BIOMEDIS, INC., Opposer, **-versus-** **RANDRIL INTERNATIONAL CO., INC.,** Respondent-Applicant.	}	**IPC No. 14-2009-00037** Opposition to: Appln. Serial No. 4-2006-013723 Date filed: 21December 2006 **TM: MELOFLAM** **(LABEL MARK)**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 88 dated May 08, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 08, 2012.

For the Director:

Atty. ADORACION U. ZARE
Hearing Officer, BLA

CERTIFIED TRUE COPY
SHARON S. ALCANTARA
Records Officer II

BIOMEDIS, INC.,	}	**IPC No. 14-2009-00037**
Opposer,	}	Opposition to:
	}	
- versus -	}	Appln. Ser. No. 4-2006-013723
	}	Date Filed: 21 December 2006
RANDRIL INTERNATIONAL CO., INC.,	}	Trademark: **MELOFLAM (LABEL MARK)**
Respondent-Applicant.	}	Decision No. 2012 - 88
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DECISION

BIOMEDIS, INC.[1] ("Opposer") filed on 02 February 2009 a Verified Opposition to Trademark Application No. 4-2006-013723. The application, filed by RANDRIL INTERNATIONAL CO., INC.[2] ("Respondent-Applicant"), covers the mark MELOFLAM (LABEL MARK) for use on *"pharmaceutical product – non-steroidal anti-inflammatory"* under Class 05 of the International Classification of Goods[3].

The Opposer alleges the following:

> "1. The trademark MELOFLAM so resembles MELOCAM trademark owned by Opposer, which was applied for registration with this Honorable Office prior to the application of the mark MELOFLAM. 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 MELOFLAM 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 MELOFLAM 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:
>
> x x x
>
> 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

[1] A corporation duly organized and existing under the laws of the Philippines with principal office located at 750 Shaw Boulevard, Mandaluyong City.

[2] A domestic corporation with principal office address at Uni 2205-A 22nd Floor, West Tower, Philippine Stock Exchange Center, Pasig City.

[3] The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

MELOFLAM will diminish the distinctiveness of Opposer's trademark MELOCAM."

The Opposer's evidence consists of print-out from IPO E-Gazette of Trademarks Published for Opposition released on 03 October 2008 and copy of Certificate of Registration No. 4-2006-005904 for the trademark MELOCAM.

The Respondent-Applicant filed its Answer on 15 June 2009 alleging the following affirmative defenses:

"2.1 The competing marks are different, i.e. MELOFLAM for the Respondent which contains MELOXICAM and used as an anti-inflammatory agent. MELOFLAM for the Respondent means to mellow down inflammation.

"2.2 Moreover, it is respectfully submitted that both parties have actually taken the dominant features of the generic name of the active ingredient – MELOXICAM, i.e.:

a) Opposer removed the letters "XI" to become MELOCAM; while
b) Respondent removed the letters "XIC" and replaced the same with the letters "FL" to become MELOFLAM.

"2.3 It is then interesting to note that under Section 123.1 (h) of the Intellectual Property Code, a generic mark can never be appropriated as one's own mark and much more be registered. Consequently, the mark registered in the name of the Opposer is a weak mark considering the fact that it is simply a derivative of the generic name (MELOCAM vs. MELOXICAM). Thus, to allow the Opposer to win in this case will run contrary to the spirit of the provision of the said law by allowing in essence the protection of the use of a derivative of a generic name.

"2.4 On another point, there is no question that for both products, the prescription of a physician is required. Thus, it is very remote for a physician to be confused to prescribe MELOFLAM for MELOCAM as most of the doctors have personal preferences with respect to certain types of medicines such as anti-inflammatory drugs.

"2.5 This is very important because under the Generics Law, physicians are required to issue prescriptions using the generic name (active ingredients) being the primary consideration. If the said physicians prefer a certain product, he may write the trademark in the prescription as a secondary consideration.

"2.6 It is also required that when the patient presents his prescription, the pharmacist in the drug store will compare the generic name in the prescription to the generic name in product as identified by the trademark in the prescription. It is also required that when the drug store has no available product identified in the prescription under the preferred trademark, the pharmacist must present a list of products sold under the same generic name but with different trademark(s). With this requirement, confusion is very much remote.

"2.7 Furthermore, from the wrapper of RANDRIL, it is very clear that these products are distributed by Randril International Co., the Respondent. Moreover, it is also very clear that the said products are manufactured by Lloyds Laboratories and licensed from Rhiza Laboratories. No where in Randril's packaging can one find any clues of leads our products came from the Opposer.

"2.8 Products of the Respondent under the name MELOFLAM have been in the market since March 2007 as shown by the delivery receipt to Mercury Drug. Since then, no confusion has been reported.

The Respondent-Applicant's evidence consists of the Affidavit of Sonny Bob Cardinal, actual packaging of MELOFLAM and copy of Delivery Receipt issued to Mercury Drug Corporation dated 14 March 2007.

The preliminary conference was set on 25 August 2009 but the Respondent-Applicant failed to appear. Thus, the preliminary conference was terminated and considered Respondent-Applicant to have waived the right to submit position paper.

Should the Respondent-Applicant's trademark application be allowed?

The Opposer anchored its opposition on Section 123.1 (d) of the Intellectual Property Code ("IP 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, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, records and evidence show that at the time the Respondent-Applicant filed its trademark application on 21 December 2006, the Opposer's sister company and predecessor-in-interest, MEDICHEM PHARMACEUTICALS, INC., already has pending application for the trademark MELOCAM filed on 05 June 2006. The said trademark application ripen into registration on 30 April 2007 and valid for a period of ten (10) years until it was assigned to herein Opposer by virtue of the Assignment of Registered Trademark[4] filed with this Office on 15 December 2008. The Respondent-Applicant's trademark application covers goods that are similar or closely related to those indicated in the Opposer's trademark registration, particularly *"antirheumatic, anti-inflammatory and analgesic pharmaceutical preparation"*. Be that as it may, this Bureau finds that the Respondent-Applicant should be allowed to register the trademark MELOFLAM.

The only similarity between the competing marks exists in the first two (2) syllables comprising the prefix "MELO". In this regard, this Bureau noticed that "MELO" as component of a mark used for anti-inflammatory treatment is obviously derived from its generic name MELOXICAM. "MELO" therefore is not unique as a mark or part thereof for pharmaceutical products or drugs bearing

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[4] Attached to the Motion for Substitution filed by Opposer on 02 February 2009 and marked as Annex A"

the generic name MELOXICAM. Indeed, "MELO" is merely suggestive that it originate from its generic name MELOXICAM used as anti-inflammatory drug and therefore cannot be exclusively appropriated.

Moreover, the last syllable in the Respondent-Applicant's mark "FLAM" gives a character visually and aurally different from the Opposer's "CAM". There being a difference in the other components of the parties' respective marks, it is unlikely for the consumers of goods to commit mistake or be confused.

It is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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.[5]

Clearly, the Respondent-Applicant's mark satisfied this function test.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED.** Let the filewrapper of Trademark Application No. 4-2006-013723, together with a copy of this Decision, be returned to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Taguig City, 08 May 2012.

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

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[5] *Pribhdas J. Mirpuri v. Court of Appeals,* G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez,* 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).