

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

PASCUAL TOTAL HEALTH, INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00166

Opposition to:

Appln. Serial No. 4-2015-012878

Date Filed: 06 November 2015

TM: NEURO E 100

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for Opposer
No. 66 United Street,
Mandaluyong City

PASCUAL TOTAL HEALTH INC.

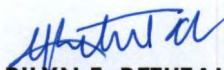
Respondent- Applicant
3F Unit B, One Orion Building
11th Avenue corner 38th Street,
Bonifacio Global City, Taguig City 1634

GREETINGS:

Please be informed that Decision No. 2017 - 51 dated 23 February 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOP HL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

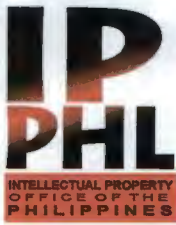
Taguig City, 24 February 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph

T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph



WESTMONT PHARMACEUTICALS, INC.

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IPC NO. 14-2016-00166

Opposition to:

Appln. Ser. No. 4-2015-012878

Filing Date: 06 November 2015

Trademark: NEURO E 100

Decision No. 2017 - 51

DECISION

WESTMONT PHARMACEUTICALS, INC.¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2015-012878. The application, filed by PASCUAL TOTAL HEALTH, INC.² ("Respondent-Applicant") covers the mark NEURO E 100 for use on "pharmaceuticals" under Class 5 of the International Classification of goods³.

The Opposer alleges the following:

"GROUNDS FOR OPPOSITION

x x x

"7. The mark 'NEURO E 100' applied for by Respondent-Applicant so resembles the trademark 'NEUROGEN-E' owned by Opposer and duly registered with the Honorable Bureau prior to the publication for opposition of the mark 'NEURO E 100'.

"8. The mark 'NEURO E 100' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'NEURO E 100' is applied for the same class of goods as that of the Opposer's trademark 'NEUROGEN-E', i.e., Class 05 of the International Classification of Goods as pharmaceutical preparations.

"9. The registration of the 'NEURO E 100' in the name of the Respondent will violate Sec. 123 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

"10. Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A domestic corporation with address at 3F Unit B, One Orion Building, 11th Ave., Corner 38th St., Bonifacio Global City Taguig City 1634.

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

the mind of the purchasers will likely result.

"11. Respondent-Applicant's use and registration of the mark 'NEURO E 100' will diminish the distinctiveness of Opposer's trademark NEUROGEN- E"

The Opposer's evidence consists of the following:

1. Exhibit "B" - certified copy of Certificate of Reg. No. 36644 for the trademark "NEUROGEN-E";
2. Exhibits "C" - certified copy of the Assignment of Registered Trademark executed on 11 July 1990 by UNILAB to L.R. Imperial;
3. Exhibit "D" - certified copy of Certificate of Renewal Reg. No. 036644 for the trademark "NEUROGEN-E";
4. Exhibits "E" - certified copy of the Assignment of Registered Trademark executed on 02 July 2013 by L.R. Imperial to Westmont Pharmaceutical, Inc. ;
- 5.
6. Exhibits "F", "G", "H" and "I" - certified true copies of the Affidavits of Use/ Declaration of Actual Use;
7. Exhibit "J" - Certificate of Product Registration No. DR-XY31242;
8. Exhibits "K" - Sample of product label bearing the trademark "NEUROGEN-E" actually used in commerce; and
8. Exhibit "L" - Certification issued by the Intercontinental Marketing Services (IMS) and sales performance.

This Bureau issued on 20 April 2016 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 22 April 2016. The Respondent-Applicant, however, did not file an Answer. On 10 January 2017, an Order was issued declaring Respondent-Applicant in default for failure to file the Answer. Accordingly, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark NEURO E 100?

Opposer anchors its opposition on Section 123.1 (d) of Republic Act No. 8293, also known as the "Intellectual Property Code of the Philippines (IP Code), as amended, which provides:

Section 123. *Registrability.* - 123.1. A mark cannot be registered if it:

x x x

(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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

The records show that at the time the Respondent-Applicant filed its application for the

mark NEURO E 100 on 06 November 2015, the Opposer already has an existing registration for the trademark NEUROGEN-E issued on 09 February 1987. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

Neurogen-E

Opposer's Mark

NEURO E 100

Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that both marks contain identical prefix "NEURO". While the letters that comes after the prefix "neuro" in the competing marks are different, that is, in Opposer's mark the letters "GEN E" is attached to the prefix "neuro" while in Respondent-Applicant's, it is the letter "E" and number "100". Respondent-Applicant merely dropped the letters "G-E-N" of Opposer's mark and added the number "100" to form its mark NEURO E 100. Also, both marks are written in plain upper case letters. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark.⁴

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it.⁵

Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article.⁶

In the case of *Societe Des Produits Nestle vs. Court of Appeals*,⁷ the Supreme Court stated that:

"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

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

⁵ *American Wire & Cable Company Vs. Director Of Patents* [G.R. No. L-26557. February 18, 1970.]

⁶ *Emerald Garments Manufacturing Corporation vs. Court of Appeals*, G.R. No. 100098. December 29, 1995.

⁷ G.R. No. 112012. April 4, 2001

ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other."

Furthermore, aside from the visual similarity, when Respondent-Applicant's mark is pronounced, the sound of the letter "E" in its mark NEURO E 100 diminishes its difference to Opposer's mark as it practically sounds similar to NEUROGEN-E. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

As to the goods, Opposer's mark is used on *neuromyotonic with Vitamin E for full revitalization*" under Class 05. On the other hand, the Respondent-Applicant's mark will be used on "*pharmaceuticals*" also under Class 05. In this instance, the Respondent-Applicant's trademark application covers a broad range of pharmaceutical preparations that may cover the goods of Opposer. Thus, the use of confusingly similar mark on similar or closely related goods will likely cause confusion, mistake or deception on the consumers into believing that there's a connection between Opposer and Respondent-Applicant, when in fact there is none or that their goods comes from the same source or origin.

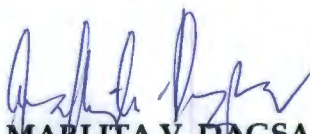
The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, 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

Accordingly, 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. 4-2015-012878, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 FEB 2017.


Atty. **MARLITA V. DAGOSA**
Adjudication Officer
Bureau of Legal Affairs

⁸See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.