

GIST-BROCADES, N.V.,  
Opposer,

INTER PARTES CASE NO. 3063

OPPOSITION TO:

- versus -

Application Serial No. 51969  
Filed : August 19, 1983  
Applicant : Schering Corporation  
Trademark : DUBLVAX  
Used on : Vaccine for Newcastle  
Disease and infectious  
bronchitis in poultry

SCHERING CORPORATION,  
Respondent-Applicant.  
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DECISION NO. 89-21 (TM)  
March 8, 1989

### DECISION

On April 6, 1988, Gist-Brocades, N.V. filed an Unverified Notice of Opposition against the registration of the trademark "DUBLVAX" used on vaccines for Newcastle Disease and infectious bronchitis in poultry applied for by Schering Corporation on August 19, 1983 in Application Serial No. 51969 published on Page 25, Volume I, No. 1 of the BPTTT Official Gazette dated March 8, 1988.

Opposer is a foreign corporation organized under the laws of Netherlands and doing business at No. 1 Wateringseweg, Delft, The Netherlands, while Respondent-Applicant is likewise a foreign corporation organized under the laws of the United States of America, with business address at Galloping Hill Road, Kenilworth, New Jersey 07033, U.S.A.

On May 18, 1988, Opposer filed its Verified Notice of Opposition based on the following grounds:

"1. The opposer is the owner of the trademark DELVAX for Veterinary Vaccines, in Class 5 under Philippine Certificate of Registration No. 32745 issued by the Philippine Patent Office on October 14, 1983. The mark was first used in The Netherlands on April 27, 1972 and saw commercial use also in the same year. Opposer also registered the same mark for the same goods in its country of origin under Benelux Certificate of Registration No. 310440 dated April 27, 1972, which is still in force and effect. The trademark DUBLVAX sought to be registered by the respondent-applicant so resembles and is in fact identical to the aforementioned pending and unabandoned mark of the opposer that the use of the respondent-applicant's aforementioned mark on its goods will very likely cause confusion and mistake, or will deceive the purchaser thereof, such that the public may be led to believe that the mark of the respondent-applicant's mark as used are those of GIST-BROCADES N.V., Opposer herein.

2. The trademark DELVAX is, and ever since its adoption has been, continuously applied to products of Opposer, to the package and containers of said products and to the labels affixed to said packages and containers. The trademark DELVAX has come to be and now is popularly known throughout the Netherlands and the Philippines and other parts of the world, and is of great value to the Opposer herein. Said mark identifies and designates the products to which it is applied as coming exclusively from Opposer and distinguishes such products from the products of others, more particularly of herein respondent-applicant.

3. The opposer herein believes that the registration of the mark DUBLVAX in the name of respondent-applicant will cause great and irreparable injury and damage to herein opposer pursuant to Section 8 of Republic Act No. 166, as amended.”

In its Answer filed on June 17, 1988, Respondent-Applicant denied the material allegations averred in the Notice of Opposition and, by way of Special and Affirmative Defenses, alleged that:

“11. Opposer has no cause of action against respondent-applicant and its Notice of Opposition states none.

12. The two trademark DUBLVAX and DELVAX are entirely different from each other based on their letters, sizes, form, sound and appearance, and their dominant features.

13. In fact, respondent-applicant’s trademark DUBLVAX in itself, its presentation, labeling and packaging, and taken in its entirety is a clearly distinctive trademark which prominently identifies and unequivocally distinguishes the origin and source of the goods on which it is used from all those manufactured, sold, or dealt in by others, inclusive of the alleged goods and trademarks of the opposer.

14. Moreover, the trademark DUBLVAX is used specially for the treatment of Newcastle disease and infectious bronchitis in poultry and is sold by prescription only.

15. In addition, the products over which DUBLVAX is used are administered to the animal intravenously by a professional and licensed veterinary doctor alone and not by any ordinary layman.

16. Respondent-applicant’s trademark has long ago been used widely by it and registered in the United States as early as August 1, 1961 and its validity as a trademark in the Philippines has been favorably passed upon by the Trademark Examiner concerned and the Director of Patents after the closest scrutiny and examination.

17. Opposer’s claim of identity and likelihood of confusion between its own alleged trademark and the respondent-applicant’s trademark DUBLVAX is speculative and without basis in fact and in law.”

After the pre-trial conference on July 26, 1988, the case was heard on the merits. On August 30, 1988, the Opposer completed the presentation of its evidence.

On September 1, 1988, Opposer submitted its Written Formal Offer of Evidence consisting of Exhibits “A” to “F” with submarkings. Said exhibits were all admitted in evidence for the Opposer in Order 88-408 dated September 30, 1988 and Order No. 88-487 denying the Respondent’s motion for the reconsideration of the former order.

More hearings followed thereafter. On February 27, 1989, Respondent-Applicant through counsel filed a Manifestation formally informing the Bureau that “it is no longer interested in pursuing Application Serial No. 51969”.

WHEREFORE, premises considered, this opposition case is GRANTED. Respondent’s Application Serial No. 51969 for the mark “DUBLVAX” is hereby declared expressly and voluntarily ABANDONED.

Let the records of this case be forwarded to the Application, Issuance & Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director