



BIOMEDIS INC.,
Opposer,

-versus-

WESTFIELD PHARMACEUTICAL INC.,
Respondent- Applicant.

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}
} IPC No. 14-2015-00093
} Opposition to:
} Appln. Serial No. 4-2014-00013646
} Date Filed: 03 November 2014
} TM: "AVICLAV"
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}
}

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
No. 66 United Street
Mandaluyong City

WESTFIELD PHARMACEUTICAL INC.
Respondent- Applicant
No. 831-A Eugenio Lopez St. corner EDSA
Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 174 dated June 07, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 14, 2016.

For the Director:

Edwin O. Datin
Atty. EDWIN DANILO A. DATIN G
Director III
Bureau of Legal Affairs

BIOMEDIS INC.,
Opposer,

- versus -

WESTFIELD PHARMACEUTICAL INC.,
Respondent-Applicant.

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IPC No. 14-2015-00093
Opposition to:

Appln. No. 4-2014-00013646
Date Filed: 03 November 2014
Trademark : "AVICLAV"

Decision No. 2016 - 174

DECISION

BIOMEDIS INC. ("Opposer"),¹ filed on 18 February 2015 a verified opposition to Trademark Application Serial No. 4-2014-00013646. The application, filed by WESTFIELD PHARMACEUTICAL INC. ("Respondent-Applicant")², covers the mark "AVICLAV" for use on goods under class 05³ namely: *anti-bacterial*.

The Opposer alleges the following grounds for opposition:

"7. The mark 'AVICLAV' applied for by Respondent-Applicant so resembles the trademark 'AMOCLAV' owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark 'AVICLAV'.

"8. The mark 'AVICLAV' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'AVICLAV' is applied for the same class and goods as that of Opposer's trademark 'AMOCLAV', i.e., Class 05 of the International Classification of Goods for use as an antibacterial.

"9. The registration of the mark 'AVICLAV' in the name of the Respondent-Applicant will violate Sec. 123.1.(d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

"x x x

(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;

xxx" (Emphasis supplied)

"10. 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

¹ A domestic corporation organized and existing under the laws of Republic of the Philippines with office address at 108 Rada Street, Dynavision Building, Legaspi Village, Makati City, Metro Manila.

² With address at 831-A Eugenio Lopez St. corner EDSA, Quezon City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"11. Respondent-Applicant's use and registration of the mark 'AVICLAV' will diminish the distinctiveness of Opposer's trademark 'AMOCLAV'."

The Opposer's evidence consists of the following:

1. Publication of Respondent-Applicant's trademark application in the Intellectual Property Office ("IPO") E-Gazette;
2. Certified true copy (Ctc) of Certificate of Registration No. 4-1999-003627 for AMOCLAV;
3. Copies of the Declaration of Actual use and Affidavit of Use;
4. Ctc of Product Registration No. DR-XY23657;
5. Sample product label bearing the trademark AMOCLAV; and,
6. Original copy of the Certification and sales performance issued by the IMS.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer dated 03 March 2015 which was received by the Respondent-Applicant's agent on 12 March 2015. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.⁴

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

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 03 November 2014⁵, the Opposer has already an existing trademark registration for the mark AMOCLAV bearing Registration No. 4-1999-003627 dated 01 July 2005⁶ in the Philippines. It has also filed Declarations of Actual Use within 3 years from filing date⁷, and in the 5th year anniversary.⁸ Significantly, this Bureau noticed that the Respondent-Applicant's trademark application indicates that AVICLAV is or will be used as "anti-bacterial". AVICLAV usage therefore, covers similar or closely related to those bearing the mark AMOCLAV.

Nevertheless, it is unlikely that the co-existence of the marks will cause confusion, much less deception, among the public. The only similarities between the marks, as shown below,

AmoClav

AVICLAV

Opposer's Trademark

Respondent-Applicant's Trademark

⁴ Order No. 2015-1108 dated 29 July 2015.

⁵ Filewrapper records.

⁶ Exhibit "A" of Opposer.

⁷ Exhibit "C" of Opposer.

⁸ Exhibit "D" of Opposer.

are the first letter "A" and the suffix "CLAV".

In this regard, it appears that the suffix "CLAV" is not an accurate indicator of the existence of confusing similarity between the marks because the suffix is common in drugs or medicine, over which the Opposer cannot claim exclusive rights. The suffix "CLAV" is obviously derived from the substance "*clavulanic acid*". In fact, the Opposer's sample product packaging shows that AMOCLAV's generic name is "CO-AMOXICLAV", its formulation consisting of "*amoxicillin*" and "*clavulanic acid*".⁹ It is a fair inference that AMOCLAV is just a contraction of "AMOXICLAV" and/or combination of "AMO" (from "*amoxicillin*") and "Clav" (from "*clavulanic acid*").

AMOXICLAV thus, is not highly distinctive as a trademark. At most, it is considered a suggestive mark, which is a weak mark. What will set apart or distinguish such mark from another mark which also includes the same suffix, are the letters and/or syllable that precede "CLAV". In this instant, it is very unlikely that a consumer will be misled or confused into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's. The Respondent-Applicant's mark starts with the letters or syllables "AVI" which are so much different, visually and aurally, from "AMO" in the Opposer's mark.

The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.¹⁰ This Bureau finds the Respondent-Applicant's mark consistent with this function.

Moreover, taking into account that the similarity between the competing marks is the suffix "CLAV", sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive rights to use "CLAV".

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-013646 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 June 2016.


Atty. **NATHANIEL S. AREVALO**
Director *W*, Bureau of Legal Affairs

⁹ Exhibit "E" of Opposer.

¹⁰ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.