

HOECHST AKTIENGESELLSCHAFT
Opposer,

INTER PARTES CASE NO. 1923

OPPOSITION TO:

- versus -

Application Serial No. 51348
Filed : June 9, 1983
Applicant : Marion Laboratories, Inc.
Trademark : CARDIZEM
Used on : Medicinal products,
including products for treatment of
cardiovascular diseases and related
conditions in humans

MARION LABORATORIES, INC.,
Respondent-Applicant.

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DECISION NO. 88-79 (TM)
August 18, 1988

DECISION

Hoechst Aktiengesellschaft, on April 3, 1985, filed an Unverified Notice of Opposition against the registration of the trademark "CARDIZEM" used on medicinal products of treatment of cardiovascular diseases and related conditions in humans lodged in this Bureau on June 9, 1983 by the Marion Laboratories, Inc. under Application Serial No. 51348 which was published on Page 11 of the Official Gazette, Volume 80, No. 42 dated October 15, 1984 and officially released for circulation on March 6, 1985.

Opposer is a foreign corporation duly organized and existing under the laws of West Germany and doing business at No. 6230 Frankfurt/Main 80, Federal Republic of Germany, while Respondent-Applicant is likewise a foreign corporation organized under the laws of Delaware, United States of America, doing business at No. 10236 Bunkenbridge Road, Kansas City, Missouri 64137, U.S.A.

On May 31, 1985, Opposer filed its Verified Notice of Opposition based on the following grounds:

"1. The opposer is the owner of the trademark CARNIGEN (Hoechst AG) as per Philippine Certificate of Registration No. 32105 issued on July 18, 1983.

2. The oppose, as owner of the trademark CARNIGEN (Hoeschst AG), has used the same in the products covered by International Class 5 long prior to respondent-applicant's application of June 9, 1983.

3. The respondent-applicant's alleged mark CARDIZEM is liable to create confusion as it is deceptively or confusingly similar to the Opposer's mark CARNIGEN and the goods covered are the same.

4. The registration of the applicant's alleged mark would violate Opposer's rights and interests in its trademark CARNIGEN (Hoechst AG) because the mark objected to is deceptively or confusingly similar, so that confusion between Opposer's and respondent-applicant's respective businesses and products as well as the resulting dilution and loss of distinctiveness of Opposer's trademark becomes inevitable."

Respondent-Applicant filed its Answer on August 26, 1985 and denied therein all the material averments made in the Notice of Opposition and invoked thereby the following defenses:

- a) That the two marks in question are clearly and distinctly different not only with respect to the spelling and pronunciation but also with respect to their appearance in the facsimiles and labels;
- b) That there is no likelihood that use of the trademark CARDIZEM will cause confusion and mistake since the products being sold under CARDIZEM marks are prescription drugs - the users will neither be confused nor mistaken as to believe the products bearing the trademark CARDIZEM of Respondent-Applicant are the products of the Opposer;
- c) That on the basis of the clear and distinct dissimilarity between the trademarks CARDIZEM and CARNIGEN, no injury or damage can possibly be caused to Opposer by the use and registration of the trademark CARDIZEM; and
- d) That the application for registration of Respondent-Applicant of the trademark CARDIZEM complies with all the requirements of Philippine Trademark Law as clearly evidenced by the fact that this Honorable Patent office has recommended the same for allowance and publication after due examination which must have taken into account the existing registration of Opposer for its trademark "CARNIGEN", assuming such registration to be subsisting.

No pre-trial hearing was held because of several postponements by parties. Subsequently, Opposer hired the law firm of Messrs. Sycip, Salazar, Feliciano & Hernandez as its new counsel which filed on February 4, 1986 a Motion for Leave to file a Verified Notice of Opposition. After it was granted, Respondent had to file an amended Answer. Thereafter, Opposer presented its evidence on the hearing of January 19, 1987 consisting of several documentary evidence (Exhs. "A" to "K-1") and submitted its formal offer of exhibits.

Respondent's counsel filed on November 13, 1987 a Motion to Dismiss this case (Inter Partes Case No. 1923) based on his client's (Marion Laboratories, Inc.) letter dated September 15, 1987 relaying the information that "its management has decided not to continue its attempts to register the trademark CARDIZEM in the Philippines due to the fact that it will not be marketing its CARDIZEM products in the Philippines". Its counsel was instructed to "take whatever steps necessary to withdraw our application at this time".

In view of the move of the herein Respondent-Application to withdraw its contested application for the registration of the mark "CARDIZEM" in the Philippines, this Bureau agrees with the herein Respondent that this Notice of Opposition has, indeed, become moot and academic.

WHEREFORE, premises considered, there being nothing more to oppose, subject Inter Partes Case No. 1923 is DISMISSED. Accordingly, trademark Application Serial No. 51348 for the trademark CARDIZEM shall be considered WITHDRAWN by Respondent-Applicant effective immediately.

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

SO ORDERED.

IGNACIO S. SAPALO
Director