

BIOMEDIS, INC.,
Opposer,

-versus-

AAA PHARMA, INC.,
Respondent- Applicant.

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}
} **IPC No. 14-2014-00193**
} Opposition to:
} Application No. 4-2013-502775
} Date Filed: 25 September 2013
} Trademark: "EXCIT"

NOTICE OF DECISION

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

AAA PHARMA, INC.
Respondent-Applicant
105 Maryland Street
Cubao, Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 376 dated October 13, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 13, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

BIOMEDIS, INC.
Opposer,

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AAA PHARMA, INC.
Respondent-Applicant.

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IPC NO. 14-2014-00193

Opposition to:
Appln. Ser. No. 4-2013-502775
Filing Date: 25 September 2013
Trademark: **EXCIT**

Decision No. 2016 - 376

DECISION

BIOMEDIS, INC.¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2013-502775 . The application, filed by AAA PHARMA, INC.² ("Respondent-Applicant") covers the mark EXCIT for use on "*urinary alkaliners*" under Class 05 of the International Classification of goods³.

The Opposer alleges that the mark EXCIT of Respondent-Applicant so resembles the trademark TASCIT owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark EXCIT as to likely cause confusion, mistake and deception on the part of the purchasing public. Thus, its registration will violate of Sec. 123.1 (d) of the IP Code which prohibits the registration of a mark similar to a prior registered mark for similar or related goods.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Copy of the pertinent page of IPO e-Gazette dated 14 April 2014;
2. Exhibit "B" - Copy of Certificate of Registration No. 4-2008-008885 for the mark TASCIT;
3. Exhibits "C" and "C-1"- certified true copies of the Declaration of Actual Use and Affidavit of use for the 5th anniversary;
4. Exhibit "D" - Sample of product label bearing the trademark "TASCIT" actually used in commerce; and
5. Exhibit "E" - Certification issued by the IMS Health; and
6. Exhibits "F" - certified copy of Certificate of Product Registration for the drug TASCIT issued by BFAD;

On 23 May 2014, this Bureau issued a Notice to Answer and personally served it to Respondent-Applicant on 13 June 2014. Despite the receipt of Notice, Respondent-Applicant failed to file an answer. Accordingly, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at Dynavision Building, 108 Rada Street, Legaspi Village, Makati City.

² A domestic corporation with address at 105 Maryland Street, Cubao, Quezon City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark 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 the Registration of Marks concluded in 1957.

the Opposer.

Should the Respondent-Applicant be allowed to register the mark EXCIT?

Sec. 123.1 (d) of Republic Act No. 8293, also known as the "Intellectual Property Code of the Philippines (IP Code)", as amended provides:

Section 123. Registrability. — 123.1. 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;

The records will show that at the time the Respondent-Applicant filed its application for the mark EXCIT on 25 September 2013, the Opposer already has an existing registration for the trademark TASCIT issued on 17 November 2008. Opposer's mark TASCIT is used in goods falling under Class 05 namely, "pharmaceutical preparation indicated for the management of renal tubular acidosis (RTA) with calcium stones, hypocitrauric calcium oxate nephrolithiasis of any etiology and uric acid lithiasis with or without calcium stones." On the other hand, Respondent-Applicant's mark EXCIT is used in "urinary alkaliners" also falling under Class 05. "Urinary alkaliners" treats and prevents kidney stones by lowering the amount of acid in urine.⁴ Since the goods of the parties relate to treatment of kidney disease, they are similar or closely related goods.

But are the marks of the parties similar as to likely cause confusion, mistake or deception on the public?

The competing marks are reproduced below:

Tascit

Opposer's Mark

EXCIT

Respondent-Applicant's Mark

Both Opposer's and Respondent-Applicant's marks contain two syllables, "TAS-CIT" and "EX-CIT". The first syllable of Opposer's mark is "TAS" while that of Respondent-Applicant is "EX" and they have identical last syllable "CIT". Despite their similarity with respect to the last syllable, this Bureau finds that it is insufficient to establish a finding of confusing similarity between the competing marks to sustain the opposition. The syllable "CIT", which is short for "citrate", is derived from the generic name *potassium citrate*, Opposer's pharmaceutical drug bearing the mark TASCIT. Citrate is a "salt or ester of citric acid; used as anticoagulants because they bind calcium ions."⁵ As such, Opposer cannot claim exclusive use thereof. When combined with

⁴<http://pennstatehershey.adam.com/content.aspx?productId=45&pid=45&gid=5259>

⁵ citrate. (n.d.) *Miller-Keane Encyclopedia and Dictionary of Medicine, Nursing, and Allied Health, Seventh Edition*. (2003). Retrieved October 10 2016 from <http://medical-dictionary.thefreedictionary.com/citrate>

a different first syllable such as the "EX" to form the word EXCIT, Respondent-Applicant's mark, is distinctive enough as to effectively identify the source of the goods or services. Further, when pronounced, the marks of the parties are not phonetically the same such that the consuming public will **not** likely be confused, mistaken or deceived into thinking that Respondent-Applicant's goods bearing the mark EXCIT originated, sponsored or manufactured by Opposer.


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.⁶ Respondent-Applicant's mark meet this function.

Accordingly, the registration of the Respondent-Applicant's mark is not proscribed under Section 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **DENIED**. Let the filewrapper of Trademark Application Serial No. 4-2013-502775, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **13 OCT 2016**


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.