" which refers to pain relievers, the intended effect or purpose of the products. As correctly held by the Director:

In the Opposer's [herein Appellant's] mark, the suffix "GESIC" is combined with the prefix "BIO". On the other hand, "GESIC" in the Respondent-Applicant's [herein Appellee's] mark follows the letters or syllable "BE". "BIO" is visually different from "BE". The straight vertical line and the sphere representing the letters "I" and "O", contrast with the vertical and horizontal lines comprising the letter "E". "BIO" also sounds different from "BE". "BIO" is pronounced as "bay-o", while "BE" simply sounds "beh".

That confusion, much less deception, is unlikely in this instant is highlighted by the fact that while the parties' respective products are both "analgesic", these goods differ in composition and in the nature of use or application. BIOGESIC represents a drug or medicine which is taken orally while the mark BEGESIC is used on a pharmaceutical product which is a topical application, hence, for external use. The consumers can easily see the difference between the products considering that BIOGESIC is not only an "analgesic" but also "antipyretic drugs" (fever reducers).

Although such root word "GESIC" may indicate to the consumers the goods or service, and/or the kind, nature, use or purpose thereof, the Appellee's mark BEGESIC may still be registered as a trademark. In the case of *Etepha, A. G. vs. Director of Patents and Westmont Pharmaceutical, Inc.*<sup>5</sup>, the Court held that a descriptive term in itself cannot be exclusively appropriated by anyone, and therefore cannot be registered as a trademark. However, the same case held that while a descriptive or generic term cannot thus be used exclusively to identify one's goods, it may properly become the subject of a trademark "by combination with another word or phrase" or even an additional prefix or suffix. In this case, we find that the Appellee's mark BEGESIC does not consist *exclusively* of signs or indications that are generic for the goods that they seek to identify, nor does it consist *exclusively* of signs or indications that designate the kind, quality, intended purpose, or other characteristics of such goods, so as to fall within the prohibition against the registration of descriptive or generic marks.

In addition, a person who would buy the Appellee's products would do so not on the basis of the mistaken belief that the product is that of the Appellant's, but because that is the product the person intends to buy. In this case, a very important circumstance to consider is whether there exists a likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the

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*Emerald Garment Manufacturing Corporation vs. Court of Appeals*, 251 SCRA 600 (1995).

*Standard Easter, Inc. vs. Court of Appeals*, 116 SCRA 336 (1982).

*Societe Des Produits Nestle, S.A., et al. vs. Court of Appeals, et al.*, G.R. No. 112012, 04 April 2001.

G.R. No. 20635, 31 March 1966.

DATE: 

ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General


source of the goods in question.<sup>6</sup> The "purchaser" is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved.<sup>7</sup> In one case decided by the Supreme Court, it was held that the ordinary purchaser must be thought of, as having, and credited with, at least a modicum of intelligence.<sup>8</sup> This principle is to be emphasized in this case, as the goods involved are not everyday common goods which are easily dispensed and bought at a minimal cost.<sup>9</sup> Rather, the subject products are pharmaceutical products which are available only in drug stores and dispensed with the intervention of professionals having knowledge of their indications and intended effects. The foregoing circumstances taken together, the likelihood of confusion as to the Appellee's and the Appellant's marks is remote.

Finally, this Office likewise notes the common practice of pharmaceutical companies of adopting trademarks for their product that reflect or resemble the product's generic name, the predominant chemical compound contained in the pharmaceutical preparation, the ailments sought to be treated, or the intended medical relief. As held by the Director, considering that the only similarity between the competing marks is the suffix "GESIC", sustaining the Appellant's opposition would have the unintended effect of giving the Appellant the exclusive right to use "GESIC", which is contrary to the principles of the trademark system. In fact, this Office takes further note that other prior trademark registrations exist for marks using the suffix "gesic" for pharmaceutical preparations, which are not owned by the Appellant.<sup>10</sup>

**WHEREFORE**, premises considered, the appeal is hereby **DISMISSED**. Let a copy of this Decision and the records of this case be furnished and returned to the Director of Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and 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.

DEC 15 2014. Taguig City.

  
**RICARDO R. BLANCAFLOR**  
Director General

<sup>6</sup> *Mighty Corporation vs. E & J Gallo Winery*, citing *Mushroom Makers, Inc. vs. R.G. Barry Corp.*, 580 F. 2d 44, 47 (2d Cir. 1978), cert. denied, 439 U.S. 1116, 99 s. Ct. 1022, 59 L. Ed. 2d 75 [1979].

<sup>7</sup> *Mighty Corporation vs. E & J Gallo Winery*, citing *Emerald Garment Manufacturing Corporation vs. Court of Appeals*, 251 SCRA 600 [1995].

<sup>8</sup> *Fruit of the Loom, Inc. vs. Court of Appeals and General Garments Corp.*, G.R. No. L-32747, 29 November 1984.

<sup>9</sup> See *Etepha, A. G. vs. Director of Patents and Westmont Pharmaceutical, Inc.*, G.R. No. L-20635, 31 March 1966.

<sup>10</sup> Among which are: KIDDIGESIC under Registration Nos. 42012007320 and 42009005547; OXYGESIC under Registration No. 42012001910; CORTALGESIC under Registration No. 42011001838; EXELGESIC under Registration Nos. 42009007164 and 42006007756; GEOGESIC under Registration No. 42008710025; QUALIGESIC under Registration No. 42009000561; PAUGESIC under Registration No. 42008006560; NASAGESIC under Registration No. 42008001639; MEFAROGESIC under Registration No. 42006013557; NAPROGESIC under Registration No. 42007007335; STANGESIC under Registration No. 42005007729; VAMGESIC under Registration No. 42005007943; RECTOGESIC under Registration No. 42000007649; DOLGESIC under Registration No. 42004006583; ACTIGESIC under Registration No. 41996114809; SKYGESIC under Registration No. 41996109550; WELCOGESIC under Registration No. 060511; DUROGESIC under Registration No. 056596; SUMAGESIC under Registration No. 014855; OPOGESIC APAP under Registration No. 022630, all under Class goods.



DATE: 

**ROBERT NEREO B. SAMSON**  
ATTORNEY V  
Office of the Director General