



BOEHRINGER INGELHEIM
PHARMA GMBH & CO. KG,
Opposer,

-versus-

MEDLINK PHARMA PHILS., INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2009-00139

Opposition to:

Appln. Serial No. 4-2008-005313

Date filed : 07 May 2008

TM: "BUSCOMED"

CASTILLO LAMAN TAN PANTALEON
& SAN JOSE LAW OFFICE

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BY: *[Signature]*

NOTICE OF DECISION

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[Signature] 12-14-2010
1010 PASTOR FIDE

GREETINGS:

Please be informed that Decision No. 2010 - 73 dated 18 November 2010
(copy enclosed) was promulgated in the above entitled case.

Makati City, 18 November 2010.

For the Director:

ATTY. PAUSI U. SAPAK
Hearing Officer, BLA



BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG,	}	IPC No. 14-2009-00139
Opposer,	}	Opposition to:
	}	
- versus -	}	Serial No. 4-2008-005313
	}	Date Filed: 07 May 2008
	}	
MEDLINK PHARMA PHILS., INC.,	}	Trademark: " BUSCOMED "
Respondent-Applicant.	}	
X-----X		Decision No. 2010 - <u>73</u>

DECISION

BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG ("Opposer"), a foreign limited partnership, organized and existing under the laws of Federal Republic of Germany, with principal office at Binger Strasse 173, 55216 Ingelheim, Germany, filed on 18 May 2009 an opposition to Trademark Application Serial No. 4-2008-005313. The trademark application, filed by **MEDLINK PHARMA PHILS. INC.** ("Respondent-Applicant"), a domestic corporation with principal address or place of business at Suite 2002, 20th Floor, Strata Building, Emerald Avenue, Ortigas, Pasig City on 07 May 2008, covers pharmaceuticals drug consisting of "*hyoscine-N-butylbromide*" under Class 5 of the International Classification of Goods.¹

The Opposer alleges the following:

"1. Opposer brings the present action pursuant to Section 2, Article II of the Philippine Constitution, which provides that the Philippines adopts, among others, the generally accepted principles of international law as part of the law of the land and adheres to the policy of peace, equality, justice, freedom, cooperation and unity with all nations. Furthermore, Section 3 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, grants a right in favor of Opposer to seek redress before Philippine courts and quasi-judicial agencies insofar as its states that:

International Conventions and Reciprocity. - Any person who is a national or who is domiciled or has a real and effective industrial establishment in

¹ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a multi-lateral 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 purposes of the registration of Marks concluded in 1957.

a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extend reciprocal rights to nationals of the Philippines by law, shall be entitled to benefit to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act.

"2. Opposer is the owner of the trademark Buscopan for its product featuring the active ingredient *hyoscine-N-butylbromide*, an antispasmodic medication which specifically relieves abdominal discomfort and pain due to cramps and spasm. The Opposer developed this product from the pharmaceutically important *alkaloid scopolamine* contained in the dried leaves and stalks of an Australian native tree, known as the corkwood tree or *Duboisia*. The active precursor substance *scopolamine* is converted in a single chemical process into *hyoscine butylbromide*, the active ingredient of Buscopan.

"3. In 1951, the new medication was ready for commercial production. Buscopan, a coined word chosen to identify this pharmaceutical preparation that was developed by Opposer, was adopted so that the product by that name could be launched the following year. Opposer ingeniously crafted the trademark by taking the first syllables of butyl and scopolamine to be prefixed to pan for pain – thus, BUSCOPAN. Buscopan is currently available in more than 100 countries around the world, in nearly half of them as a prescription-free/over-the-counter medicine. In Spanish-speaking countries, it is sold under the name Buscapina. Opposer also offers a combination of *butylscopolamine* and *acetaminophen*, marketed under the name Buscopan Plus. It is therefore obvious that what is distinctive about Opposer's mark is the prefix BUSCO, which refers to *butylscopolamine*, and which it retains for other trademarks for *butylscopolamine* in other territories.

"4. Buscopan is available in a number of different formulations – *e. g.* with additional pain relievers – and in different forms – tablets, drops, syrup and, for health professionals only, in ampules for injection. Opposer has registered the trademark Buscopan with the Intellectual Property Office of the Philippines and was granted Certificate of Trademark Registration No. 12403 on August 4, 1966 for goods under Class 5 of the Nice Classification of Goods (specifically, medicines; antispasmodics). The latest Certificate of Renewal for the Trademark was issued on August 4, 2006, which is good for another ten (10) years from the date of issuance.

"5. Buscopan has been listed in Drugs.com, Medic8.com, Mims.com and NetDoctor.co.uk. Buscopan has become internationally well-known not only as an effective anti-spasmodic for both gastric and urinary spasms, but also as a mark associated with Opposer which has been respected and known to produce reliable and effective drugs. Buscopan together with Dulcolax and Mucosolvan are the three international key Consumer Health Care products of the Opposer. In fact, Buscopan has its own dedicated international website, www.buscopan.com, which informs patients and visitors to the website about the product Buscopan and how it works. Buscopan, also has local websites in Argentina, Australia, Brazil, Ecuador, Germany, Great Britain, Mexico, South Africa, South Korea and Spain.

"6. The Opposer reported total net sales of EUR 11.6 billion for 2008, which is 5.9% higher than its net sales in 2007. The Consumer Health Care business contributed EUR 569 million to the net sales of the first half of 2008. A worldwide total net sale of EUR 10,952 million in 2007 was reported by the Opposer. The Consumer Health Care self-modification business developed positively with turnover growth of 7.2% (in Euro terms) in 2007 to EUR 1,141 million, with the Opposer's international core brands Dulcolax and Buscopan continuing their gratifying development. Strong growth in the Europe market versus 2006 came from flagship brands Dulcolax (+16%), Buscopan (+ 9%) and Antistax (+11%). For 2007, Buscopan contributed EUR 77 million to the Opposer's total net income. The Buscopan brand continued its international development through line extensions in different consumer-relevant indications.

"7. In this case, the marks are used on exactly the same goods: antispasmodic pharmaceutical drug consisting of *hyoscine-N-butylbromide* or *butylscopolamine*. Buscomed is confusingly similar with Buscopan, such that Buscomed's presence in the market would likely cause confusion in the minds of the prescribing specialists, pharmacists and patients, and deceptively confuse consumers as to its origin. Following the *idem sonans* rule, Buscomed sounds like Opposer's mark Buscopan. Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia & Co.*, the High Court overturned the decision of the then Director of Patents that granted the registration of LIONPAS, as it surely could not have been denied that SALONPAS and LIONPAS, when spoken, sound very much alike. According to the High Court:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, Vol. 1, will reinforce our view that SALONPAS and LIONPAS

are confusingly similar in sound; Gold Dust and Gold Drop; Jantzen and Jass-Sea; Silver Flash and Supper Flash; Cascarete and Celborite; Celluloid and Cellonite; Chartreuse and Charseurs; Cutex and Cuticlean; Hebe and Meje; Kotex and Femetex; Zuso and Hoo Hoo. Leon Amdur, in his book Trade-Mark Law and Practice, pp. 419-421, cites, as coming within the purview of the idem sonans rule, Yusea and U-C-A, Steinway Pianos and Steinberg Pianos, and Seven-Up and Lemon-Up. In *Co Tiong, S. A. v. Director of Patents*, this Court unequivocally said that Celdura and Cordura are confusingly similar in sound; this Court held in *Sapolin Co. v. Balmaceda*, 67 Phil. 795 that the name Lusolin is an infringement of the trademark Sapolin, as the sound of the two names is almost the same.

In the case at bar, SALONPAS and LIONPAS, when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America v. E. I. Dupont*, 154 F. 2d. 146, 148).

The registration of LIONPAS cannot therefore be given due course.

"8. The mark Buscomed, a mark quite junior compared with Buscopan, shares the dominant element BUSCO to the mark Buscopan that would lead a reasonable observer to believe the trademarks are related. Buscomed and Buscopan only differ in the last syllable. The prefix BUSCO is dominant in both marks. Buscopan is an intelligently crafted mark coined by Opposer to distinguish its product from any other product available in the market. Respondent's desire to profit from the reputation of the well-known mark Buscopan is readily obvious in its selection of a very similar mark instead of creating an original mark from the countless combinations of letters available to it. Yet, Respondent chose to ride on the popularity of Buscopan.

"9. The mark Buscomed shares elements of spelling and style to the mark Buscopan that would lead a reasonable observer to believe the trademarks are related. Indeed, by applying the dominancy test, which is explicitly embodied in Sections 155.1 and 155.2 of the IP Code, this Honorable Office would arrive at the unmistakable conclusion that the two marks are confusingly similar. Notably, in *McDonald's Corp. v. L. C. Big Mak Burger, Inc.*, a case where the trademark Big Mak was found to be confusingly similar with the Big Mac mark, the High Court explicitly held:

x x x

"10. Quite clearly, Respondent's intent to ride on the goodwill attached to Opposer's mark cannot be denied. Being a junior mark, Buscomed was intended by Medlink to ride on the goodwill attained by Buscopen. Medlink need not spend a big amount of money to promote Buscomed and only have to associate itself with the well-known Buscopen mark to be able to get and enjoy a big following for its product at the expense of Opposer. It is worth noting that Mr. Villamor A. Cando, Respondent's President, was a former employee of Boehringer Ingelheim Philippines, Inc. for 16 years and was the Group Product Manager of Boehringer Phils. When he opted for early retirement. Respondent's Vice-President is Mr. Alejo R. Zarsa, who was also a former employee of Boehringer Phils. For 23 years. He was Boehringer Phils.' National Sales Manger when he also opted for early retirement to lead and manage the sale operations of Respondent. Messrs. Cando and Zarsa very well know the success and reputation of Buscopen as an antispasmodic relied upon by physicians and patients alike.

"11. It cannot be denied Buscopen is a well-known trademark both here in the Philippines and worldwide. For more than 50 years, Buscopen has provided targeted, safe and effective relief from abdominal discomfort and pain. The product Buscopen is available and is being distributed in the Philippines by Metro Drug, Inc. To promote its product in the Philippines, Opposer caused the preparation of a video advertisement intended for television broadcast. Buscopen is available in more than 100 countries around the world. Opposer has registered its trademark Buscopen in many countries such as, to name a few, Portugal, United Arab Emirates, Bahrain, Namibia, Malawi, Singapore, Saudi Arabia, Lebanon, Kenya, Jordan, New Zealand, Australia, Taiwan, United States of America, Spain, Morocco, Italy, France, Iceland, Finland, Austria, Germany, Monaco, Canada and the United Kingdom. As of March 1, 2009, Opposer has a pending application for the registration of the trademark Buscopen in Libya. If Respondent were to be allowed to use the Buscomed mark in connection with the advertisement and sale, either through direct sales, the internet or otherwise, of its pharmaceutical product, the consuming public would nonetheless be confused with regard to the source and reputation of the goods.

"12. Respondent's use of the Buscomed mark would indicate a connection between Respondent's goods and Opposer's, when in fact there is none, thus resulting in the clear infringement of Opposer's registered mark and irreparable damage to Opposer's goodwill and reputation. It is apparent that Respondent's mark is calculated to ride on or cash in on the popularity of the Buscopen mark, which undoubtedly has earned goodwill and reputation through Opposer's extensive use and promotion since 1952.

"13. Hence, as the registered owner and prior user of the well-known Buscopan mark, Opposer has a vested right to the exclusive use of its mark for its goods, to the exclusion of others, whether such goods are similar or dissimilar to those offered by Opposer. On the other hand, Medlink is a junior user that would not lose anything if it were prohibited from seeking registration of Buscomed. Being a junior user, Medlink could have come up with a mark that is not confusingly similar with Buscopan.

"14. Considering the substantial investment made by Opposer in promoting its Buscopan mark and Respondent's deceitful conduct in applying for the registration of a mark similar to Opposer's, it is plain that Opposer would be greatly damaged and prejudiced, and Respondent would be unduly enriched at the expense of Opposer, with the registration of the Buscomed mark in Respondent's name."

The Opposer's evidence consists of the following:

1. Exhibit "A" - Copy of the Certificate of Corporation of the Opposer;
2. Exhibit "B" - A printed copy of the website of the Opposer;
3. Exhibit "C" - Certificate of Authentication of the Power of Attorney issued to Mr. Harald Binz on 13 March 2009;
4. Exhibit "D" - Certified true copy of the General Information Sheet (GIS) of MEDLINK for the year 2007 issued by the Securities and Exchange Commission (SEC);
5. Exhibit "E" - Printed copy of the website visited on 17 February 2009;
6. Exhibit "F" - Printed copy of website visited on 17 February 2009;
7. Exhibit "G" - Printed copy of website;
8. Exhibit "H" - Copy of Certificate of Trademark Registration;
9. Exhibit "I" - Certified true copy of the Certificate of Trademark Renewal of Registration No. 12403 for the trademark Buscopan;
10. Exhibit "J" - Printed copy of website;
11. Exhibit "K" - Printed copy of webpages;
12. Exhibit "L" - Printed copy of webpages;
13. Exhibit "M" - Printed copy of webpages;
14. Exhibit "N" - Printed copy of webpages;
15. Exhibit "O" - Printed copy of webpages;
16. Exhibit "P" - Printed copy of pages of the website;
17. Exhibit "Q" - Printed copy of webpages;
18. Exhibit "R" - The product of Buscomed obtained from Mercury Drug by Opposer's counsel;
19. Exhibit "R-1" - Receipt, for the purchase of two (2) pieces Buscomed

- Tab10mg at Mercury Drug, Paco, Manila dated 23 April 2009;
20. Exhibit "R-2" - Printed copy of webpages;
 21. Exhibit "R-3" - Printed copy of webpages;
 22. Exhibit "R-3-a" - Printed copy of webpages;
 23. Exhibit "R-4" - Printed copy of webpages;
 24. Exhibit "R-5" - Printed copy of webpages;
 25. Exhibit "R-6" - Printed copy of webpages;
 26. Exhibit "R-6-a" - Printed copy of webpages;
 27. Exhibit "S" - Printed copy of webpages visited on 23 February 2009;
 28. Exhibit "T" - Printed copy of webpages visited on 17 February 2009;
 29. Exhibit "U" - Printed copy of website;
 30. Exhibit "V" - List of countries where the mark Buscopan is registered;
 31. Exhibit "W" - Printed copy of webpages;
 32. Exhibit "X" - Printed copy of webpages;
 33. Exhibit "Y" - Printed copy of webpages;
 34. Exhibit "Z" - Printed copy of webpages;
 35. Exhibit "AA" - Printed copy of webpages;
 36. Exhibit "BB" - Printed copy of webpages;
 37. Exhibit "CC" - Printed copy of webpages;
 38. Exhibit "DD" - Printed copy of webpages;
 39. Exhibit "EE" - Printed copy of webpages;
 40. Exhibit "FF" - Printed copy of webpages;
 41. Exhibit "GG" - Printed copy of webpages;
 42. Exhibit "HH" - Printed copy of webpages;
 43. Exhibit "II" - Printed copy of webpages;
 44. Exhibit "JJ" - Printed copy of webpages;
 45. Exhibit "KK" - Printed copy of webpages;
 46. Exhibit "LL" - Printed copy of webpages;
 47. Exhibit "MM" - Printed copy of webpages;
 48. Exhibit "NN" - Printed copy of webpages;
 49. Exhibit "OO" - Printed copy of webpages;
 50. Exhibit "PP" - Printed copy of webpages;
 51. Exhibit "QQ" - Printed copy of webpages;
 52. Exhibit "RR" - Printed copy of webpages;
 53. Exhibit "SS" - Printed copy of webpages;
 54. Exhibit "TT" - Printed copy of webpages;
 55. Exhibit "UU" - Printed copy of webpages;
 56. Exhibit "VV" - Printed copy of webpages;
 57. Exhibit "WW" - Printed copy of webpages;
 58. Exhibit "XX" - Printed copy of webpages;
 59. Exhibit "YY" - Printed copy of webpages;

60. Exhibit "ZZ" - Printed copy of webpages;
61. Exhibit "AAA" - Copy of the article by Akima Miyoshi, Professor of Internal Medicine at Hiroshima University, Japan;
62. Exhibit "BBB" - Copy of the article from THE LANCET dated 20 August 1966;
63. Exhibit "CCC" - Authenticated Affidavit of Jeurgen Romhild;
64. Exhibit "CCC-1" - Authenticated Affidavit of Jutta Lindemann;
65. Exhibit "DDD" - Notarized Affidavit of Mr. Guido Hoeller;
66. Exhibit "DDD-1" - Notarized Affidavit of Aurora Librado;
67. Exhibit "EEE" - Notarized Affidavit of Ms. Ma. Jonalyn F. Baggayan;
68. Exhibit "FFF" - Notarized Affidavit of Ms. Teresa Paz B. Grecia Pascual;
69. Exhibit "GGG" - Certification issued by the Supreme Court as to the admission to the bar of Atty. Teresa Paz B. Grecia Pascual.

On 19 August 2009, the Respondent-Applicant filed its Verified Answer whereby it admitted some of the allegations in the opposition but denied all the material allegations thereof and further avers the following as affirmative allegations and defenses:

"1. MEDLINK was established and registered with the Philippine Securities and Exchange Commission (SEC) on 28 March 2003 with a vision to be of service to the health needs of Filipino people by making available high quality and affordable ethical medicines.

"2. MEDLINK has been trading, distributing and selling quality and affordable medicines to the Filipino public since November 2003. To make its own identity, it was decided early on that, whenever possible, MEDLINK will develop a brand that is related to the generic name of the product together with the word MED to mean that said product is the generic brand of MEDLINK. This strategy has been adopted by MEDLINK as shown by the brand name/trademarks of some of its products, namely: (a) CAPOMED, meaning Captropril (anti hypertensive) of MEDLINK; (b) GLUCOMED, meaning Anti-Glucose (anti diabetic) of MEDLINK; (c) OXYMED, meaning Oxytoncin (uterine stimulant) of MEDLINK; (d) ERGOMED, meaning Ergometrine (uterine stimulant) of MEDLINK; and (e) BUSCOMED, meaning Butyl Scopolamine (anti spasmodic) of MEDLINK.

All of the above-mentioned marks, except BUSCOMED, have been registered with this Honorable Office.

"3. MEDLINK started marketing, distributing and selling the product hyocine-N-butylbromide under the brand name and mark, BUSCOMED, in

January 2004. As such, MEDLINK has been trading BUSCOMED in the Philippines for more than 5 years already.

"4. Similar to its other products, the BUSCOMED brand name and mark was conceived pursuant to the branding strategy of MEDLINK, that is, to combine the generic name of the product together with the word, MED. In this case, the generic name of the product is *hyocine-N-butylbromide*, otherwise known as *butylscopolamine* (antispasmodic), the first two syllables of which are BU and SCO, which is thereafter combined with MED to form BUSCOMED. As Opposer itself admitted, *butylscopolamine* is also the active ingredient in its Buscopan product.

"5. Prior to trading, marketing and distributing *hyocine-N-butylbromide* under the brand name BUSCOMED, MEDLINK sought approval of said brand name with the Bureau of Food and Drugs (BFAD). In a letter dated 27 August 2003, the BFAD approved MEDLINK's use of the brand name, BUSCOMED. Thereafter, Certificates of Product Registration were issued to MEDLINK for the use of the brand name BUSCOMED for its product in its injection and tablet forms.

"6. MEDLINK actually commenced marketing, trading and promotion of BUSCOMED in January 2004, or for a period of more than 5 years already. MEDLINK thereafter filed an application for the registration of the mark, BUSCOMED, with this Honorable Office, just as it did with the other brand names and marks of its branded generic products. Unfortunately, Opposer has filed this baseless and unmeritorious opposition to the registration thereof.

"7. There is nothing ingenious or novel in coining the term BUSCO and its use singly or in combination with other syllables or phrases, as what Opposer wants to impart. BUSCO is a combination of the first syllables of *butylscopolamine*, more popularly known as *hyocine-N-butylbromide*, the active ingredient in the product.

"8. In fact, many other global pharmaceutical products use the term BUSCO in their respective products with the generic ingredient, *hyocine-N-butylbromide*, including: (a) Buscorem; (b) Buscovital; (c) Buscolysin; (d) Buscotil; and (e) Buscono, among others. Furthermore, as shown above, *Buscopin* and *Buskopan* have myriad synonyms consisting of the syllables BUSCO, including, among others, *Buscol*, *Buscolamin*, *Buscopin*, *Buscoridin*, *Butylscopolamini bromidum*, *Butylscopolammonoum bromidi*, *Hyocine-N-butylbromide*, *Scopolamine butylbromide*. Opposer cannot thus claim that it had exclusively used the term BUSCO in its products to the exclusion of other pharmaceutical companies, MEDLINK included.

"9. For its part, MEDLINK has adopted a branding strategy combining the generic name of the product together with the word MED, in this case, BUSCO and MED. The same branding strategy has been adopted by MEDLINK in its other products, namely, CAPOMED, GLUCOMED, OXYMED and ERGOMED. The suffix MED distinguishes the product, indicating that it came from MEDLINK.

"10. As it is, no competent authority in the Philippines has declared that Buscopan is a mark that is well-known internationally, much less in the Philippines. Opposer therefore cannot prevent other companies from using the term BUSCO in their product names and marks.

"11. MEDLINK has marketed, sold and distributed BUSCOMED in the Philippine market for 5 years already and no one, Opposer included, has come forward to say that they were confused by the use of the marks BUSCOMED and Buscopan. As such, Opposer's claim of confusing similarity is more imagined than real.

"12. Aside from the generic term BUSCO, which is a combination of the first syllables of the active ingredient *hyocine-N-butylbromide* which is often adopted by pharmaceutical companies, the use of the suffix pan in Opposer's product and MED in MEDLINK's product is very significant. It is so in the case of MEDLINK, which has adopted a branding strategy to use the generic name of the product and combine it with the syllable MED to distinguish it from the products of other drug companies. Confusion is thus avoided because the prescribing doctors, pharmacists and the public will know that Buscopan came from Opposer, while BUSCOMED came from MEDLINK.

"13. It should be emphasized that BUSCOMED is a prescription drug. It is not an Over-The-Counter medicine, as Opposer's Buscopan tablet is. The intervention of a medical doctor, who is knowledgeable not only of the active ingredient in each and every medicine but also of the nature, origin and source of each drug, is therefore necessary in prescribing BUSCOMED. When said medical doctor prescribes BUSCOMED, he or she does so, recognizing its distinction with other drugs, including Buscopan, which treats the same ailment. There is thus no possibility of confusion, even a mere likelihood of confusion, as competent and well-informed medical doctors prescribe BUSCOMED, in contrast to Buscopan. It is for this reason that MEDLINK focuses its promotion of the drug with the prescribing doctors, rather than with the general public."

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Printout from website where the product BUSCOREM 10mg appeared;
2. Exhibit "1-A" - Printout from website where the product BUSCOVITAL appeared;
3. Exhibit "1-B" - Printout from website where the product BUSCOLYSIN appeared;
4. Exhibit "1-C" - Printout from website where the product BUSCOTIL 10mg appeared;
5. Exhibit "1-D" - Printout from website where the product BUSCONO [tab] appeared;
6. Exhibit "1-E" - Printout from website where the products BUSCOL, BUSCOLAMIN, BUSCOLYSIN, BUSCOPIN, BUSCORIDIN, BUTYLSCOPOLAMINI BROMIDUM, BUTYLSCOPOLAMMONIUM BROMIDI, HYOSCINE-N-BUTYLBROMIDE, SCOPOLAMINE BUTYLBROMIDE, among others, appeared;
7. Exhibit "2" - Certified true copy of Certificate of Registration No. 4-2008-005315 for the mark OXYMED issued on 16 February 2009 to MEDLINK PHARMA PHILS., INC.;
8. Exhibit "2-A" - Certified true copy of Certificate of Registration No. 4-2008-005312 for the mark CAPOMED issued on 16 February 2009 to MEDLINK PHARMA PHILS., INC.;
9. Exhibit "2-B" - Certified true copy of Certificate of Registration No. 4-2008-005316 for the mark ERGOMED issued on 16 February 2009 to MEDLINK PHARMA PHILS., INC.;
10. Exhibit "2-C" - Certified true copy of Certificate of Registration No. 4-2008-005310 for the mark GLUCOMED issued on 16 February 2009 to MEDLINK PHARMA PHILS., INC.;
11. Exhibit "3" - Copy of letter dated 27 August 2003 issued by the Bureau of Food and Drugs to Ms. Constanca S. Ramos of Medlink Pharma Phils., Inc.;
12. Exhibit "4" - Certified true copy of BFAD Certificate of Registration No. DRP-400 for the brand name BUSCOMED;
13. Exhibit "4-A" - Certified true copy of BFAD Certificate of Registration No. DRP-563 for the brand name BUSCOMED;
14. Exhibit "5" - Photograph of Respondent BUSCOMED's actual box and ampule products;
15. Exhibit "5-A" - Photograph of Opposer BUSCOPAN's actual box and ampule products;
16. Exhibit "6" - Photograph of Respondent BUSCOMED's actual box;
17. Exhibit "6-A" - Photograph of Opposer BUSCOPAN's actual box; and
18. Exhibit "7" - Joint Affidavit of Villamor A. Cando and Michelle S. Lupera.

The Opposer filed a Reply to the Answer on 01 September 2009, while the Respondent-Applicant filed a Rejoinder thereto on 14 September 2009.

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

The Respondent-Applicant claims that it cannot be prevented from using and registering the mark BUSCOMED because the prefix "BUSCO" is a generic term. According to the Respondent-Applicant, it adopted the mark BUSCOMED by combining the generic name of the product together with the letters "M", "E", and "D", to indicate that it came from MEDLINK. It also contends that the word BUSCO is a generic term commonly used by a number of pharmaceutical companies worldwide in marketing the generic product, *hyoscine-N-butylbromide*, like the following trademarks:

1. Buscorem²;
2. Buscovital³;
3. Buscolysin⁴;
4. Buscotil⁵; and
5. Buscono⁶.

In *Societe Des Produits Nestle*,⁷ the Supreme Court defined generic terms as:

"those which constitute the common descriptive name of an article or substance, or comprise the genus of which the particular product is a species, or are commonly used as the name or description of a kind of goods, or imply reference to every member of a genus and the exclusion of individuating characters, or refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product, and are not legally protectable."

Based on the above definition, the term BUSCO cannot be considered a generic name nor a genus of a particular product specie. It is neither a common descriptive name of a drug or commonly used as the name or description of a

2 Exhibit "1".

3 Exhibit "1-A".

4 Exhibit "1-B".

5 Exhibit "1-C".

6 Exhibit "1-D".

7 *Societe Des Produits Nestle v. Court of Appeals, et. al.*, G. R. No. 112012, April 4, 2001, citing Federal Unfair Competition: Lanham Act S. 43 (a).

kind of goods.

Since the term BUSCO cannot be considered as generic, what remains to be resolved is whether there is likelihood of confusion between the Opposer's BUSCOPAN and the Respondent-Applicant's BUSCOMED.

In this regard, 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 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.⁸

Thus, Section 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("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.

Records show that prior to the filing of the Respondent-Applicant's trademark application on 07 May 2008, the Opposer was granted Certificate of Trademark Registration No. 12403 on 04 August 1966 for the mark BUSCOPAN.⁹ The latest Certificate of Renewal for the said trademark was issued to Opposer on 4 August 2006,¹⁰ which is good for another ten (10) years from the date of issuance. This Bureau also noted that the competing marks are both used on pharmaceutical preparation for use as *antispasmodic medication*, under Class 5 of the Nice Classification. Moreover, the pharmaceutical products on which the competing marks are used are available in tablet and ampules form.

⁸ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Dir. Of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspect of Intellectual Property (TRIPS Agreement).

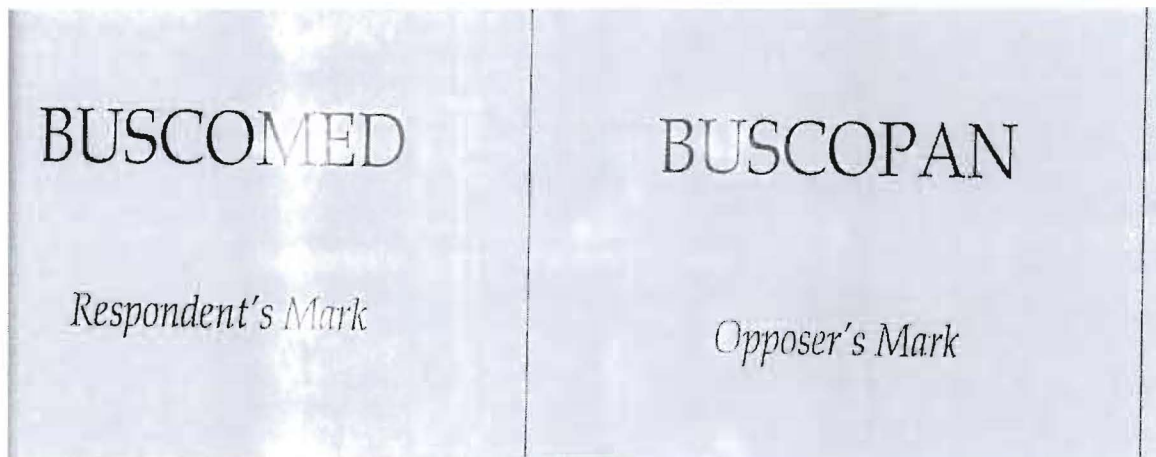
⁹ Exhibit "H".

¹⁰ Exhibit "I".

But do the competing marks resemble each other that confusion or deception is likely to occur?

In determining whether two or more marks are confusingly similar, the law does not require actual confusion, it being sufficient that confusion is likely to occur.¹¹

The competing marks are reproduced below for comparison:



The feature in the competing marks that immediately draws the eyes and ears is the term BUSCO. Thus, notwithstanding the difference in the suffixes, confusion or deception is likely considering that the competing marks are used on the same pharmaceutical products. The confusion could either be with respect to the goods itself or of business origin, or both. The public would be susceptible to conclude that one mark is just a variation of the other.

By analogy, confusion cannot also be avoided by merely dropping, adding or changing one of the letters of a registered mark¹². Confusingly similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.¹³ The copycat need not copy the entire mark, but is is enough that he takes one feature which the average buyer is likely to remember.¹⁴

11 See *Philips Export B. V., et al. v. Court of Appeals, et. al.*, G. R. No. 96161, 21 February 1992.

12 Reference: *Continental Connector Corp. v. Continental Specialties Corp.*, 207 USPQ.

13 See *Societe des Produits Nestle, S. A. v. Court of Appeals*, G. R. No. 112012, 04 April 2001.

14 Ref. *Nims, The Law of Unfair Competition and Trademarks*, 4th Ed. Vol. 2, pp. 678-679.

The Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code, and therefore, should not be allowed.

WHEREFORE, premises considered, the instant **OPPOSITION** is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2008-005313, together with a copy of this Decision, be returned to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 18 November 2010.


NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs

