IP PHL

WESTMONT PHARMACEUTICALS, INC.,	}	**IPC No. 14-2013-00355**
Opposer,	}	Opposition to:
	}	Application No. 4-2013-005518
	}	Date filed: 15 May 2013
-versus-	}	TM: **"NEURODIN"**
	}	
	}	
	}	
ATTY AMBROSIO V. PADILLA III,	}	
Respondent-Applicant.	}	

x----------x

NOTICE OF DECISION

OCHAVE & ESCALONA
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No. 66 United Street
Mandaluyong City

ATTY. AMBROSIO V. PADILLA III
Respondent-Applicant
Unit 1001 88 Corporate Center
Sedeno corner Valero Streets
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - ____ dated July 24, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 24, 2015.

For the Director:

Atty. JO ERHINE C. ALON
Bur. au of Legal Affairs

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WESTMONT PHARMACEUTICALS, INC.
Opposer,

versus-

ATTY. AMBROSIO V. PADILLA III,
Respondent-Applicant.
x----------x

IPC NO. 14-2013-00355

Opposition to:
Appln. Ser. No. 4-2013-005518
Filing Date: 15 May 2013
Trademark: **NEURODIN**

Decision No. 2015 - _ ____

DECISION

WESTMONT PHARMACEUTICALS, INC.[1] ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2013-005518. The application, filed by ATTY. AMBROSIO V. PADILLA III[2] ("Respondent-Applicant") covers the mark NEURODIN for use on *"pharmaceutical products namely: vitamin B-complex, which comprises the essential B vitamins needed for the proper functioning of almost every process in the body"* under Class 5 of the International Classification of goods[3].

The Opposer alleges the following:

> "1. The trademark 'NEURODIN' owned by Respondent-Applicant so resembles the trademark 'NEUROGEN-E' owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark 'NEURODIN'.
>
> "2. The mark 'NEURODIN' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'NEURODIN' 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 Product namely: Vitamin B-Complex.
>
> "3. The registration of the 'NEURODIN' in the name of the Respondent will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:
>
> x x x
>
> 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 the mind of the purchasers will likely result."

The Opposer's evidence consists of the following:

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[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 Filipino citizen with address at Unit 1001, 88 Corporate Center, Sedeno corner Valero Streets, Salcedo Village, Makati City.

[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.

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. Exhibits "J" - Sample of product label bearing the trademark "NEUROGEN-E" actually used in commerce; and
8. Exhibit "K" – Certification issued by the IMS.

This Bureau issued on 29 August 2013 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 05 September 2013. The Respondent-Applicant, however, did not file an Answer. On 04 March 2014, Order No. 2014-016 was issued declaring Respondent-Applicant in default for failing 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 NEURODIN?

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.[4] Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark NEURODIN on 15 May 2013, the Opposer already has an existing registration for the trademark NEUROGEN-E issued on 09 February 1987, covering goods falling under Class 05, namely, *"neuromyotonic with Vitamin E for full revitalization"*. This Bureau noted that Opposer's mark is indicative of the pharmaceutical product on which it is used, that is, "neuromyotonic vitamin E" which makes it a suggestive mark. Therefore its distinctive mark is not in the prefix "neuro" but in the syllables or letters attached or affixed to it.

As shown below, the syllables following the prefix "NEURO" in the Opposer's mark is "GEN-E", while in the Respondent's mark, is the syllable "DIN".

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

Neurodin

Opposer's Mark *Respondent-Applicant's Mark*

It is very clear that both Opposer's and Respondent's marks contain identical prefix "NEURO". While the syllable that comes after the prefix "neuro" in the competing marks are different, their similarity is more noticeable because of how the respective marks are pronounced as a whole. In pronouncing the Respondent-Applicant's mark, the sound of the syllable "DIN" at the end 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.

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[5]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, 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 to mislead or confuse persons in the ordinary course of purchasing the genuine article[6].

As to the goods/services upon which the competing marks are used, it may appear that the competing marks are used on different goods/services although they are classified under the same class, that is, Opposer's mark is used on *neuromyotonic with Vitamin E for full revitalization* under Class 05 while Respondent's mark is being applied for *"pharmaceutical products namely: vitamin B-complex, which comprises the essential B vitamins needed for the proper functioning of almost every process in the body"* also under Class 5. Thus, the goods are actually similar, or at least closely related. In the sample packaging submitted by Opposer, the mark NEUROGEN- E is used in the market for "Vitamin B-Complex, Vitamin E. As such there is likelihood that any impression, perception or information about the goods under the mark NEURODIN may be unfairly attributed or confused with Opposer's NEUROGEN-E, and vice versa.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility

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[5] See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.
[6] See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

or likelihood of the purchaser of the older brand mistaking the newer brand for it.[7] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[8]

> 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.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.[9]

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. 4-2013-005518, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 24 July 2015.

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

[7] See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.
[8] See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.
[9] See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.