

STERLING PRODUCTS INTERNATIONAL, INC.,

Opposer,

INTER PARTES CASE NO. 3050

OPPOSITION TO:

Application Serial No. 43175

Filed : November 14, 1980

Applicant : Alcon Pharmaceuticals, Ltd.

Trademark : FENICOL

Used on : Medicines and pharmaceutical products

- versus -

ALCON PHARMACEUTICALS, LTD.,
Respondent-Applicant.

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Decision No. 88-93 (TM)
August 25, 1988

DECISION

The Sterling Products International Inc. filed on February 26, 1988 an unverified Notice of Opposition against the registration of the trademark "FENICOL" used on medicines and pharmaceutical products applied for on November 14, 1980 by Pharmaceuticals, Ltd. under Application Serial No. 43175 and was posted for opposition on January 27, 1988 in the Bulletin Board of the Bureau of Patents, Trademarks and Technology Transfer.

Opposer is a foreign corporation organized under the laws of Delaware, U.S.A. with address at 90 Park Avenue, New York City 10016, U.S.A., while Respondent-Applicant is likewise a foreign corporation organized and existing under the laws of Switzerland, with address at 6330 Cham, Switzerland and its sister corporation, Alcon Laboratories Ltd., organized and existing under the laws of Delaware, U.S.A., with address at 6201 South Freeway, Fort Worth, Texas 76134, U.S.A.

On April 26, 1988, Opposer submitted its verified Notice of Opposition based on the following grounds:

"1. The opposer is the owner of the trademark FENAROL used in connection with pharmaceuticals, namely, muscle relaxant, tranquilizer and sedatives; its ownership over said mark is recognized by the Bureau of Patents, Trademarks and Technology Transfer in a Certificate of Trademark Registration No. 8075 issued on February 4, 1960 and renewed in a Certificate of Renewal No. 2545 issued February 18, 1982;

2. Respondent-Applicant's mark is confusingly similar to Opposer's mark FENAROL, a mark which was used and registered at a time prior to the use of, or filing for subject trademark.

Respondent-Applicant was furnished a copy of the verified Notice of Opposition on May 11, 1988.

On May 26, 1988, Respondent-Applicant filed a Motion for a 45-day extension but was only granted 30 days within which to file its Answer (Order No. 88-172), followed by a Manifestation and Motion filed on June 24, 1988 informing the Bureau that "the opposer and respondent-applicant have reached an agreement to the effect that respondent-applicant can register that mark "FENICOL" subject to certain conditions. The Bureau gave the parties 45 days within which to submit said Agreement (Order No. 88-211 dated June 30, 1988).

On August 8, 1988, Respondent-Applicant submitted the Agreement executed by and between the Opposer and the Respondent-Applicant which provides the following conditions for the registration of the mark "FENICOL";

"a) To restrict the registration and use of the trademark 'FENICOL' to 'medication for topical treatment of bacterial infections of the eye'

b) Not to derive any rights from the registration of its trademark FENICOL against Sterling's trademark FENAROL, and to take no action to oppose or to interfere with the use of the trademark FENAROL for any goods other than those with ophthalmic applications."

WHEREFORE, this opposition case is DISMISSED. As agreed upon by the parties, Respondent's Application Serial No. 43175 for the registration of the trademark "FENICOL" is given due course subject to the above-quoted conditions.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director