

Trade Marks Registry

Cardiff Road
Newport
South Wales
NP10 8QQ

Switchboard: 01633 814000
Direct Line: 01633 811137
Fax: 01633 811175
Minicom: 0645 222250
Website: www.ipso.gov.uk

World Intellectual Property Organisation (WIPO)
International Bureau
34, chemin des Colombettes
1211 Geneva 20
Switzerland

Our Ref: OPP72366 /TS/HLM
Your Ref: T/M 'PANTORAL'
Date: 26th January 2012

Please quote our complete reference on all correspondence

Dear Sirs

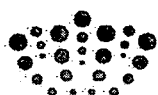
**NOTIFICATION OF A PARTIAL REFUSAL OF PROTECTION BASED ON AN
OPPOSITION BY THE UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE
IN ACCORDANCE WITH ARTICLE 5 OF THE MADRID PROTOCOL**

RE: International Registration number	: M1089599
For the mark	: PANTORAL
Holder of the International Registration	: Obchtchestvo s ogranitchennoi
Opposition number	: 72366

I must advise you that following receipt of an opposition to the above Trade Mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers some of the goods of the International Registration, which are as follows:

Albuminous foodstuffs for medical purposes; albuminous preparations for medical purposes; antiparasitic preparations; bacterial preparations for medical and veterinary use; biological preparations for medical purposes; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; dietetic substances adapted for medical use; digestives for pharmaceutical purposes; elixirs [pharmaceutical preparations]; ferments for pharmaceutical purposes; haematogen; herbs teas for medicinal purposes; medicinal herbs; medicinal infusions; medicinal oils; medicinal roots; mineral food-supplements; nervines; nutritional additives for medical purposes; opotherapy preparations; preparations of trace elements for human use; serums; styptic preparations; tonics [medicines]; vitamin preparations.

Please note protection will not be granted until the conclusion of these proceedings.



Please find attached a copy of the Form TM7 (Notice of Opposition) that was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

We also attach:

Copies of the marks referred to in the statement of case.

Form TM8, for any reply to this opposition to be filed.

An address for correspondence in the United Kingdom, another EEA state or the Channel Islands must be provided on the attached TM33 within this two month period. If one is not provided within this time, the international registration will be treated as withdrawn.

If the holder of the International Registration wishes to file a counterstatement, they must complete the attached Form TM8 and **return it to this office** together with the counterstatement within **two months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a Form TM8 and counterstatement will result in the provisional refusal being upheld. That would mean in this case, protection being granted only in respect of those goods and services which have not been the subject of the opposition.

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the Form TM8 can be extended for a further seven months by the filing of a Form TM9c.

The Form TM8 and counterstatement should be received on or before **26th March 2012** unless a cooling off period is entered into by the parties.

Yours faithfully



Heather Mackerness

ASSISTANT CASEWORK EXAMINER



INTELLECTUAL
PROPERTY OFFICE

M4-IPO-LONDON

10/JAN/2012

3597046/ 0001 D03312 TM07.....
11JAN12 200.00 ACCOUNT M1089599

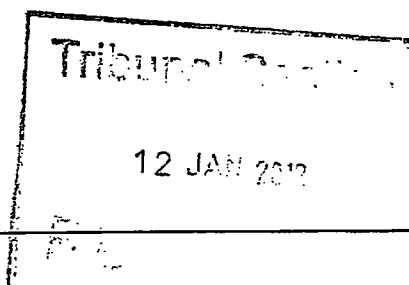
Form TM7

Official Fee £200 due with this form

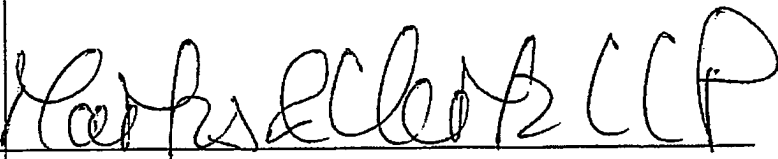
Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Notice of opposition and statement of grounds

Please read the notes below before filling in this form



1. Trade Mark number.	M1089599
2. Full name of the applicant, international registration holder, or registered proprietor.	Obchtchestvo s ogranitchennoi otvetstvennostiou "Laboratoria sovremennogo zdorovia"
3. Full name and address (including postcode) of the opponent.	Nycomed GmbH Byk-Gulden-Str. 2 Konstanz 78467 Germany
4. Full name and address (including postcode) of the opponent's representative (if any).	Marks and Clerk LLP 90 Long Acre London WC2E 9RA
5. Are there any related proceedings currently with the Registry, the UK courts or with the OHIM? If so, give application, registration or opposition number.	N/A
6. State the date that you notified the applicant, international registration holder, or registered proprietor that you intended to oppose the trade mark application, International designation or amendment. (Please see note below)	The Holder was notified of the Opponent's intention to oppose through the filing of a form TM7A on 26 November 2011 and as a result of proceedings filed against the same mark in other jurisdictions.

7. Declaration	I believe that the facts stated in this notice and in the attached statement of grounds are true
Your signature.	
Your name in BLOCK CAPITALS.	Marks and Clerk LLP
Date.	10 January 2012
8. Name and daytime phone number of the person we should contact in case of query	Stephanie Loeffler 0207 240 0000
9. Your reference.	SL/kh/XN801727GB
10. Number of sheets attached to this form.	4

Notes Number every extra sheet and say in question 10 above how many you have used.

An opposition launched without giving the applicant, international registration holder or the registered proprietor a reasonable opportunity to withdraw the application, international designation or amendment, may result in the opponent being ineligible for an award of costs.

Filing a form TM7a, notice of threatened opposition, may qualify as giving notice subject to the applicant being provided with a reasonable opportunity to withdraw the application.

Boxes 3 and 4: at least one of these should be located in the European Economic Area (EEA) or the Channel Islands

Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of earlier trade mark

Number:

6383137

Is it a UK, Community or International mark?

Community Trade Mark

Representation of the mark:

PANTOSAL

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☒ All
- ☐ Some (please specify)

2. **Statement of use provision**– Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?

☐ Yes ☒ No

- 3(a). If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?

☐ All

☐ Some (please specify)

Or,

- 3(b). If yes and the mark has not been used, please state any proper reasons for non use.

Details of the mark you are opposing

4. Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?

☐ All

☒ Some (please specify)

Albuminous foodstuffs for medical purposes; albuminous preparations for medical purposes; antiparasitic preparations; bacterial preparations for medical and veterinary use; biological preparations for medical purposes; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; dietetic substances adapted for medical use; digestives for pharmaceutical purposes; elixirs [pharmaceutical preparations]; ferments for pharmaceutical purposes; haematogen; herbs teas for medicinal purposes; medicinal herbs; medicinal infusions; medicinal oils; medicinal roots; mineral food-supplements; nervines; nutritional additives for medical purposes; opotherapy preparations; preparations of trace elements for human use; serums; styptic preparations; tonics [medicines]; vitamin preparations.

Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g, why you consider the respective marks or goods and/or services to be similar?

Please see attached statement of case on pages 3 and 4.

TRADE MARKS ACT 1994

IN THE MATTER of the UK
Designation of International
Registration No. 10809599
PANTORAL in Class 5 (the
"Contested Application") of
Obchtchestvo s ogranichennoi
otvetstvennostiou "Laboratoria
sovremennogo zdorovia" (the
"Applicant")

- and -

IN THE MATTER of an
Opposition thereto by Nycomed
GmbH (the "Opponent")

STATEMENT OF CASE

1. The Opponent is the Proprietor of Community Trade Mark No. 6383137 PANTOSAL in Class 5. The aforesaid right pre-dates the date of filing of the Contested Application and therefore constitutes an "Earlier Right" within the meaning of Section 6(1)(a) of the Trade Marks Act, 1994 (the "Act").
2. The Contested Application consists of the word PANTORAL which is virtually indistinguishable from the Earlier Right since the signs concerned share the same number of letters and the only difference is the substitution of the letter "S" of the Earlier Right, for the letter "R". Consequently, the signs are so similar as to give rise to a likelihood of confusion. The Contested Application covers goods which are both identical and similar to the goods covered by the Earlier Right. For reasons which include the aforesaid arguments, registration of the Contested Application is contrary to the provisions of section 5(2)(b) of the Act.
3. By reason of the matters set forth above, the Contested Application is not a registrable trade mark within the meaning of the Act, or at all.

4. The Opponent asks that the Contested Application be refused and that an award of costs be made in its favour against the Applicant in these proceedings.

MARKS & CLERK LLP
Attorneys for the Opponent
Date: 10 January 2012



INTELLECTUAL
PROPERTY OFFICE

Form TM33
Nil Fee

**Appointment or change of
agent or contact address**

Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Please read the note below before filling in this form.

1. Trade mark numbers affected. (Please put an 'M' in front of Madrid marks). (List on a separate sheet if there is not enough space on this form).	(Lowest) Class
2. Full name of the a) proprietor; or b) opponent as now shown on our records.	
3. Name and address (including postcode) of the new agent or contact address	
Trade Marks ADP number (if you know it).	
4. Declaration. Signature. Name in BLOCK CAPITALS. Date.	We have been appointed by the above proprietor or opponent.
5. Name and daytime phone number of the person we should contact in case of query. Your reference. Number of sheets attached to this form.	This is sheet 1 of
6. E-mail Contact Details If your e-mail contact details have changed, please notify us of the new e-mail address (see note 2).	

Notes 1. We suggest you check the proprietor's name and the marks they own by doing a proprietor search on our website www.ipo.gov.uk before you fill in the form.

2. It is important that you notify us of any change to your e-mail address. However, we will only amend the e-mail address details of any application referred to on this form if they were e-filed on or after 1st October 2009.

Please refer to www.ipo.gov.uk/pro-types/pro-tm/t-law/t-notice/t-notice-01102009.htm for further information.

We cannot add an e-mail address if the trade mark application was not filed electronically.

Costs of proceedings before the Comptroller

Preparing a statement and considering the other side's statement

From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.

Preparing evidence and considering and commenting on the other side's evidence

From £500 if the evidence is light to £2,000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.

Preparing for and attending a hearing

Up to £1,500 per day of hearing, capped at £3,000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.

Expenses

- (a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time).
- (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.



Form TM8

Nil Fee

Notice of defence and counterstatement

Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Please read the guidance notes on the next page before filling in this form.

1. Trade mark number.	
2. Full name of the applicant or registered proprietor.	
3. Opposition, invalidation, revocation, or rectification number.	
4. Name and address (including postcode) of the agent (if any).	
5. Do you want the opponent to provide proof of use? (see note)	
6. If you answered 'Yes' to question five, please state for which goods and services you require proof.	
7. Counterstatement	

<p>8. Are there any related proceedings currently with the Registry, the UK courts or with the OHIM? If so, give application, registration or opposition number.</p>	
<p>9. Declaration</p> <p>Your signature.</p> <p>Your name in BLOCK CAPITALS.</p> <p>Date.</p>	<p>I believe that the facts stated in this notice of defence and counterstatement are true.</p>
<p>10. Name and daytime phone number of the person we should contact in case of query.</p> <p>Your reference.</p> <p>Number of sheets attached to this form.</p>	

Notes If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 10 how many sheets you have used.

Boxes 2 and 4: at least one of these should be located in the European Economic Area (EEA) or the Channel Islands

Box 5: Only applies in opposition, or similarly in the case of invalidation proceedings, where the person opposing or invalidating your mark may have provided a statement of use and only applies to grounds of opposition or invalidation raised under sections 5(1) and 5(2) and 5(3) of the Trade Marks Act.
If more than one trade mark is being relied upon, please indicate in respect of which trade mark you would like the opponent to provide proof of use.