

MERCK KGAA,
Opposer,

-versus-

ASTRAZENECA AB,
Respondent-Applicant.

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}
} **IPC No. 14-2011-00226**
} Opposition to:
} Appln. No. 4-2010-501048
} Date Filed: 21 July 2010
} **TM: "NEUROPAIN"**
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}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 264 dated November 10, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 10, 2015.

For the Director:


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

MERCK KGAA,

Opposer,

-versus-

ASTRAZENECA AB,

Respondent-Applicant.

} **IPC NO. 14-2011-00226**

} Opposition to:

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} Appln. Ser. No. 4-2010-501048

} Date Filed: 21 July 2010

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} Trademark: **"NEUROPAIN"**

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x-----x } Decision No. 2015- **264**

DECISION

MERCK KGaA., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-501048. The application, filed by ASTRAZENECA AB (Respondent-Applicant)², covers the mark "NEUROPAIN", for use on "pharmaceutical preparations and substances" under Class 5 of the International Classification of Goods³.

The Opposer alleges that:

"2. Opposer is the owner of the trademark 'NEUROBION', which has been registered in the Intellectual Property Office ('IPO') of the Philippines since February 2, 1975. 'NEUROBION' is classified as class 5 goods under 'Pharmaceutical and Medical Preparations'. It is further described to be '[e]specially Pharmaceutical Products containing a combination of the Neurotropic Vitamins B1, B6 and B-12.' Aside from the Philippines, the trademark 'NEUROBION' is likewise registered in various countries. Its oldest registration is in Germany on July 13, 1955. Copies of the Bibliographic Data of 'NEUROBION' from the IPO website, Listing of Trademark Registrations of 'NEUROBION' in various countries, Certificates of Registration in Trinidad and Tobago and Certificate of Renewal/Restoration in South Africa are attached xxx

"4. The Application for the Registration of the trademark 'NEUROPAIN' should be denied on the ground that the same is confusingly similar to the registered trademark 'NEUROBION.' Otherwise, if Respondent-Applicant's application for registration is granted, it will deceive or cause confusion to the buying public.

¹ A foreign corporation duly organized and existing under the laws of Germany with address at Frankfurter Strasse 250, 64293 Darmstadt Germany

² A corporation organized and existing under the laws of Sweden with address at SE-151 85 SODERTALJE

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

“5. The Intellectual Property Code of the Philippines provides that a mark cannot be registered if it is identical or confusingly similar to a registered mark. Thus, Section 123 of the said Code provides:

‘Sec. 123. Registrability.-

123.1. A mark cannot be registered if it: xxx

(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; xxx

“6. The trademark ‘NEUROPAIN’ should be denied registration due to similarity in its aural effects with the registered trademark ‘NEUROBION.’ It is settled rule that similarity in sounds between a registered trademark and a trademark seeking to be registered is sufficient ground for denial of the registration of the latter. Xxx

“9. Applying said test in the case at bar, a simple comparison of the trademarks ‘NEUROPAIN’ and ‘NEUROBION’ would easily show that they are confusingly similar. First, both ‘NEUROPAIN’ and ‘NEUROBION’ are composed of three syllables and are spelled using exactly nine (9) letters. Second, they both start with exactly the same prefix ‘NEURO’, which by itself is likely to cause confusion considering that the said prefix creates the biggest impression, and is the part of the trademark that would certainly be imprinted in the minds of the buying public. xxx

“15. In the case at hand, there is no question that both Respondent-Applicant and the Opposer are engaged in pharmaceutical research and production. Moreover, a perusal of the Trademark Application filed by Respondent-Applicant and the Bibliographic Data of ‘NEUROBION’ will instantly show that both ‘NEUROPAIN’ and ‘NEUROBION’ are class 5 ‘Pharmaceutical Preparations and Substances’. Being in the same classification calls for a stricter application of trademark laws so as to protect the rights of the Opposer as a prior registrant.

“16. From the time of the first registration of the trademark ‘NEUROBION,’ Opposer has been using said trademark and marketing the same all over the world. Through the consistent use over time, the trademark ‘NEUROBION’ has become recognizable all over the world. Representing quality and effective pharmaceutical product, said trademark has gained recognition and goodwill in the eyes of the consumers. xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Copy of trademark application of the Respondent-Applicant;
2. List of trademark registrations for the mark "NEUROBION" and copy of its Certificate of Registration in Zanzibar, Trinidad and Tobago and South Africa;
3. Print out of IPO E-gazette showing trademark "NEUROPAIN";
4. Copy of status of registration of the mark "NEUROBION" and
5. Copy of Affidavit of Use dated for the mark "NEUROBION"⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 12 July 2011. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 18 January 2012, Order No. 2012-166 declaring the Respondent-Applicant to have waived its right to file an Answer.

Should the Respondent-Applicant be allowed to register the trademark NEUROPAIN?

Records show that at the time Respondent-Applicant applied for registration of the mark "NEUROPAIN" the Opposer already registered the mark "NEUROBION" under of Registration No. 022189 on 24 February 1975. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "pharmaceutical and medicinal preparations, especially pharmaceutical products containing a combination of the neurotropic vitamins B1, B6 and B12", while the Respondent-Applicant's trademark application indicates use as "pharmaceutical preparations and substances".

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

The competing marks are reproduced below:



Opposer's mark

NEUROPAIN

Respondent-Applicant's mark

The marks are phonetically similar with respect to the first two syllables ("NEURO"). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur.

The Opposer's product, NEUROBION⁵ is a pharmaceutical products containing a combination of the neurotropic vitamins B1, B6 and B12. The prefix 'NEURO' used in

⁴ Annexes "A" to "I"

⁵ Annex "H"

both marks is defined as "combining form meaning nerve, nerve tissue, the nervous system⁶. Thus, it is predictably used for medicines relating to neurologic health issues. More importantly, when the suffixes "PAIN and "BION" are appended to the prefix "NEURO", the resultant marks are different both visually and aurally, hence not confusingly similar. The consumers can easily distinguish one mark from the other.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-501048 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 November 2015.


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

⁶ Medical Dictionary for the Health Professions and Nursing © Farlex 2012; @ <http://medical-dictionary.thefreedictionary.com/neuro->