

UNITED LABORATORIES, INC.
Opposer,

versus

UNITEDHEALTH GROUP INC.
Respondent-Applicant
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IPC No. 14-2010-00029

Opposition to:
Appln. Serial No. 4-2008-000702
Date Filed: 21 January 2008
Trademark: UNITEDHEALTH
INTERNATIONAL
Decision No. 2011-76

DECISION

UNITED LABORATORIES, INC. ("Opposer") a corporation duly organized and existing under the law of the Philippines and with principal address at 66 United Street, Mandaluyong City, Philippines, filed on 29 January 2010 an opposition to Trademark Application No. 4-2008-00702. The application filed by Unitedhealth Group Incorporated ("Respondent-Applicant") a foreign corporation with principal business address at 9000 Bren Road East MN008-T202, Minnetonka, Minnesota, United State of America covers the mark "UNITEDHEALTH INTERNATIONAL" for use on various medical and healthcare related goods/services under Classes 33 and 36 of the International Classification of goods.

The Opposer alleges among other things, the following:

1. The mark "UNITEDHEALTH" owned by Respondent-Applicant so resembles the trademarks "UNITED LABORATORIES, INC.", "UNITED LABORATORIES," and "UNITED AND DEVICE" owned by the Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark UNITEDHEALTH.
2. The mark UNITEDHEALTH will likely cause confusion, mistake and deception on the part of the purchasing public most especially considering that the opposed mark UNITEDHEALTH is applied for the same class as that of Opposer's trademarks UNITED LABORATORIES, Inc, and UNITED and DEVICE i.e. Class 35 of the International Classification of Goods.
3. The registration of the mark UNITEDHEALTH in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code xxx.
4. The foregoing provisions explicitly prescribe the registration of a mark if it is identical with a registered mark belonging to a different proprietor, or 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 is nearly resemble such a mark as to be likely to deceive or cause confusion.

The Opposer's evidence consists of the following:

1. Exh. "A": copy of the "E-Gazette" released on 1 Oct. 2009
2. Exh. "A-1": portion of the copy of the "E-Gazette" where the mark Unitedhealth International was published and listed.
3. Exh. "B": copy of Reg. 0385 for the mark United Laboratories, Inc. dated 22 July 1958
4. Exh. "C": copy of Cert. of Renewal No. 2115 for the mark United Laboratories Inc. dated 22 Jan 1978

5. Exh. "D": copy of Cert. or Renewal No. R-2115 issued on 3 Sept. 2001 for the mark United Laboratories Inc.
6. Exh. "E": copy of Cert. or Reg. No. 002115 for the mark United Laboratories, Inc. use on the business of manufacturing and selling drugs and medicines (date of renewal: 22 Jan. 2008);
7. Exh. "F": Cert. of Reg. No. 4-2007-008191 for the mark United Laboratories (date of registration: 5 Nov. 2007);
8. Exh. "G": Cert. of Reg. No. 12807 for the mark United;
9. Exh. "H": Cert. of Renewal No. 12807 (date of renewal: 31 Mar. 2007);
10. Exh. "I": Affidavit of use for 5th anniversary;
11. Exh. "J": Affidavit of use filed on 22 Jan. 1993 for the mark United Laboratories, Inc.;
12. Exh. "K": Affidavit of use filed on 11 Mar. 1988 for the mark United Laboratories, Inc.;
13. Exh. "L": Declaration of Actual Use ("DAU");
14. Exh. "M": Affidavit of use for the 15th anniversary of the mark United Laboratories, Inc.; and
15. Exh. "N": Affidavit of use filed on 29 Apr. 1997 for the mark United Laboratories, Inc.

The Respondent-Applicant filed its Verified Answer on 24 March 2010, alleging among other things that its trademark is not confusingly similar to the opposer's. The Respondent-Applicant asserts that its mark differs from the Opposer's particularly, in the words used and the spelling thereof.

Should the Respondent-Applicant Trademark Application be allowed?

The essence of trademark registration is to give protection to the owner of Trademarks. The function of the trademarks 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; to protect the manufacturer against and sale of inferior and different articles as his products.

Thus, Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") states 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 good or services, or closely related goods or services, or if it nearly resembles such a mark to be likely to deceive or cause confusion,

Records and evidence show that at the time the Respondent-Applicant filed its trademark application in 2008, the Opposer has existing trademark registrations for United Laboratories, Inc, United Laboratories and United and Device. The mark United Laboratories, Inc. was registered on 22 January 1958 Reg. No. 6295 used on the goods/services under Class 35, particularly "Business of manufacturing and selling drugs and medicines" which was renewed under Reg. No. R-2115 in September 2001. This Bureau finds the medical and healthcare goods

and services covered by the Respondent-Applicant's trademark application closely related to the Opposers.

But does the Respondent-Applicant's mark resemble the opposer's mark such that confusion or deception is likely to occur?

The Opposer's mark consists of the words "United", "Laboratories" and "Inc." with the last words, being common in the business, disclaimed. The Respondent-Applicant on the other hand disclaimed the word "International". What strikes the eyes and rings to ears in both marks is the word "United"/ The word is the feature that gives these marks the distinctive character of a trade or service mark.

In this regard, records and evidence shows that the Opposer has been using the "United" trademarks in the business of manufacturing and/or selling medicines as early as 1949. Since then, until the Respondent-Applicant filed its trademark application subject of this opposition case and there being no evidence to the contrary, the Opposer is the only one that is using the word "United" as a trademark or as a prominent feature of a trademark for use on medical and health related goods. The use therefore, by the Respondent-Applicant of the word "United" as a mark or as part thereof for use also on similar or closely related goods or services would like make the consumers assume of think the goods or services originate from the Opposer's, and/or the parties are affiliated with or connected to each other. In addition to the confusion shown to the public, the Respondent-Applicant will also possibly benefit from the Opposer's advertisement and promotional activities, reputation and prestige.

Aptly, to constitute an infringement of a trademark and warrant a denial of an application for registration, the law does not require that the competing trademark must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the laws, 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. When one applied for the registration of a mark or label which is almost the same or very closely resembles one already use and registered by another, the application should be rejected and dismisses outright even without any opposition on the part of the owner and user of a previously registered label or trademark, this is not only to avoid confusion on the part of the public but also to protect and already used and registered trademark and established goodwill.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application No.4-2008-000702 to be returned, together with a copy of this Decision to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 21 September 2011