



MERCK KGaA,
Opposer,

-versus-

DARVY'S PHARMA, INC.,
Respondent-Applicant.

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}
} IPC No. 14-2010-00183
} Opposition to:
} Appln. Serial No. 4-2009-011081
} Filing Date: 29 October 2009
} TM: "NEUROTON"
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}
}

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES

Counsel for the Opposer
21st Floor, Chatham House
No. 116 Valero corner Herrera Street
Salcedo Village, Makati City

DARVYS PHARMA, INC.

Respondent-Applicant
5th Floor, Semicon Building
No. 50 Marcos Highway
Pasig City

GREETINGS:

Please be informed that Decision No. 2013 - 147 dated July 18, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 18, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Bureau of Legal Affairs



MERCK KGaA,

Opposer,

IPC NO. 14-2010-00183

Opposition to:

- versus -

Appln. Serial No. 4-2009-011081
(Filing Date: 29 October 2009)

DARVY'S PHARMA, INC.,

Respondent-Applicant.

TM: "NEUROTON"

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Decision No. 2013- 147

DECISION

Merck KGaA¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-011081. The application, filed by DARVY'S PHARMA, INC.² ("Respondent-Applicant"), covers the mark "NEUROTON" for use on "*pharmaceutical preparation namely nootropic agent*" under Class 5 of the International Classification of goods³.

The Opposer alleges, among other things, that the registration of the mark NEUROTON is contrary to Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, the mark NEUROTON is similar to its registered mark "NEUROBION" as to be likely to deceive or cause confusion. The Opposer also claims that NEUROBION is a well-known mark.

In support of its opposition, the Opposer submitted the following:⁴

1. Special Power of Attorney from Merck KGaA;
2. certified true copy of the renewal of registration certificate number 22189 for NEUROBION;
3. certified true copy of the fifth anniversary acceptance of the Affidavit of Use for NEUROBION;
4. certified true copy of the tenth anniversary acceptance of the Affidavit of Use for NEUROBION;
5. certified true copy of the fifteenth anniversary acceptance of the Affidavit of Use for NEUROBION;
6. Affidavit of Mr. Ulrich Fogel and Jonas Kolle;
7. list of countries worldwide where NEUROBION is used;
8. sample packs and packages for NEUROBION;
9. certified copy of Bangladesh trademark registration number 870816 for NEUROBION;

¹ A foreign corporation organized and existing under the laws of Germany, with business address at Frankfurter Strass 250, 64293 Darmstadt, Germany.

² With address at 5/F Semicon Bldg., 50 Marcos Highway, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

⁴ Marked as Exhibit "A" to "L", inclusive.

Republic of the Philippines

INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center

10. certified copy of Lesotho trademark registration number LS/M/97/00437 for NEUROBION;
11. certified copy of Ecuadorian trademark registration number 883 for NEUROBION; and
12. certified copy of WIPO UK trademark registration number 195690 for NEUROBION.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 28 September 2010. The Respondent-Applicant, however, did not file an answer. Hence, the Hearing Officer issued on 17 February 2011 Order No. 2011-269 declaring the Respondent-Applicant to have waived the right to file answer and the case submitted for decision.

Sec. 123.1 (d) of the IP Code which provides 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 at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing registration for the mark NEUROBION under Reg. No. 22189, covering "*pharmaceutical and medicinal preparations, especially pharmaceutical products containing a combination of the neurotropic vitamins B1, B6 and B12.*" under Class 5. The goods indicated in the Respondent-Applicant's trademark application - "*nootropic agent*" are, thus, closely related to those covered by the Opposer's trademark registration. The applications or uses of the parties' respective pharmaceutical products are related to brain function and the nervous system. "*Nootropics*", also referred to as smart drugs, memory enhancers, neuro enhancers, cognitive enhancers, and intelligence enhancers, are drugs, supplements, nutraceuticals, and functional foods that purportedly improve mental functions such as cognition, memory, intelligence, motivation, attention, and concentration. "*Nootropics*" are thought to work by altering the availability of the brain's supply of neurochemicals (neurotransmitters, enzymes, and hormones), by improving the brain's oxygen supply, or by stimulating nerve growth.⁵

However, this Bureau finds that the subject trademark application should not be rejected on the ground that NEUROTON is similar to NEUROBION. Obviously, the competing marks were both derived from the term or prefix "NEURO". The term or prefix "NEURO" refers to or is in connection with the nervous system⁶. The prefix is of common usage in respect of goods, services or processes, particularly medical products or services, in relation to brain functions and nervous system. As a brand, mark or name, it conveys the goods or service and/or the kind, nature, use or purpose thereof.

The Opposer combined though the prefix "NEURO" with the letters "BION", resulting in a sufficiently distinctive mark, *albeit* as a suggestive one. It is stressed,

⁵ Source: <http://en.wikipedia.org/wiki/Nootropic> citing Dorlands Medical Dictionary and Lanni C. Lenzken SC, Pascale A, et. al. (March 2008). "Cognition enhancers between treating and doping the mind" *Pharmacol. Res.* 57(3): 196-213.

⁶Source <http://www.thefreedictionary.com/neuro> citing The American Heritage Dictionary of the English Language, Fourth Edition copyright 2000 by Houghton Mifflin Company; Collins English Dictionary-Complete and Unabridged Harper Collins Published 1991, 1994, 1998, 2000, 2003; Random House Kemerman Webster's College Dictionary, 2010 Dictionaries Ltd. Copyright 2005, 1997, 1991 by Random House, Inc.

however, that the instant opposition cannot be sustained just because the marks have the same prefix "NEURO". To do so would have the unintended effect of giving the Opposer the exclusive right to use the prefix "NEURO" on medical products or processes that relate to the brain and/or the nervous system. Aptly, as to whether the mark NEUROTON is confusingly similar to the Opposer's, is therefore to be determined by comparing it with the latter's mark in its entirety.

In the Opposer's mark, the prefix "NEURO" is combined with the letters "BION". On the other hand, "NEURO" in the Respondent-Applicant's mark is followed by the letters "TON". The configurations (lines and contours) of the letters "BI" in NEUROBION are in stark contrast with those of the letter "T" in NEUROTON, enabling the eyes to easily distinguish one mark from the other. The difference is more obvious with respect to sound. In "BION", the stress is on the letter "b", producing two syllables - "ba"- "yon" as against the single syllable "ton"

With the finding that NEUROTON is not confusingly similar to the mark NEUROBION, there is no necessity to delve on the issue as to whether the latter is a well-known mark. The protection accorded to well-known mark applies only when the marks are confusingly similar.

It must be stressed, however, that while this Bureau cannot sustain the opposition based on the ground cited by the Opposer, this does not mean that the Respondent-Applicant's trademark application should now proceed to registration. This Bureau takes cognizance of its Decision No. 2013-135, dated 16 July 2013, in Inter Partes No. 14-2010-00187 entitled *Warner Lambert Company LLC, Opposer v. Darvy's Pharma, Inc., Respondent-Applicant*. In said decision, this Bureau sustained the opposition of Warner Lambert Company LLC to Trademark Application No. 4-2009-011081 pursuant to Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition filed by Merck KGaA is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-011081 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 July 2013.


Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

