

WANDER LTD.,
Opposer,

INTER PARTES CASE NO. 3278

OPPOSITION TO:

- versus -

Application Serial No. 60177
Filed : October 20, 1986
Applicant : Johnson & Johnson
Trademark : "MEDIPREN"
Used on : Pharmaceutical pain
reliever

JOHNSON & JOHNSON,
Respondent-Applicant.

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DECISION NO. 89-31 (TM)
June 8, 1989

DECISION

On November 2, 1988, Wander Ltd. filed a Petition for extension of time within which to file its Verified Notice of Opposition against the registration of the trademark "MEDIPREN" used on Pharmaceutical pain reliever, namely IBUPROFEN, applied for by Johnson & Johnson on October 20, 1986 in Application Serial No. 60177 published on Page 65 of the BPTTT Official Gazette, Volume I, No. 7 dated September 27, 1988 which was released for circulation on September 30, 1988.

Opposer is a foreign corporation with business address at Monbijoustrasse 115, CH-3001 Berne, Switzerland, while Respondent Applicant is likewise a foreign corporation organized and existing under the laws of the State of New Jersey, U.S.A., with business address at One Johnson & Johnson Plaza, New Brunswick, New Jersey, 08933-7001, United States of America.

The verified Notice of Opposition was filed on November 25, 1988 based on the following grounds.

- “1. The mark "MEDIPREN" X X X is confusingly similar with the trademark MERITENE of Opposer, which Opposer owns and has not abandoned; duly registered in the Bureau of Patents, Trademarks and Technology Transfer and which was issued on November 22, 1977 under Registration No. 1788.
2. The Opposer will be damaged and prejudiced by the registration of the mark "MEDIPREN" in the name of respondent-applicant, and its business reputation and goodwill will suffer great and irreparable injury.
3. Respondent-applicant's use of the mark "MEDIPREN" for pharmaceutical pain reliever namely, ibuprofen, which mark so resembles or is identical with the trademark owned and used by Opposer, constitutes an unlawful appropriation of a trademark owned and currently used by Opposer.”

In its Answer filed on December 16, 1988, Respondent-Applicant asserted, among others, that there is an obvious difference between Respondent's and Opposer's mark in spelling, appearance, pronunciation and meaning; the labels, packing and/or containers of Respondent's products are likewise different in design, wordings, etc.; and the purchasers of both Opposer's and Respondent's products buy the upon prescription by doctors.

The case was scheduled for pre-trial conference on February 6, 1989. For failure to appear at the said pre-trial conference, Respondent-Applicant was declared "as in default" but was later reconsidered for meritorious reasons. The case was set for hearing on May 5, 1989 but was reset to June 9, 1989 by agreement of the parties pending result of an ongoing negotiation for the amicable settlement of the case.

On May 26, 1989, Opposer through counsel filed a copy of a Motion to withdraw its opposition to the registration of the trademark "MEDIPREN" because the parties have already reached an agreement that amicably settled this case.

The said agreement provides, among others, that Respondent-Applicant will restrict the registration and use of "A" MARK ("MEDIPREN") in the Philippine to: "analgesic product, namely Ibuprofen" (Annex "B").

WHEREFORE, the herein opposition case is DISMISSED. Accordingly, Application Serial No. 60177 should be given due Course, subject to the provisions of the attached agreement (Annex "B").

Let the records of this case be forwarded to the Application, Issuance & Publication Division for Appropriate action in accordance with this Decision.
SO ORDERED.

IGNACIO S. SAPALO
Director