WARNER LAMBERT COMPANY LLC, Opposer, **-versus-** **DARVY'S PHARMA, INC.,** Respondent-Applicant.	} } } } } } } } }	**IPC No. 14-2010-00187** Opposition to: Appln. Serial No. 4-2009-011081 Filing Date: 29 October 2009 **TM: "NEUROTON"**

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NOTICE OF DECISION

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Taguig City

DARVYS PHARMA, INC.
Respondent-Applicant
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Pasig City

GREETINGS:

Please be informed that Decision No. 2013 - 135 dated July 16, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 16, 2013.

For the Director:

Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

WARNER LAMBERT COMPANY LLC,
Opposer,

- versus -

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

IPC NO. 14-2010-00187
Opposition to:

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

TM: "NEUROTON"

Decision No. 2013- 135

DECISION

WARNER LAMBERT COMPANY LLC[1] ("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 goods[3].

The Opposer alleges, among other things, that the registration of the mark NEUROTON is contrary to Sec. 123.1, paragraphs (d) to (f), 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 "NEURONTIN" as to be likely to deceive or cause confusion. The Opposer also claims that NEURONTIN is a well-known and famous trademark.

In support of its opposition, the Opposer submitted the legalized/authenticated affidavit of its Assistant Secretary Richard A. Friedman and the annexes thereto, to wit:

1. a sample product label bearing the mark NEURONTIN;
2. table listing the trademark registrations for NEURONTIN in the Philippines and other countries;
3. representative copies of the trademark registrations for the mark NEURONTIN in different countries;
4. affidavit of Joseph Lyle K. Sarmiento;
5. affidavit of Joseph Lyle K. Sarmiento and the attachments thereto (printout of the website http://epilepsy.emedtv.com/neurontin/neuroton.html; and printout of the website http://www.ehow.com/about_5444604_neuroton-side-effects.html); and
6. certified true copy of Philippines Trademark Reg. No. 4-1993-92065, affidavit of Millet R. Asuncion and the attachments thereto (samples of items bearing the NEURONTIN mark such as the NEURONTIN Sulit Card and the NEURONTIN Card Carrier, publication of the NEURONTIN mark in the

[1] A foreign corporation organized and existing under the laws of the State of Delaware, United States of America ("U.S.A."), with principal address at 235 East 42nd Street, New York, New York, 10017-5755, U.S.A.
[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.

Philippine Index of Medical Specialties, and copies of the Bureau of Food and Drugs certificates of product registration for the NEURONTIN mark).

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 01 October 2010. The Respondent-Applicant, however, did not file an answer. Hence, the Hearing Officer issued on 17 February 2011 Order No. 2011-268 declaring the Respondent-Applicant to have waived the right to file answer and the case submitted for decision.

Should the mark NEUROTON be registered in favor of the Respondent-Applicant?

The Opposer's evidence is insufficient to establish that all or at least a combination of the criteria under Rule 102 of the Trademark Regulations concurs. Hence, this Bureau is constrained from declaring the Opposer's mark a well-known mark. Corollarily, this Bureau cannot sustain the opposition pursuant to Sec. 123.1, pars. (e) and (f) of the IP Code.

Be that as it may, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by 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 NEURONTIN under Reg. No. 4-1993-92065, issued on 13 December 1999, covering "*antiepileptic preparations*" under Class 5. Also, the goods indicated in the Respondent-Applicant – "*nootropic agent*" are closely related to those covered by the Opposer's trademark registration. Furthermore, the resemblance between the marks is likely to cause confusion, or even deception.

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.[4] The Opposer's goods on the other hand, are medication for epilepsy, which is a common and diverse set of chronic neurological disorders characterized by seizures.[5]

In fact, both the competing marks were derived from the term or prefix "NEURO". The term or prefix "NEURO" refers to or is in connection with the nervous

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[4] 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.

[5] Source: http://en.wikipedia.org/wiki/Epilepsyciting Chang BS, Lowenstein DH (2003). "Epilepsy" N. Engl. J. Med. 349 (13): 1257-66 and "Epilepsy: Medicine Plus" U.S. National Library of Medicine 11 February 2013.

system[6]. Marks, brands or names identifying goods or services that start with the prefix "neuro", particularly, medical products or services, are therefore indicative of the application or use thereof.

The Opposer combined the prefix "NEURO" with the letters "NTIN". The resulting word – NEURONTIN - is sufficiently distinctive, *albeit* as a suggestive mark. 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 this regard, this Bureau finds that there is likelihood that consumers will confuse one with the other. The sounds produced by the marks are similar. To the ears, the letter "RONTIN" hardly differs from "ROTON". The Supreme Court in *Prosource International Inc. v. Horphag Research Management, S.A.*[7] held that it takes into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity. And in *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et. al.*[8], cited in *McDonalds Corporation v. L.C. Big Mak Burger, Inc.*, the Court held:

> "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, cities, 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 vs. Director of Patents, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in Sapolin Co. vs. 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."

Aptly, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing 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[9]. Even if the consumer notices the differences in the spelling of the competing marks, the likelihood of confusion would subsist, as one mark is mistaken for as a variation of the other. The confusion is not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[10]

> Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

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[6]Source 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.

[7] G.R. No. 180073, 25 Nov. 2009.

[8] G.R. No. L-19297, 22 Dec. 1966.

[9] *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

[10] *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

Considering that both marks are used on closely related pharmaceutical products, there is likelihood that information, assessment, perception or impression about NEUROTON products as heard may unfairly cast upon or attributed to the Opposer, and *vice-versa*.

In conclusion, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED.** 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, 16 July 2013.

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