



BIOMEDIS, INC.,  
Opposer,

-versus-

GLAXOSMITHKLINE TRADING  
SERVICES LIMITED,  
Respondent- Applicant.

X-----X

} IPC No. 14-2013-00025  
} Opposition to:  
} Appln. Serial No. 4-2012-010389

} TM: "MEROPIDEL"

### NOTICE OF DECISION

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

**ORTEGA BACORRO ODULIO CALMA & CARBONELL**  
Counsel for the Respondent-Applicant  
5<sup>th</sup> & 6<sup>th</sup> Floors, ALPAP I Building  
140 L.P. Leviste Street, Salcedo Village  
Makati City

### GREETINGS:

Please be informed that Decision No. 2016 - 238 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:

  
Atty. **EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs

**BIOMEDIS, INC.,**

Opposer,

- versus -

**IPC NO. 14 - 2013 - 00025**

Opposition to:

Trademark Application Serial No.  
42012010389

**GLAXOSMITHKLINE  
SERVICES LIMITED,**

**TRADING**

**TM: "MEROPIDEL"**

Respondent-Applicant.

**DECISION NO. 2016 - 238**

X-----X

## DECISION

BIOMEDIS, INC. (Opposer)<sup>1</sup> filed an Opposition to Trademark Application Serial No. 4-2012-010389. The trademark application filed by GLAXOSMITHKLINE TRADING SERVICES LIMITED (Respondent-Applicant)<sup>2</sup>, covers the mark MEROPIDEL for "*pharmaceutical preparation and substances*" under Class 5 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer based its Opposition on the following grounds:

- 1.) The mark "MEROPIDEL" applied for by Respondent-Applicant so resembles the trademark "MEROP" owned by Opposer and duly registered with this Honorable Office prior to the publication of the application for the mark "MEROPIDEL."
- 2.) The mark "MEROPIDEL" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "MEROPIDEL" is applied for the same class and goods as that of Opposer's trademark "MEROP", i.e. Class 05 of the International Classification of Goods for Pharmaceutical Preparations.
- 3.) The registration of the mark "MEROPIDEL" in the name of the Respondent-Applicant will violate Sec 123 of the IP Code.

<sup>1</sup> A company organized and existing by virtue of and under the laws of Philippines with office address at 6<sup>th</sup> Floor, Dynavision Building, 108 Rada Street Legazpi Village, Makati City.

<sup>2</sup> A foreign corporation with office address at 6900 Cork Airport Business Park, Kinsale, Cork Ireland

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.



The Opposer further alleges:

“11. Opposer is the owner of the trademark ‘MEROP.’ It is engaged in the marketing and sale of a wide range of pharmaceutical products.

11.1 The trademark application for the trademark ‘MEROP’ was filed with the IPO on 9 January 2008 and was approved for registration on 19 January 2009 to be valid for a period of 10 years, or until 19 January 2019. Thus, the registration of the trademark ‘MEROP’ subsists and remains valid to date. x x x

“12. The trademark ‘MEROP’ has been extensively used in commerce in the Philippines. x x x

“13. As provided in Section 138 of the IP Code, “A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.”

“14. The registration of Respondent-Applicant’s mark ‘MEROPIDEL’ will be contrary to Section 123.1 (d) of the IP Code. ‘MEROPIDEL’ is confusingly similar to Opposer’s trademark ‘MEROP.’ x x x

“15. To allow Respondent-Applicant to continue to market its products bearing the mark ‘MEROPIDEL’ undermines Opposer’s right to its trademark ‘MEROP.’ As the lawful owner of the trademark ‘MEROP’, Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public. x x x

“16. The registration and use of Respondent-Applicant’s confusingly similar mark ‘MEROPIDEL’ on its goods will enable the latter to obtain benefit from Opposer’s reputation and goodwill, and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with the Opposer.

“17. In case of grave doubt, the rule is that, ‘[a]s between a newcomer who by confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.’

“18. Respondent-Applicant’s use of the mark ‘MEROPIDEL’ in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer’s trademark ‘MEROP’, will undermine the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of



its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'MEROPIDEL.'

"19. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'MEROPIDEL.'"

To support its Opposition, the Opposer submitted the following as evidence:

Exhibit "A" – copy of the pertinent page of the IPO E-Gazette;

Exhibit "B" – certified true copy of the Certificate of Registration No. 4-2008-000272 for the trademark MEROP;

Exhibit "C" – certified true copy of the Declaration of Actual Use;

Exhibit "D" – a sample of the product label bearing the trademark MEROP; and

Exhibit "E" – certified true copy of the Certificate of Product Registration for MEROP;

This Bureau issued and served a Notice to Answer to the Respondent-Applicant on 28 February 2013. On 25 March 2013, Respondent-Applicant filed a Motion for Extension of Time to File Verified Answer until 29 April 2013, which was granted by this Office. However, the Respondent-Applicant still failed to file an Answer to the Opposition. In view of the failure to file an Answer, an Order dated 9 September 2013 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The basic issue to be resolved in the instant case is whether Respondent-Applicant's trademark MEROPIDEL should be allowed for registration.

The competing marks are reproduced below for comparison:

**Merop**

**MEROPIDEL**

Opposer's Trademark

Respondent-Applicant's Trademark

The instant Opposition is anchored on Section 123.1, paragraph (d), of the 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 mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed her trademark application on 24 August 2012, the Opposer has already a prior and existing trademark registration for the mark MEROP. Nevertheless, this Bureau finds that it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public.



Both the mark starts with the prefix "MEROP." In this regard, there is sufficient reason to infer and conclude that the common prefix came from "MEROPENEM", which is the generic name for the pharmaceutical products subject of the two trademarks. Thus, the said trademarks are suggestive mark and therefore a weak mark with respect to medical goods or services. It readily gives away or tells the consumers the goods or service, and/or the kind, nature, use or purpose thereof. The Opposition therefore cannot be sustained solely on account of the marks having the same prefix ("MEROP") because to do so would have the unintended effect of giving the Opposer practically the exclusive right to use "MEROP" which obviously refers to the generic name.

Hence, what will set apart or distinguish the two trademarks that both contain the prefix "MEROP" and used on similar or related goods are the letters and/or syllables that succeed or accompany the said prefix. In the instant case, Respondent-Applicant's mark contains an additional suffix *-IDEL* which provides a differentiating effect visually and phonetically from the two syllabic "MEROP" mark of the Opposer.

Undoubtedly, the clear variances in the additional letters at the latter portion of the Respondent-Applicant's word mark are sufficient safeguard in order not to misled or confused the consumer into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's.

Time and again, it has been held in our jurisdiction that 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. This Bureau finds the Respondent-Applicant's mark consistent with this function.

**WHEREFORE**, premises considered, the instant Opposition to the Trademark Application No. 42012010389 is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 42012010389 be returned together with a copy of this **DECISION** to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 30 JUN 2016

  
**ATTY. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs