MERCK KGAA, Opposer, **-versus-** **ATTY. AMBROSIO V. PADILLA III,** Respondent- Applicant.	}	**IPC No. 14-2013-00343** Opposition to: Appln. Serial No. 4-2013-005518 Date Filed: 15 May 2013 **TM: "NEURODIN"**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 483 dated December 23, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL 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, December 23, 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

MERCK KGAA,
Opposer,

versus-

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

IPC NO. 14-2013-00343

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

Decision No. 2016 - 483

DECISION

MERCK KGAA.[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 grounds:

> "a. Respondent's 'NEURODIN' mark is confusingly similar with Opposer's registered 'NEUROBION' mark, covering the same or similar goods and services.
>
> "b. Because of the confusing similarity between the opposing marks, Respondent's product maybe assumed to originate from Merck thereby deceiving the public into believing that there is some connection between the Respondent and the Opposer which, in fact, does not exist (confusion of origin).
>
> "c. Respondent's use of the 'NEURODIN' mark, which is confusingly similar to the Opposer's registered mark, blurs the distinctiveness of the 'NEUROBION' mark.

The Opposer's evidence consists of the following:

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[1] *A corporation duly organized and existing under the laws of the Germany with address at Frankfurter Strase 250 D-64293, Darmstadt, Republic of Germany.*
[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. Special Power of Attorney;
2. Printout of the website of Merck;
3. Printout from the website of Merck about the details of its Neurobion product.
4. Copy of the Certificate of Registration No. 4-1973-401500 for the mark NEUROBION;
5. Certificate of Registration No. 22189 for the mark NEUROBION issued on 24 February 1995.
6. Certificate of Registration No. 4-1975-402267 for the mark DOLO-NEUROBION issued on 29 December 1977.
7. Certificate of Renewal Registration No. 25573 for the mark DOLO-NEUROBION issued on 29 December 1997.
8. Printout of the relevant pages of Opposer's website http://www.merckserono.in/en/therapy areas/vitamin/neurobion/neurobion.html regarding NEUROBION;
9. Philippine newpaper clippings on the 50th anniversary of Neurobion;
10. Printouts of relevant pages from the website http:www.neurobion.com;
11. Photocopies of pages 246 and 14 of 18th Edition of Pharmaceutical Products Directory;
12. Printout of pertinent pages of the website http://www.evaluategroup.com;
13. Printout of pertinent website of www.mims.com regarding NEUROBION;
14. Printout of relevant page from the website http://home.intekom.com;
15. Printout of the relevant portion of the website http://www.sandarmyaing.com;
16. Printout of the relevant portion of the website http://www.damanhealth.ae;
17. Printout of the relevant portion of the website http://www.thefilipinodoctor.com;
18. Printout of the relevant portion of the website http://www.idruginfo.com;
19. Printout of the relevant portion of the website http://www.ncbi.nlm.nih.gov;
20. List of countries where the mark NEUROBION is registered and relevant samples of certificates of registration issued in Afghanistan, Zanzibar, Pakistan, Singapore, Sweden, Nepal, Sri Lanka, Cambodia, Bahamas, Benelux;
21. Judicial Affidavit of Atty. Teresa Paz B. Grecia Pascual; and
22. Joint Judicial Affidavit of Mr. Jonas Kolle and Ms. Diana Schmerler.

This Bureau issued on 25 October 2013 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 21 November 2013. The Respondent-Applicant, however, did not file an Answer. On 31 March 2014, Order No. 2014-420 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 NEUROBION issued on 24 February 1975, or 38 years earlier. Opposer's mark is used on "*Pharmaceutical and Medicinal Preparations. Especially Pharmaceutical Products Containing a Combination of the Neurotropic Vitamins B1, B6 and B12*" falling under Class 05, which is identical or closely related to the goods upon which the Respondent's NEURODIN mark is being applied for namely, "*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 05.

But are the mark of the parties confusingly similar as to cause confusion, mistake or deception on the part of the purchasers?

The marks of the parties are reproduced below:

Neurobion	Neurodin
Opposer's Marks	Respondent-Applicant's Mark

It is very clear that both Opposer's and Respondent's marks contain the identical prefix "NEURO". The word "neuro" means nerve or the nervous system. The prefix "neuro"is indicative of the pharmaceutical product which is used by Opposer, that is, "neurotropic vitamins" 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. In Opposer's mark, the prefix "neuro" is followed by the letters "B-I-O-N" while in Respondent's, it is followed by the letters "D-I-N". In coming up with his mark, Respondent merely dropped the letters "B" and "O" in Opposer's mark and replace it with letter "D" to form his own mark "NEURODIN".

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

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

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].

Further, as already mentioned, the goods upon which the confusing similar marks of Opposer and Respondent are used, are similar, competing or closely related as they both refer to Vitamin B or Vitamin B - Complex. 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 NEUROBION, 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 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

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[5] *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.
[6] *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.
[7] *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.
[8] *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.

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, 23 DEC 2016

MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs